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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CARDER STARR

Appeal 2018-000586
Application 13/888,519
Technology Center 2100

Before BRUCE WINSOR, BETH Z. SHAW, and
MICHAEL J. ENGLE, *Administrative Patent Judges*.

SHAW, *Administrative Patent Judge*.

DECISION ON APPEAL¹

Appellant seeks our review under 35 U.S.C. § 134(a) of the Final Rejection of claims 7–11 and 17–21. Claims 1, 3–6, and 12–16 are withdrawn. Final Act. 1. Claim 2 is cancelled. App. Br. 23. We have jurisdiction under 35 U.S.C. § 6(b).

Because we affirm at least one ground of rejection with respect to each claim on appeal, the Examiner’s decision rejecting claims 7–11 and

¹ Throughout this Decision we have considered the Appeal Brief filed April 24, 2017 (“App. Br.”), Reply Br. filed October 24, 2017, the Examiner’s Answer mailed August 24, 2017 (“Ans.”), and the Final Office Action mailed October 28, 2016 (“Final Act.”).

17–21 is affirmed. *See* 37 C.F.R. § 41.50(a)(1). We also enter a new ground of rejection under 37 C.F.R. § 41.50(b).

INVENTION

Appellant’s invention is directed to a word building game. Spec. ¶ 2.
Claims 7 and 21 are illustrative and reproduced below:

7. A method of playing a word building game, comprising:
receiving, by a first player, tiles depicting characters comprising at least a first language and a second or different language, the tiles with characters of the first language and the tiles with characters of the second or different language being used non-simultaneously;
forming, by the first player, a word from the characters using the first language within a playing environment having a plurality of character areas, the plurality of character areas including one or more change language areas;
and counting a point value for the word based on the numeric value of the characters used in the word,
whereby if the tiles selected by the first player depicting the first language engage the one or more change language areas, the tiles depicting the second or different language are subsequently used by a second player to build a word.

21. A method of playing a word building game with at least first and second players using specialized digital computing apparatus having a storage medium, comprising the steps of:
displaying for the players a digital grid forming a playing environment, the digital grid having an array of rows and columns, each of the rows and columns forming a plurality of 4-sided polygons,
wherein a first set of the 4-sided polygons includes score enhancing-related indicia for enhancing an assigned value of a formed word, and a second set of said 4-sided polygons including second indicia instructing the players to change a language used in the word building game;
storing in the storage medium acceptable words in a first language and a second language;
distributing to the first player, by the specialized digital computing apparatus, a plurality of digital tiles that may be placed on the digital grid and combined during game play to form words in the first and second

languages, each digital tile including a representation of a single character having an associated point value;

detecting, by said digital computing apparatus, when the players form a word across one of said second set of 4-sided polygons that include the second indicia instructing the players to change to the language;

assigning a score by said digital computing apparatus to words submitted for play by the players based in part on a value assigned to the characters in the words; and

verifying, by said digital computing apparatus, acceptability of the words played by accessing the storage medium to determine that the words being played are in a correct language based upon a determination that the immediately prior word was played across one of said second set of polygons that include said indicia instructing a player to change the language used in the word building game.

REJECTIONS

The Examiner rejected claim 21 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Final Act. 3–4.

The Examiner rejected claims 7–11 and 17–21 under 35 U.S.C. § 112, second paragraph, as being indefinite. Final Act. 5–11.

The Examiner rejected claims 8–11 under 35 U.S.C. § 101 as directed to non-statutory subject matter. Final Act. 12–13.

The Examiner rejected claims 7–11 and 17–21 under 35 U.S.C. § 103(a) as being unpatentable over Ogilvie, US 2011/0133405 A1 (June 9, 2011); Mattel Games, “How to Play Scrabble” (2003) (“Scrabble”); Miller, “Tower of Scrabble” (Sept. 16, 2007) (“Miller”), available at <http://www.washingtonpost.com/wp-dyn/content/article/2007/09/14/AR2007091401974.html>; and Rajat et al., “Scrabble for the Apple iPad” (Apr. 3, 2010) (“Rajat”), available at <https://www.youtube.com/watch?v=VdUznE15L30>. Final Act. 13–34.

CONTENTIONS AND ANALYSIS

We have reviewed Appellant's arguments in the Briefs, the Examiner's rejection, and the Examiner's response to Appellant's arguments.

Written Description Rejection

The Examiner finds the Specification does not support "verifying, by said digital computing apparatus, acceptability of the words played by accessing the storage medium to determine that the words being played are in a correct language based upon a determination that the immediately prior word was played across one of said second set of polygons that include said indicia instructing a player to change the language used in the word building game," as recited in claim 21. Final Act. 4. The Examiner finds that "verifying" is described in paragraph 25 of the Specification, but that the verifying is not done based on the claimed determination. *Id.*

We disagree. There is no requirement that the claimed invention be described in the identical wording that was used in the Specification; however, there must be sufficient disclosure to show one of skill in the art that the inventor "invented what is claimed." *Union Oil Co. of Cal. v. Atl. Richfield Co.*, 208 F.3d 989, 997 (Fed. Cir. 2000) (quoting *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989)). As Appellant argues, the Specification, including paragraphs 18, 19, 28, and 30, supports the claimed verification is done "based upon a determination that the immediately prior word was played across one of said second set of polygons that include said indicia instructing a player to change the language used in the word building game." More particularly, one of ordinary skill in the art would have understood that

the “verifying” of the acceptability of words described at paragraphs 25 and 28 is based on the dictionary of the language of play, and that the language of play is based on the last change in the language of play by playing a word across a polygon that indicates a change of language, as described in paragraphs 28 and 30. It follows that the acceptability of the *very next word* played after a change in language will be verified “based upon a determination that the *immediately prior word* was played across [a change language area],” as recited in claim 21 (emphasis added). *E.g.*, Spec. ¶ 30 (“When a word is played across a Change Language square that player must select a new language for the *next play(s)*”) (emphasis added).

Accordingly, we do not sustain the rejection of claim 21 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Indefiniteness Rejection

The Examiner rejected claims 7–11, and 17–21 under 35 U.S.C. § 112, second paragraph for: (i) conditional limitations (Final Act. 8–11) and (ii) being unclear and having elements lacking antecedent basis (Final Act. 5–8). With respect to the unclear elements, the Examiner provides some suggested corrections. *Id.* at 8.

First, Appellant argues the claimed words pointed out by the Examiner in claims 7, 8, 10, and 21 are not “conditional limitations.” App. Br. 15. With regard to the use of the word “may” in claim 21, we agree with Appellant that the specified limitation is not a conditional limitation because it limits the functionality of distributed digital tiles rather than setting forth

optional or alternative steps or functions.

With regard to the limitations using the word “if” in claims 7, 8, and 10 and the word “when” in claim 21, we agree with the Examiner that these limitations set forth a condition. *See Ex parte Schulhauser*, No. 2013-007847, 2016 WL 6277792, at *3–5 (PTAB Apr. 28, 2016) (precedential) (addressing a conditional step in a method); *id.* at *7 (addressing an “if” condition in a system claim); *see also* MANUAL OF PATENT EXAMINING PROCEDURE (MPEP) § 2111.04(II) (9th ed. Rev. 08.2017, Jan. 2018) (citing *Schulhauser*). We do not, however, agree that they render the claims indefinite, as they recite functional limitations (App. Br. 15), the metes and bounds of which can be ascertained by one of ordinary skill in the art. *See* MPEP § 2173 (“It is of utmost importance that patents issue with definite claims that clearly and precisely inform persons skilled in the art of the boundaries of protected subject matter.”).

Accordingly, we do not sustain this aspect of the rejection, i.e., the “conditional claims environment,” as a reason to reject claims 7, 8, 10, and 21.

However, with respect to the “unclear/lack of antecedent basis” portion of the Examiner’s rejection, Appellant generally states, without additional explanation, that the words of the claims are not unclear and do not lack antecedent basis. App. Br. 16. As the Examiner points out, Appellant does not explain why there is any error regarding this aspect of the rejection. Ans. 7. As such, Appellant’s arguments have not demonstrated error in this rejection. Specifically, we agree with the Examiner that at least the following limitations are unclear or lack antecedent basis: “the tiles

selected by the first player” in claim 7;² “*the* tiles depicting the first language,” “*the* tiles depicting the second or different language,” and “receiving *the tiles* from the players” in claim 8;³ “receiving *the characters*” in claim 10; and “based upon a determination that *the immediately prior word* was played across [a change language area]” in claim 21. *See* Final Act. 5–8; Ans. 8. Dependent claims 9, 11, and 17–20 do not resolve the deficiencies of the independent claims. *See* Final Act. 5. We therefore sustain the Examiner’s rejection of claims 7–11 and 17–21 under 35 U.S.C. § 112, second paragraph.

Section 101 Rejection

Appellant does not argue the § 101 rejection is in error. Rather, Appellant states that “when the Board reverses the Examiner on all other issues in this Brief, the Appellant will amend the preambles of claims 8–11 to a ‘non-transitory computer-readable carrier,’ where the words ‘non-transitory’ are added.” App. Br. 16. Consequently, we sustain the § 101 rejection of claims 8–11. We note that we can only render a decision as to claims as they are currently presented before us on appeal, and cannot speculate as to the scope of any potentially amended claims.

² In the event of further prosecution, the Examiner may wish to consider whether claim 7 lacks written description under § 112, first paragraph based on claim 7 requiring “the ‘second’ player uses [the tiles with characters of the second or different language] belonging to the ‘first’ player.” Ans. 8–9.

³ In the event of further prosecution, the Examiner also may wish to consider whether “the numeric value” in claims 7 and 8 lack antecedent basis.

Section 103 Rejection

Claim 21 recites, in part, “displaying . . . a second set of said 4-sided polygons including second indicia instructing the players to change a language used in the word building game.” In other words, claim 21 visually differentiates the set of polygons that are the change language areas from the other polygons that comprise the playing environment. Based on this record, we agree with Appellant that the Examiner has not shown or explained sufficiently how Miller or the other cited references teach this limitation. Therefore, we do not sustain the § 103 rejection of claim 21.

Although Appellants also argue the rejection of claims 7–11 and 17–20 under § 103, these claims are indefinite for the reasons discussed below. Because we are unable to determine the scope and meaning of claims 7–11 and 17–20, we cannot conduct the necessary inquiry for determining obviousness with respect to these claims, such as ascertaining differences between the claimed subject matter and the prior art. *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966); *see also In re Aoyama*, 656 F.3d 1293, 1298 (Fed. Cir. 2011) (quoting *Enzo Biochem, Inc. v. Applera Corp.*, 599 F.3d 1325, 1332 (Fed. Cir. 2010)) (“[A] claim cannot be both indefinite and anticipated.”); *In re Steele*, 305 F.2d 859, 862–63 (CCPA 1962) (reversing the Board’s decision of obviousness because it relied on “what at best are speculative assumptions as to the meaning of the claims”). Accordingly, we reverse the Examiner’s rejection of claims 7–11 and 17–20 under § 103 *pro forma*. The Examiner is free to consider § 103 again if the claims are

amended to overcome the indefiniteness issues discussed below.

REJECTION UNDER 37 C.F.R. § 41.50(b)

As a new ground of rejection using our authority under 37 C.F.R. § 41.50(b), claims 7–11 and 17–20 are rejected as indefinite under 35 U.S.C. § 112, second paragraph.

Independent claim 7 recites “receiving, by a first player, tiles depicting characters comprising at least a first language and a second or different language, *the tiles with characters of the first language and the tiles with characters of the second or different language being used non-simultaneously.*” Independent claims 8 and 10 recite commensurate limitations.

Figures 4 and 5 of the Specification depict “the playing grid . . . during game play . . . changing the language from English to Spanish.” Spec. ¶¶ 15, 17, 13, 19. In Figure 4, the English word “HAPPY” is placed over a change language area, thereby changing the language from English to Spanish. In Figure 5, the ‘A’ in the English word “HAPPY” is used for the Spanish word “GRACIAS”. Thus, the character ‘A’ is simultaneously both an English character and a Spanish character, and the character ‘A’ is simultaneously used in both an English word and a Spanish word. Applying Figure 5 to claim 7, the character ‘A’ falls within claim 7’s recitation of “the tiles with characters of the first language” because ‘A’ is a character of English, yet the character ‘A’ also falls within claim 7’s recitation of “the tiles with characters of the second or different language” because ‘A’ is a character of Spanish. In this example, every character in English is also a character in Spanish. Thus, in this example, any time a player uses a tile

with an English character on it, the player is simultaneously using a tile with a Spanish character on it.

During prosecution of an application, a rejection for indefiniteness is well-grounded if “language in a claim is ambiguous, vague, incoherent, opaque, or otherwise unclear in describing and defining the claimed invention.” *In re Packard*, 751 F.3d 1307, 1311 (Fed. Cir. 2014); *Ex parte McAward*, Appeal No. 2015-006416, 2017 WL 3669566, at *2 n.3 (PTAB Aug. 25, 2017) (precedential). Here, as presently written, it is unclear how “the tiles with characters of the first language” can be used “non-simultaneously” from “the tiles with characters of the second or different language” when all of the characters of the first language (English) also are characters of the second language (Spanish).

The Specification does disclose that a language’s “special characters . . . (such as the ‘ñ’ in Spanish) can only be used when the language-of-play is in that particular language.” Spec. ¶ 32. As presently written, however, claim 7’s “characters of the [first / second] language” are not limited to just “special” characters not found in the other language.

Dependent claims 9, 11, and 17–20 do not remedy the deficiencies in their respective independent claims and are indefinite for the same reasons.

CONCLUSION

We reverse the rejection of claim 21 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

We affirm the Examiner’s rejection of claims 7–11 and 17–21 under 35 U.S.C. § 112, second paragraph, as being indefinite for being unclear or lacking antecedent basis.

We affirm the rejection of claims 8–11 under 35 U.S.C. § 101.

We reverse *pro forma* the rejection of claims 7–11 and 17–20 under 35 U.S.C. § 103.

We reverse the rejection of claim 21 under 35 U.S.C. § 103.

In a new ground of rejection, we reject claims 7–11 and 17–20 under 35 U.S.C. § 112, second paragraph.

DECISION

We affirm the Examiner’s decision to reject claims 7–11 and 17–21.

We enter a new ground of rejection of claims 7–11 and 17–20.

Because we affirm at least one ground of rejection with respect to each claim on appeal, the Examiner’s decision rejecting claims 7–11 and 17–21 is affirmed. *See* 37 C.F.R. § 41.50(a)(1).

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides that “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides:

When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

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(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

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

37 C.F.R. § 41.50(b)