



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
14/112,436 10/17/2013 Taku Endo Q207251 9088

23373 7590 04/20/2018
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

RENWICK, REGINALD A

ART UNIT PAPER NUMBER

3714

NOTIFICATION DATE DELIVERY MODE

04/20/2018

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PPROCESSING@SUGHRUE.COM
sughrue@sughrue.com
USPTO@sughrue.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TAKU ENDO

Appeal 2017-005181
Application 14/112,436
Technology Center 3700

Before JENNIFER D. BAHR, LEE L. STEPINA, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

PESLAK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Taku Endo (“Appellant”) appeals under 35 U.S.C. § 134(a) from the Examiner’s decision rejecting claims 1–12.¹ We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ The Appeal Brief identifies KONAMI DIGITAL ENTERTAINMENT CO., LTD. as the real party in interest. Appeal Br. 2.

THE CLAIMED SUBJECT MATTER

Claim 1, reproduced below with italics added, is illustrative of the claimed subject matter.

1. A game apparatus for dynamically generating a display screen for providing a user with a game for collecting a plurality of items belonging to each of a plurality of item groups, the game apparatus comprising:

a memory configured to store one or more program codes;
a communication unit configured to communicate with a terminal apparatus of a user;

and

a processor configured to read the one or more program codes and execute one or more operations comprising:

monitoring a plurality of item groups, each including one or more items to be collected by the user;

determining whether the user has a collection-not-completed item group in which all items in the item group have not yet been collected by the user;

determining another user who owns an item not yet collected by the user in the collection-not-completed item group as a candidate user from whom the item is to be taken when an event is achieved when the user has the collection-not-completed item group in which all items in the item group have not yet been collected by the user;

transmitting, to the terminal apparatus via the communication unit, a first display screen on which the user is capable of instructing commencement of the event, to cause the terminal apparatus to display the first screen;

receiving an instruction, via the communication unit, for the commencement of the event from the user; and in response to receiving the instruction for the commencement of the event, *dynamically and automatically generating a second display screen independent of a direct request from the user for displaying the another user as the candidate user*, and transmitting the second display screen to the terminal apparatus via the communication unit, to cause the terminal apparatus to

display the second display screen including the determined another user who owns the item not yet collected by the user in the collection-not-completed item group.

REJECTION

Claims 1–12 are rejected under 35 U.S.C. § 101 as directed to patent ineligible subject matter.

DISCUSSION

Appellant argues claims 1–12 as a group. Appeal Br. 8–24. We select claim 1 as representative and claims 2–12 stand or fall with claim 1. 37 C.F.R. § 41-37(c)(1)(iv).

To determine patent-eligibility, we perform a two-step analysis. First, we determine if the claims are directed to a patent-ineligible concept such as an abstract idea. *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014). If so, we determine if the claims contain an “inventive concept” that transforms the abstract idea into a patent-eligible application. *Id.* at 2357.

The Rejection

The Examiner determines that claim 1 “is directed to the abstract idea of a method of organizing human activities. Specifically a method of informing players of other players who own certain items.” Final Act. 2. In an Advisory Action, the Examiner further explains that

[t]he process of determining what items are not on a player’s list but are on another player’s list, is itself comparing two lists, and therefore comparing information. This comparison can be performed by a person using mental steps. The additional step of presenting to the player, an optional trading partner based on whether or not said other players hold a particular item is merely, ‘comparing data and presenting the player with options,’ which can also be performed

using mental steps. This was also previously determined to be an abstract idea in itself.

Adv. Act. 3.

The Examiner states that certain claim limitations “can be performed by individuals in person without the use of a computer” and other claim elements “amount to no more than recitation of generic computer structure that serves to perform generic computer functions that are well-understood, routine, and conventional activities previously known in the pertinent industry.” Final Act. 3. The Examiner concludes that “[v]iewed as a whole, these additional claim elements do not provide meaningful limitations to transform the abstract idea into a patent eligible application of the abstract idea such that the claim amounts to significantly more than the abstract idea itself.” *Id.*

Alice Step 1

Appellant contends that claim 1 is not directed to an abstract idea. Appeal Br. 9. Appellant argues that the Examiner’s statement of the abstract idea in the Final Action, i.e., informing players of other players who own certain items, is “overly simplified.” *Id.* at 11; *see also* Reply Br. 12. In support of this contention, Appellant presents several arguments based on an assertion that the claims are directed to an improvement in computer technology or graphical user interfaces due to the limitation “dynamically and automatically generating a second display screen independent of a direct request from the user for displaying the another user as the candidate user.” *See id.* at 11–12, 14, 16–17. Appellant conceptually frames the claimed features as

provid[ing] a specific manner of dynamically generating a display screen for providing a user with a game and a candidate user . . . independent of a direct request from the user for displaying the another user as the candidate user. Here, the claimed features are directed to a specific manner, in which, a display data is generated for displaying a graphic interface.

Id. at 11–12.

Appellant asserts that the claims address a problem with “smart phones and other portable devices with smaller screen where a pointing device such as a mouse cannot be used” and wherein the claimed apparatus “reduces the burden on a player who wants to acquire a desired item in an event using a device that has limited types and functions of input devices.” *Id.* at 12. In support of these arguments, Appellant relies on *Enfish v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016), *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014), and July 2015, Examiner Guidelines Update, App. 1, Ex. 23. *Id.* at 10, 14, 16.

In the Answer, the Examiner maintains that “the claims are directed to a method of organizing human activity wherein players are informed of other players who are missing a particular item. This process can be conducted by a person who reviews two lists and determines what items a user does not have.” Ans. 6. The Examiner states that the claim limitation “dynamically and automatically generating a second display screen . . .” is “merely updating information on a display . . . This is not a problem within the realm of computer display and is instead a generic computer function.” *Id.* at 8.

In the Reply Brief, Appellant refers us to, *inter alia*, two Federal Circuit decisions *McRO v. Bandai Namco Games America, Inc.*, 837 F.3d 1299 (Fed. Cir. 2016) and *Trading Technologies Intl., Inc. v. CQG, Inc.*, 675

Fed. Appx. 1001 (Fed. Cir. 2017).² Reply Br. 10. For the following reasons, we agree with the Examiner that claim 1 is directed to an abstract idea.³

Appellant’s argument that the claims are directed to addressing problems with “smart phones and other portable devices with smaller screen where a pointing device such as a mouse cannot be used” as an input device (Appeal Br. 12) is not persuasive because it is not commensurate with the scope of claim 1. Claim 1 recites “a terminal apparatus” which will “display the second display screen” without any limitation to the display screen or lack of pointing devices. Further, Appellant’s Specification generically describes “display unit 26 (such as a liquid crystal display panel) displays . . . a screen of the game.” Spec. ¶ 17. The Specification further describes “[a] touch sensitive panel integrated with the display unit 26 . . . can be employed as the input unit 28.” *Id.* In light of these provisions, Appellant does not direct us to any portion of the Specification that would support a construction that claim 1 is limited to small screen devices or persuasively explain why a touch sensitive panel display does not allow input with a pointing device.

² Both *McRO* and *Trading Technologies* were decided after the filing of the Appeal Brief in this case.

³ Appellant also asserts that the claims “hav[e] been found *not* obvious from any prior art of record.” Reply Br. 7. We reviewed the prosecution record in this application and do not find any rejection of the claims under 35 U.S.C. § 103(a) nor do we find a determination by the Examiner that the claims were patentable thereunder. In any event, such a determination would not be relevant to the analysis under 35 U.S.C. § 101. *See Two-Way Media Ltd. v. Comcast Cable Comm'ns, LLC*, 874 F.3d 1329, 1339–40 (Fed. Cir. 2017) (“Eligibility and novelty are separate inquiries.”).

Appellant’s reliance on *Enfish* and *DDR Holdings* is also not persuasive. In *Enfish*, the claims were found to be patent eligible because they were directed to “a specific type of data structure designed to improve the way a computer stores and retrieves data in memory.” *Id.* at 1339. In this case, Appellant has not shown an improvement in the technology of graphical user interfaces or the processor of the gaming apparatus. Rather, the claim requires automatic generation of a screen displaying certain information about a candidate user (potential opponent in the game), which, presumably, would also be displayed in the same manner in response to a direct request from the user. Appellant does not direct us to any part of the claims or the Specification directed to improvements in the technological aspects of the graphical user interface *per se*. In fact, both claim 1 and the Specification indicate otherwise. Claim 1 requires that the game apparatus receive “an instruction” from the user prior to automatically generating a second display screen and causing the terminal apparatus to display the second display screen. According to Appellant’s Specification, the recited instruction may be provided to the game apparatus by the user operating input unit 28. *See* Spec. ¶¶ 24-25. Further, the user can operate input unit 28 “to select a desired player” or a “desired item” from those listed in game screen GB. *Id.* ¶¶ 26–28, Fig. 2A. Thus, the claim limitation automatically generating a second display screen is performed in response to a direct “instruction” from the user via the terminal apparatus. Although this instruction is not “a direct request from the user for displaying another user,” this instruction is disclosed as entered into the input device on the user’s terminal apparatus. Appellant’s argument that the claims solve an issue relating to user input due to the size of a screen on a terminal apparatus are

not persuasive because the claims specifically require a user input via the terminal apparatus.

In *DDR Holdings*, the Federal Circuit explained the claims were not directed to an abstract idea because “they do not merely recite the performance of some business practice known from the pre-Internet world along with the requirement to perform it on the Internet. Instead the claimed solution is necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks.” 773 F.3d at 1257. As discussed above in connection with *Enfish*, Appellant does not persuade us that the claims at issue are necessarily rooted in computer technology or graphical user interface technology in order to overcome a specific technological problem in the prior art.

Claim 1 including the limitation dynamically generating a screen of categorized information, i.e., candidate users, is analogous to “collecting information in classified form, then separating and transmitting that information according to its classification” which the Federal Circuit held “is an abstract idea that is not patent-eligible.” *Cyberfone Systems, LLC v. CNN Interactive Group, Inc.*, 558 Fed. Appx. 988, 992 (Fed. Cir. 2014). Appellant’s reliance on *Trading Technologies*, *McRO*, and Example 23 from the July 2015 Examiner Guidelines is unavailing in light of the holding in *Cyberfone*.

In *Trading Technologies*, the Federal Circuit, quoting the district court, explained that the claims in that case did not recite:

“a fundamental economic or longstanding commercial practice” . . .
[but] “solve problems of prior graphical user interfaces . . . in the
context of computerized trading . . .

the challenged patents do not simply claim displaying information on a graphical user interface. The claims require a specific structured graphical user interface paired with a prescribed functionality directly related to the graphical user interface's structure that is addressed to and resolves a specifically identified problem in the prior state of the art.

675 Fed. Appx. at 1004.

As noted above, claim 1 simply requires automatic display of information relating to the game being played on the graphical user interface. Appellant does not persuasively explain how the recited automatic display of information is rooted in the specific structure of the graphical user interface or the functionality of the graphical user interface.

The holding in *McRO* is similarly unavailing. The claims at issue in *McRO* were directed to “A method for automatically animating lip synchronization and facial expression” and “are limited to specific rules with specific characteristics.” 839 F. 3d at 1306, 1313. The Federal Circuit held the claims were not directed to an abstract idea because the claim incorporates “specific features of the rules as claim limitations” and “is directed to a patentable technological improvement over the existing manual 3-D animation techniques.” *Id.* at 1315. Appellant does not persuasively explain how automatically displaying a screen of information without prompting by the user is a technological improvement over existing computer technology or graphical user interface technology.

Example 23 of the July 2015 Examiner Guidelines is a hypothetical example regarding an improvement to a computer graphical user interface. July 2015 Update, App. 1 at 7. The example relates to a problem in a computer display where multiple windows are simultaneously open and one window overlaps with and thereby obscures the text displayed in underlying

windows. *Id.* The hypothetical claim is directed to solving this specific problem by, *inter alia*, relocating the textual information that is obscured in the underlying window to an unobscured portion of the underlying window. *Id.* at 8. The guidelines indicated that the hypothetical claim did not recite an abstract idea because it “is necessarily rooted in computer technology to overcome a problem specifically arising in graphical user interfaces.” *Id.* at 9. The example, thus, does not support Appellant’s argument because claim 1 is not directed to an improvement or change in the graphical user interface technology. Appellant does not argue that the recited automatic display of information would be displayed in a different manner than with a direct user request for the information.

We have considered all of Appellant’s arguments and determine that Appellant does not apprise us of error in the Examiner’s determination that claim 1 is directed to an abstract idea. The limitations of claim 1 including the limitation “dynamically and automatically generating a second display screen” are analogous to “collecting information in classified form, then separating and transmitting that information according to its classification” and hence is an abstract idea. *See Cyberfone Systems, LLC*, 558 Fed. Appx. at 992. Automatically displaying the information without a direct request from the user is merely insignificant post-solution activity. *See Parker v. Flook*, 437 U.S. 584, 592 (1978).

Alice Step 2

Appellant contends that the claimed invention amounts to significantly more than an abstract idea due to improvement in graphical user interface technology. Appeal Br. 21. As explained above, we do not agree

that automatically generating a display screen with certain information, independent of a direct request from the user, is directed to an improvement in graphical user interface technology or computer technology. Appellants do not argue that the information automatically displayed is novel or different than information displayed in previous game apparatus. Rather, Appellants argue that the claimed apparatus reduces the number of input steps required by a user to have the same information displayed. *See* Appeal Br. 21. This activity is merely the automatic display of routine and conventional gaming information by means of “well understood, routine conventional activit[ies] previously known to the industry.” *In re TLI Communications*, 823 F.3d 607, 613 (Fed. Cir. 2016); *see* Ans. 8, 9–10. The Federal Circuit in *TLI*, quoted the Supreme Court in *Alice*, that “[n]early every computer will include a ‘communications controller’ and a ‘data storage unit’ capable of performing the basic calculation, storage, and transmission functions required by the method claims.” *Id.* at 614. Here, claim 1 requires a communication unit to send an instruction to a processor, which automatically transmits stored information to a display.

Appellant also contends the claims are directed to an improvement in processing speed and resource usage of a computer and the Examiner did not consider this aspect of the claimed invention. *Id.* at 21, 23. This contention is not persuasive because Appellant does not direct us to any portion of the Specification or other evidence that would support a finding that the claimed invention improves processing speed or resource usage of a computer. Appellant lastly contends that the Examiner did not consider the claim limitation “dynamically and automatically generating a second display screen.” *Id.* at 23. To the contrary, the Examiner specifically considered the

Appeal 2017-005181
Application 14/112,436

limitation and determined that it is directed to “presenting the player with options.” Adv. Act. 3.

As Appellant’s contentions do not apprise us of error, we determine that the elements of claim 1, considered both individually and as an ordered combination, do not transform the abstract idea of claim 1 into patent-eligible subject matter. Claims 2–12 fall with claim 1.

DECISION

The Examiner’s decision rejecting claims 1–12 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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED