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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROBERT BURNSIDE¹

Appeal 2017-007741
Application 13/952,318
Technology Center 3700

Before: LEE L. STEPINA, RICHARD H. MARSCHALL, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

STEPINA, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's decision to reject claims 21–40. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ The Appeal Brief indicates that the real party in interest is Jack Ten Suited. Appeal Br. 2.

CLAIMED SUBJECT MATTER

The claims are directed to a method and apparatus for electronic gaming. Claims 21, 28, and 35 are independent. Appeal Br. 11 (Claims App.). Claim 21, reproduced below, is illustrative of the claimed subject matter:

21. A method comprising:

receiving, by a gaming system, a first plurality of tournament entries corresponding to a first plurality of players, each of the first plurality of tournament entries being for a same type of game and for a predetermined duration;

tracking, by the gaming system, play of the first plurality of players;

determining, by the gaming system, when a first set of the first plurality of players has completed the predetermined duration, the first set being less than an entirety of the first plurality of players, the first set defining entrants in a first tournament;

after determining the first set of the first plurality of players, determining, by the gaming system, a first winner of a first tournament among the first set;

after determining the first set of the first plurality of players, determining, by the gaming system, when a second set of the first plurality of players has completed the predetermined duration, the second set being less than the entirety of the first plurality of players, the second set defining entrants in a second tournament;

after determining the second set of the first plurality of players, determining, by the gaming system, a second winner of a second tournament among the second set;

wherein a first player of the first set plays one or more hands against players in the second set during the duration of the first tournament, the one or more hands counting in play for the first player in the first tournament and for the second player in the second tournament; and

wherein determining the first set and determining the second set is performed independently of an order the first plurality of tournament entries are received.

Id. at 11.

REJECTION

Claims 21–40 are rejected under 35 U.S.C. § 101 as being directed to patent ineligible subject matter.

OPINION

Appellant argues for the patentability of claims 21–40 as a group. *See* Appeal Br. 6. We take claim 21 as representative. *See* 37 C.F.R. § 41.37(c)(1)(iv).

In *Alice*, the Supreme Court applied the framework set forth previously in *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289 (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. Pty. Ltd. v. CLS Bank Int’l.*, 134 S. Ct. 2347, 2355. The first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* If so, the second step in the analysis is to consider the elements of the claims “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*, 132 S. Ct. at 1297).

Step 1

Addressing the first step of the *Alice* inquiry, the Examiner states that the claims are directed to “a system without any other recited computer components, to perform a series of mental steps that people aware of each step, can and regularly do perform a series of mental steps that people, aware of each step, can and regularly do perform in their heads.” Final Act. 2–3.

The Examiner concludes that, “[w]hatever the boundaries of the ‘abstract ideas’ category, the claim[s] at issue here involve[] a mental process excluded from section 101: the mental steps of comparing new and stored information and using rules to identify options.” *Id.* at 4.

Appellant contends, “Claims 21–40 are not directed to an abstract idea. Each of the claims is instead directed to a concrete improvement in the technological environment of online gaming tournaments.” Appeal Br. 6.

In support of this contention, Appellant states:

The claimed embodiments further *improve the operation of online gaming* tournaments by allowing players to independently decide whether to play in a non-tournament ‘cash’ game, a tournament, or both by allowing play in the cash game to count towards performance in a tournament. *See, e.g.*, claims 22, 29, and 35. Because players in tournaments are not assigned to a player pool until the player meets the predetermined duration, the claimed embodiments *provide for a level and convenience of play not previously achieved in the art.*

Id. at 6–7 (emphases added). Thus, Appellant touts the benefits provided by the claimed methods in the area of online gaming.

In response, the Examiner determines that the claims do not require online play and do not require the use of a computer, much less new computer hardware. Ans. 8. The Examiner also determines that the claims are similar to the claims at issue in *In re Smith*, 815 F.3d 816 (Fed. Cir. 2016) in that they are directed to a method of exchanging financial obligations, specifically, by specifying rules for conducting a wagering game. Ans. 6.

In reply, Appellant contends, “The subject matter of the present invention relates to online gaming. For example, the very first paragraph of the Specification sets out that the ‘present disclosure relates generally to

electronic gaming devices and systems, and more particularly to a system and method for online gaming.” Reply Br. 2. Appellant goes on to cite and quote other portions of the Specification and Figure 1 in support of this contention. *See id.* at 2–4.

The Examiner has the better position on this point. We agree with the Examiner that the *claims* do not require on-line play. The Specification supports this determination. *See* Spec. ¶ 16 (“Any network components capable of exchanging *audio*, video or other data using frames, packets *or otherwise* may be included within the scope of particular embodiments.”) (Emphases added). However, even assuming, *arguendo*, that the gaming system used in the method of claim 21 requires a computer network, the use of a computer network (including the internet) does not require a conclusion that the claims are not directed to an abstract idea. *See Internet Patents Corp. v. Active Network, Inc.*, 790 F3d 1343, 1348 (finding the idea of retaining information in the navigation of online forms to be abstract).

We also agree with the Examiner that the claims are analogous to the claims at issue in *Smith*, which recited rules for playing a game of Blackjack. *See Smith*, 815 F.3d at 817–818. In this regard, Appellant states that claims 21–40 “are directed to the improved management of online gaming tournaments for enhanced player experience.” Appeal Br. 7. Although the specific rules of the games that are part of the tournaments are recited only in dependent claims (*see, e.g.*, dependent claim 23 requiring the type of game to be “Hold ’Em”), representative claim 21 provides general rules for tracking play of players. *Id.* at 11–12 (Claims App.). In Appellant’s words, “Players are able to apply their performance in cash games to their tournament play, and they are placed in a playing pool only when they

complete the selected duration, so they can play at their leisure while still participating in tournament play.” *Id.* at 3. The recited rules for tracking the play of players and applying portions of this play toward a tournament are analogous to the specific rules for game play recited in the claims at issue in *Smith*, albeit the claims in the present appeal are more generic. Specifically, the recited rules manage whether a player’s gameplay in a game also applies to a tournament rather than only to whether a player wins or loses a particular game. *See* claim 21; *see also Smith*, 815 F.3d at 817.

Accordingly, we agree with the Examiner that claim 21 is directed to an abstract idea, similar to the claims at issue in *Smith*.

Step 2

Appellant relies on *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014) and asserts that, like the claims at issue in that case, the present claims recite “something more” than an abstract idea. Appeal Br. 8–10. In this regard, Appellant contends “the present claims do not attempt to preempt every application of the idea of managing online gaming tournaments.” *Id.* at 8.

In response, the Examiner states, “the [claims on appeal] do not address problems unique to the Internet, so contrary to Applicant’s arguments, *DDR Holdings* has no applicability.” Ans. 5. The Examiner finds that the method recited in claim 21 does not recite significantly more than the abstract idea discussed above, and, specifically, to the extent the use of a computer is required, conventional computers may be used. *See* Ans. 9.

In reply, Appellant states that the “gaming system” required by claim 21 “should be understood in light of the Specification as reciting a gaming

system which includes computer hardware components and network interface.” Reply Br. 6.

This argument is unavailing, because, as the Examiner correctly finds, to the extent a computer and network are required by claim 21, this hardware may be generic.

Appellant also argues that the method recited in claim 1 provides “an unconventional result and achieves an *improvement in the gaming system* by supporting non-traditional outcomes of tournaments. Also, as explained above, there is no real-world analogue to this outcome, so it must be that the claims perform steps which are more than routine.” Reply Br. 7 (emphasis added); *see also id.* at 5 (stating, “there can be no doubt, given the context of the Specification (as applied to a group of online players), the claims provide tournament play which provides the benefit that players can come and go as they please”).

We disagree with Appellant’s argument on this point because the “improved management of online gaming tournaments” (Appeal Br. 7) does not improve the computer or network itself. If we were to accept Appellant’s contention in this regard, then any new content provided via a computer or network could be considered such an “improvement.”

Appellant contends that “the prosecution history of the current application under appeal includes prior art rejections under §§ 102 and 103, which were overcome with amendments to the claims,” “the Examiner [essentially] admits that the claims recite new non-obvious limitations,” and, therefore, “the Examiner’s naked assertion that the claims recited ‘purely conventional steps’ is unfounded and inconsistent.” Reply Br. 7–8.

We disagree with Appellant on this point because even a novel and non-obvious claim directed to an abstract idea may be, nonetheless, patent-ineligible. *See Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 90 (2012); *see also Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981) (“The ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.”). Appellant does not dispute that the hardware Appellant alleges allows the method of claim 21 to be performed online is conventional. As for the particular order of the steps recited in claim 21, these steps and their sequence pertain to the abstract idea itself, i.e., these steps are analogous to the rules for the game claimed in *Smith*. Under such circumstances, the fact that these steps may patentably distinguish over prior art, obviating a rejection under sections 102 or 103, does not mean that they amount to significantly more than the abstract idea itself.

We have considered all of Appellant’s arguments regarding steps 1 and 2 of the *Alice* test for patent eligible subject matter, but find them unavailing. Accordingly, we sustain the Examiner’s rejection of these claims under 35 U.S.C. § 101.

DECISION

The Examiner’s decision to reject claims 21–40 is affirmed.

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Application 13/952,318

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

AFFIRMED