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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BENGT GREGORY-BROWN, DEREK HARP, and
BRAD MCQUAID¹

Appeal 2017-008426
Application 14/033,082
Technology Center 3700

Before CHARLES N. GREENHUT, JAMES P. CALVE, and
BENJAMIN D. M. WOOD, *Administrative Patent Judges*.

WOOD, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Appellants state that the real party in interest is Maslow Six Entertainment, Inc. App. Br. 2.

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 1, 4–9, 11–16, and 18. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

THE INVENTION

The claims are directed to a system and method for presenting a virtual game space with discoverable items to be prospected. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A system configured to provide a virtual game to a user, the system comprising:
 - one or more hardware processors configured by machine-readable instructions to:
 - determine a view of a virtual game space for presentation to a user, the virtual game space including different spatial zones, the virtual game space further including a rechargeable resource that is available to the user within the virtual game space and that is configured to recharge over time;
 - associate a limited number of discoverable items with individual ones of the spatial zones in the virtual game space such that a majority of the spatial zones in the virtual game space are not associated with discoverable items;
 - receive a user selection of an action to be performed from among a set of potential actions, the set of potential actions including a harvesting action and a locator action, the harvesting action including obtaining a discoverable item, the locator action including obtaining an indication of a location of a discoverable item, wherein:
 - the harvesting action is associated with a first cost, the first cost representing a deduction of a first amount of the rechargeable resource in the virtual game space; and

the locator action is associated with a second cost, the second cost representing a deduction of a second amount of the rechargeable resource in the virtual game space;

determine whether the selected action results in discovery of a discoverable item;

deduct the first amount of the rechargeable resource, responsive to the harvesting action being the selected action;

award the discoverable item to the user responsive to determining that the harvesting action results in discovery of a discoverable item;

deduct the second amount of the rechargeable resource responsive to the locator action being the selected action; and

indicate to the user whether the discoverable item would have been discovered if the selected action had been the harvesting action.

REJECTIONS

Claims 1, 4–9, 11–16, and 18 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 1, 4–9, 11–16, and 18 are rejected on the ground of non-statutory double patenting over claim 1–22 of U.S. Patent No. 8,540,566.

ANALYSIS

Claims 1, 4–9, 11–16, and 18—Non-statutory Subject Matter

Based on Appellants' arguments (Br. 4–7), we will decide the appeal of the claims at issue based on claim 1 alone. 37 C.F.R. § 41.37(c)(1)(iv).

To determine whether a claim falls within a judicially recognized exception to patent eligibility under 35 U.S.C. § 101, we apply the two-step framework set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289, 1293–94 (2012), and reaffirmed in *Alice*

Corporation Proprietary LTD. v. CLS Bank International, 134 S. Ct. 2347, 2355 (2014). For the first step, we determine whether the claims at issue are directed to a patent-ineligible concept such as an abstract idea, law of nature, or natural phenomenon. *Alice*, 134 S. Ct. at 2355 (citing *Mayo*, 132 S. Ct. at 1296–97). If so, we advance to the second step where “we 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” of the otherwise patent-ineligible concept. *Id.* (quoting *Mayo*, 132 S. Ct. at 1298, 1297). The Court has described this second step “as a search for an inventive concept—i.e., an element or combination of elements that is sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the ineligible concept itself.” *Id.* (citing *Mayo*, 132 S. Ct. at 1294 (internal quotation marks and alterations omitted)).

Regarding the first step in the *Alice* Framework, the Examiner finds that the claims are directed to “a multiple step process . . . for providing a virtual game.” Final Act. 3. According to the Examiner, “[t]he concept of providing a virtual game on a computer is very analogous to the concept of managing or providing a game of Bingo on a computer,” which the Federal Circuit held amounted to an abstract idea. *Id.* (citing *Planet Bingo, LLC v. VKGS LLC*, 576 Fed. Appx. 1005 (Fed. Cir. 2014)). The Examiner further determines that the “additional of limitations that narrow the idea, such as harvesting, associating cost, deducting an amount of rechargeable resources and spatial zones, further describe the abstract idea, but do not make it less abstract.” *Id.*

Regarding the second step, the Examiner finds that “the claim simply instructs the practitioner to implement the concept of providing a virtual game with routine conventional activity specified at a high level of generality in a particular technological environment.” *Id.* at 4. Thus, according to the Examiner, “[w]hen viewed either as individual limitations or as an ordered combination, the claim as a whole does not add significantly more to the abstract idea of providing a virtual game.” *Id.*

Appellants raise several arguments in response. First, Appellants argue that the claims are directed to patent-eligible subject matter because they are directed to “a specific technique to improve upon computer processes for utilizing computer technology to allow the solving of problems that arise in a game space or virtual space hosted over a network.” Br. 5. Second, Appellants argue that the claims are patent eligible because they “avoid pre-empting other, sub-optimal ways of performing the alleged abstract idea with a computer.” *Id.* Finally, Appellants argue that “a patent examiner cannot properly reject a claim under Section 101 if the examiner does not provide any evidence that at least a non-computer-implemented version of a computer-implemented process required by the claims exists in the prior art.” *Id.* at 6 (citing *McRO, Inc. v. Bandai Namco Games America Inc.*, 837 F.3d 1299 (2016)).

None of Appellants’ arguments persuade us of Examiner error. First, we are not persuaded that claim 1 is directed to “a specific technique to improve upon computer processes for utilizing computer technology,” as Appellants contend. Claims involving computer technology “might not succumb to the abstract idea exception” if they purport “to ‘improve the functioning of the computer itself,’ or ‘improv[e] an existing technological

process.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (quoting *Alice*, 134 S. Ct. at 2358–59). But methods that use computer technology “merely as a tool” may be considered directed to an abstract idea. *Id.* at 1336. Appellants contend that the claims are directed to techniques that provide guidance to computer game players to help them locate items in a virtual game space. Br. 5. While the claimed techniques may improve a player’s virtual gaming experience, Appellants do not explain how these techniques pertain to improvements to computer functionality. Nor is it evident that they do so, as the Specification indicates that the claimed methods are implemented with standard computer and networking technology. Spec. ¶¶ 22–24, Fig. 1.

We are also not persuaded that claim 1 is patent eligible because it has limited preemptive affect. That claim 1 may not preempt “an entire field” is not relevant to whether claim 1 is directed to an abstract idea, because “the exclusion applies if a claim involves a natural law or phenomenon or abstract idea, even if the particular natural law or phenomenon or abstract idea at issue is narrow.” *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1353 (Fed. Cir. 2014) (citing *Mayo*, 132 S. Ct. at 1303); *see also Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (holding that “[w]hile preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility”).

Finally, Appellants argue that “a patent examiner cannot properly reject a claim under Section 101 if the examiner does not provide any evidence that at least a non-computer-implemented version of a computer-implemented process required by the claims exists in the prior art.” *Id.* at 6

(citing *McRO*, 837 F.3d at 1314). Although Appellants' position is not entirely clear, Appellants appear to be arguing that, under *McRO*, a process implemented on a computer is not an abstract idea if the process is new. We do not read *McRO* as altering the Federal Circuit's prior disagreement with the notion that "the addition of merely novel or non-routine components to the claimed idea necessarily turns an abstraction into something concrete." *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014). Thus, it is not dispositive that the prior art does not teach "a non-computer implemented version" of any computer-implemented process required by the claims on appeal. See *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016) (holding that "a claim for a *new* abstract idea is still an abstract idea.").

Because we are not persuaded that the Examiner erred in rejecting claims 1, 4–9, 11–16, and 18 under 35 U.S.C. § 101 as directed to patent-ineligible subject matter, we sustain the rejection.

Claims 1, 4–9, 11–16, and 18—Non-statutory double patenting

Appellants have not responded to the Examiner's rejection of claims 1, 4–9, 11–16, and 18 on the ground of non-statutory double patenting over claims 1–22 of U.S. Patent No. 8,540,566. Therefore, Appellants have waived any argument of error, and we summarily sustain this rejection without reaching the merits thereof. See *In re Berger*, 279 F.3d 975, 984, 985 (Fed. Cir. 2002) (holding that the Board did not err in sustaining a rejection under 35 U.S.C. § 112, second paragraph, when the applicant failed to contest the rejection on appeal).

DECISION

For the above reasons, we affirm the Examiner's rejection of claims 1, 4–9, 11–16, and 18 as directed to patent-ineligible subject matter, and summarily affirm the Examiner's rejection of claims 1, 4–9, 11–16, and 18 on the ground of non-statutory double patenting.

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