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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARK L. YOSELOFF

Appeal 2017-009690
Application 13/399,141
Technology Center 3700

Before JEREMY M. PLENZLER, BRANDON J. WARNER, and
LISA M. GUIJT, *Administrative Patent Judges*.

WARNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Mark L. Yoseloff (“Appellant”)¹ appeals under 35 U.S.C. § 134(a) from the Examiner’s decision rejecting claims 1–9, 11–16, and 18–20, which are all the pending claims, under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. Appeal Br. 5; *see id.* at 10–43; Final Act. 3–16. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

¹ According to Appellant, the real party in interest is Bally Gaming, Inc. Appeal Br. 4.

CLAIMED SUBJECT MATTER

Appellant's disclosed invention "relates to wagering games, particularly wagering games using playing cards or images of playing cards, and wagering games played on casino tables, video machines, multi-player platforms or the internet." Spec. ¶ 2. Claims 1 and 11 are independent.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method of administering a wagering game using a 52-card deck of physical playing cards solely against a pay table defining a plurality of predetermined winning hand outcomes, the method comprising:

receiving an ante wager from at least one player in a designated ante wager area of a game table comprising a layout with the designated ante wager area, a designated first play wager area, and a designated second play wager area;

providing the at least one player with an initial partial hand of randomized physical playing cards to view;

after the at least one player has viewed the initial partial hand and before a complete player hand has been viewed by the at least one player, receiving from the at least one player a fold or an additional wager placed in the designated first play wager area of the game table;

providing at least one first additional physical playing card for use by the at least one player, the at least one first additional physical playing card being insufficient to form the complete player hand;

after receiving the additional wager from the at least one player in the designated first play wager area of the game table, after the at least one player has viewed the at least one first additional physical playing card, and before at least one second additional physical playing card has been viewed by the at least one player, receiving from the at least one player the fold or a second additional wager in the designated second play wager area of the game table;

providing the at least one second additional physical playing card to the at least one player; and

after the complete player hand has been formed, resolving all wagers received in the designated ante wager area, the designated first play wager area, and the designated second play wager area of the game table solely against the plurality of predetermined winning hand outcomes and not against a dealer hand.

PRINCIPLES OF LAW

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 consistently held that this provision contains an important implicit exception: laws of nature, natural phenomena, and abstract ideas are not patentable. *See Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014); *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972) (“Phenomena of nature, though just discovered, mental processes, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work.”).

Notwithstanding that a law of nature or an abstract idea, by itself, is not patentable, an application of these concepts may be deserving of patent protection. *See Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293–94 (2012). In *Mayo*, the Court stated that “to transform an unpatentable law of nature into a patent-eligible *application* of such a law, one must do more than simply state the law of nature while adding the words ‘apply it.’” *Mayo*, 132 S. Ct. at 1294 (citation omitted).

In *Alice*, the Court reaffirmed the framework set forth previously in *Mayo* “for distinguishing 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. 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 the claims are directed to a patent-ineligible concept, then 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 1298, 1297).

In other words, the second step is to “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 on the [ineligible concept] itself.’” *Id.* (brackets in original) (quoting *Mayo*, 132 S. Ct. at 1294). The prohibition against patenting an abstract idea “cannot be circumvented by attempting to limit the use of the formula to a particular technological environment or adding insignificant postsolution activity.” *Bilski v. Kappos*, 561 U.S. 593, 610–11 (2010) (citation and internal quotation marks omitted). The Court in *Alice* noted that “[s]imply appending conventional steps, specified at a high level of generality,” was not “*enough*” [in *Mayo*] to supply an “‘inventive concept.’” *Alice*, 134 S. Ct. at 2357 (quoting *Mayo*, 132 S. Ct. at 1300, 1297, 1294).

ANALYSIS

The claims at issue here are directed to a method of administering a wagering game using a standard deck of playing cards against a pay table that defines predetermined winning hand outcomes, including the steps of

receiving wagers from a player, dealing cards to form a player hand, and then resolving the wagers against the predetermined winning outcomes defined in the pay table. *See* Appeal Br., Claims App. In other words, the claims are directed to the idea of paying or collecting iterative wagers based on a comparison of a player hand against a pay table. *See id.*

The Examiner determines that the claims remain directed to patent-ineligible subject matter because, considering all elements both individual and in combination, the claims are directed to an abstract idea without significantly more. *See* Final Act. 3–16; Ans. 13–18. In light of the principles above, and for the reasons discussed below, we agree with the Examiner’s conclusion that the claims are directed to patent-ineligible subject matter.

Appellant argues that the claims use “unconventional” (new or different) rules—presumably, the iterative wagering in building to a complete player hand, to be resolved against a pay table—ensuring that the claims are directed to more than an abstract idea. *See* Appeal Br. 18–22; Reply Br. 3–4. We are not persuaded by Appellant’s argument.

In the first step of the *Alice* analysis, “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 (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016), *cert. denied*, 138 S. Ct. 469 (2017) (citing *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353–54 (Fed. Cir. 2016)). To this end, the Examiner calls attention to *In re Smith*, 815 F.3d 816 (Fed. Cir. 2016), where the Federal Circuit already considered claims similar to structure of this type—namely, “rules for playing a wagering game” (*id.*

at 817)—and affirmed a determination of patent-ineligibility for similarly structured claims directed to rules for conducting a wagering game. *See* Final Act. 9; Ans. 17–18.

In *Smith*, the Federal Circuit has already decided that rules for playing a wagering game, implemented using conventional elements, constitutes ineligible subject matter. Likewise, as the Examiner explains, the presently recited rules for administering a wagering game, also implemented using conventional elements, are similarly ineligible. *See* Ans. 18. Appellant does not apprise us of a meaningful distinction in the form or type of the claims between those presently recited and those previously adjudicated in *Smith*.

Further, to the extent that Appellant suggests that the alleged novelty of some particularities of the wagering game rules should indicate that the claims are transformed into patent-eligible subject matter, this suggestion is misplaced. *See* Appeal Br. 18–22; Reply Br. 3–4. An allegation that the claims involve new or different rules does not conflict with the Examiner’s conclusion of ineligibility under § 101 because “a claim for a *new* abstract idea is still an abstract idea.” *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016) (citing *Mayo*, 132 S. Ct. at 1304).

Whether the claimed concept is “[g]roundbreaking, innovative, or even brilliant . . . does not by itself satisfy the § 101 inquiry.” *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2117 (2013). Consequently, under the second step of the *Alice* analysis, an abstract idea does not transform into an eligible inventive concept just because the Examiner has not found prior art that discloses or suggests it. Indeed, “[t]he ‘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.” *Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981).

Given the binding precedent of our reviewing courts, we agree with the Examiner’s ultimate conclusion that the present claims are directed to patent-ineligible subject matter, particularly in light of the explanation provided at pages 14–18 of the Examiner’s Answer, where the Examiner applies the principles above.

In short, Appellant does not apprise us of a material difference in the form, structure, or substantive content of the recitations, between the claims recited and those claims already determined to be patent-ineligible by our reviewing courts. Thus, for this reason and those explained above, we are obliged to sustain the Examiner’s rejection.

DECISION

We AFFIRM the Examiner’s decision rejecting claims 1–9, 11–16, and 18–20 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.

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