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EXAMINER

COLLINS, DOLORES R

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DANIEL DONN MILDER

Appeal 2018-004222
Application 14/207,507
Technology Center 3700

Before WILLIAM A. CAPP, JILL D. HILL, and
BRANDON J. WARNER, *Administrative Patent Judges*.

CAPP, *Administrative Patent Judge*.

DECISION ON RECONSIDERATION

STATEMENT OF THE CASE

Appellant¹ seeks our review under 35 U.S.C. § 134 of the final rejection of claims 2–7 under 35 U.S.C. § 101 as directed to patent-ineligible subject matter, and claims 1–22 under 35 U.S.C. § 103 over Brodrick (US 8,613,449 B2, iss. Dec. 24, 2013). We have jurisdiction under 35 U.S.C. § 6(b). We previously entered a Decision on Appeal on December 28, 2018, which we subsequently vacated on February 1, 2019.

Now, upon reconsideration, we AFFIRM the Examiner’s final rejection.

¹ Rainbow Dice Partnership is the Applicant and real party in interest.
Appeal Br. 1.

THE INVENTION

Appellant's invention is a wagering dice game. Spec. ¶ 1. Claim 2, reproduced below, is illustrative of the subject matter on appeal.

2. A method of playing a dice game comprising:
 - presenting a gaming table comprising a first side and a second side, said first side of said gaming table comprises:
 - a first section containing a plurality of color combinations,
 - a second section containing a plurality of color combinations wherein each combination contains one color and one blank,
 - a third section containing two blanks for colors that are the same,
 - a fourth section containing a plurality of color combinations that are less than the number of color combinations in said first section;said second side of said gaming table comprises:
 - a first section containing the same color combinations as in said first side's fourth section;
 - a second section containing a plurality of color combinations each of which comprises a combination with identical colors;
 - a third section containing a plurality of color combinations other than those in said second side's first section;receiving a plurality of wagers on said first side or said second side of said gaming table;
 - presenting a set of regular, non-standard, polyhedron dice comprising a plurality of identical die, each said die having an even number of faces and each said die having different color on each of its said faces;
 - wherein said first side and said second side contain pre-determined color combinations associated with rolling said pre-determined color combinations using said set of dice and wherein said pre-determined color combinations are assigned odds for wagering on the outcome of a roll of said set of dice;
 - rolling said set of dice to expose a top face of each said die;
 - identifying colors exposed on the top face of each said die after said rolling of said set of dice; and
 - resolving wagers placed in sections of said gaming table solely based on combinations of said colors exposed on said top surface of each said die.

PROCEDURAL POSTURE

On December 28, 2018, we entered a Decision reversing the Examiner's final rejection of all pending claims. *See* Decision, December 28, 2018. Substantially contemporaneous with our Decision, the Federal Circuit issued a decision in the case of *In re Marco Guldenaar Holding, B.V.*, 911 F.3d 1157 (Fed. Cir. 2018), which affirmed the Board's decision in *Ex parte Marco Guldenaar*, App. No. 2015-003656, 2017 WL 2797662 (PTAB June 20, 2017), which, in turn, affirmed an Examiner's rejections under 35 U.S.C. §§ 101 and 103.

As with the claims at issue in the instant case, the claims in *Guldenaar* are directed to a method of playing a dice game. *Guldenaar*, 911 F.3d at 1158. According to the appellant in *Guldenaar*, the primary novelty of that claimed invention is the indicia (or lack thereof) on the dice. *Id.* The Federal Circuit, in *Guldenaar*, held that the claimed dice game is a patent-ineligible application of an abstract idea. *Id.* at 1160. Furthermore, in *Guldenaar*, the Federal Circuit determined that the printed indicia on each die are not functionally related to the substrate of the die. *Id.* at 1161.

In view of the substantial similarity between the underlying facts of *Guldenaar* and the instant case, we entered an order vacating our December 28 Decision. *See* Order Vacating Decision on Appeal, February 1, 2019. In the February Order, we authorized Appellant to submit a supplemental brief to include, but not necessarily limited to, a discussion of the impact of *Guldenaar* as relates to the issues presented in the instant appeal. *Id.* at 4.

On March 1, 2019, Appellant filed its Supplemental Brief (hereinafter "Supp. Br."). The Supplemental Brief discusses *Guldenaar* as it relates to

the Section 101 and 103 issues on appeal in the instant case. *Id.* Having now had an opportunity to review Appellant’s Supplemental Brief and reconsider our previous decision in light of the Federal Circuit’s decision in *Guldenaar*, this Appeal is now ripe for a decision on the merits.

OPINION

35 U.S.C. § 101 – Ineligible Subject Matter

Appellant argues claims 2–7 as a group. Appeal Br. 8–24. We select claim 2 as representative. *See* 37 C.F.R. §41.37(c)(1)(iv).

The Supreme Court has set forth “a framework 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. v. CLS Bank Int’l*, 573 U.S. 208, 217 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs, Inc.*, 566 U.S. 66, 72–73 (2012)). According to the Supreme Court’s *Alice/Mayo* framework, we must first determine whether the claims at issue are directed to one of those concepts (*i.e.*, laws of nature, natural phenomena, and abstract ideas). *Id.* If so, we must secondly “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.” *Id.* The Supreme Court characterizes the second step of the analysis 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.* (quoting *Mayo*, 566 U.S. at 72–73).

The PTO recently published revised guidance on the application of § 101. *See* 2019 Revised Patent Subject Matter Eligibility Guidance, 84

Fed. Reg. 50 (“2019 Guidelines”). Under the guidelines, in conducting step one of the *Alice* framework, we first look to whether the claim recites:

- (Prong 1) any judicial exceptions, including certain groupings of abstract ideas; and
- (Prong 2) additional elements that integrate the judicial exception into a practical application.

Step 1, Prong 1

The 2019 Guidelines identifies three key concepts identified as abstract ideas: (a) mathematical concepts including “mathematical relationships, mathematical formulas or equations, mathematical calculations”; (b) certain methods of organizing human activity, such as “fundamental economic principles or practices,” “commercial or legal interactions,” and “managing personal behavior or relationships or interactions between”; and (c) mental processes including “observation, evaluation, judgment, [and] opinion.”

The Examiner determines that claims 2–7 are directed to the abstract idea of playing a game. Final Action 2. The Examiner further determines that any additional elements in the claims other than the abstract idea, when considered separately and in combination, are not sufficient to amount to significantly more than the abstract idea. *Id.*

Appellant argues that the Examiner’s determination that the dice game is directed to an abstract idea is conclusory. Appeal Br. 8. Appellant further argues that *In re Smith*, 815 F.3d 816, 819 (Fed. Cir. 2016) left open the possibility that games directed to new or original card decks could potentially survive a Section 101 challenge. Appeal Br. 9.

Movement of pieces and specific components upon the board—which is assigned pre-determined color combinations associated with a probability of rolling the pre-determined color

combinations using a set of *non-standard* dice and a *non-standard*, color-based board wherein the predetermined color combinations are assigned odds for wagering on the outcome of a roll of said set of dice—and players’ interactions therewith, provide a real world result, according to specific, defined, and repeatable rules of play, and result in a real world measurable outcome.

Id. at 9–10. Appellant further argues that the steps of claim 2 cannot be performed in the human mind. *Id.* at 17.

In response, the Examiner reiterates that Appellant’s claims are directed to rules for conducting a game. Ans. 3. The Examiner considers rules for conducting a game as analogous to other fundamental economic practices found abstract by the Supreme Court. *Id.* According to the Examiner, “applicant’s game is, effectively, a decision making process based on probabilities created by outcomes during the game.” *Id.*

Claim 2 is a method claim for playing a dice game and includes limitations directed to:

- “presenting a gaming table . . .”;
- “receiving . . . wagers on . . . said gaming table”;
- “presenting a set of . . . dice”;
- “rolling said set of dice . . .”;
- “identifying” indicia (colors) that appear face up on the dice; and
- “resolving wagers” based on the roll of the dice.

Claims App., claim 2. Thus, playing the game includes rolling a set of dice where each die in the set has a different color on each face thereof. *Id.* The game also includes a playing surface where areas of the playing surface are assigned pre-determined color combinations that may be obtained from rolling the dice. *Id.* The pre-determined color combinations are assigned

odds for wagering on the outcome of rolling the dice. *Id.* Essentially, all the claim does is what every risk based economic practice does, namely: (1) creates or determines a probabilistic outcome; and (2) generates a payout scheme based on the probabilistic outcome.

In the *Guldenaar* case, the Federal Circuit held that a substantially similar method of playing a wagering dice game falls under the concept of methods of organizing human activity. *Guldenaar*, 911 F.3d at 1160. Here, Appellant's claim 2 also recites playing a game, which is a personal interaction where humans follow rules or instructions. That is one of certain methods of organizing human activity, which is a judicial exception, namely, an abstract idea.

Step 1, Prong 2

Under Prong 2 of Step 1 of the *2019 Guidelines*, we do not assume that such claims are directed to patent ineligible subject matter because "all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas." *In re TLI Commc'ns LLC Patent Litig.*, 823 F.3d 607, 611 (Fed. Cir. 2016) quoting *Alice*. Instead, "the claims are considered in their entirety to ascertain whether their character as a whole is directed to excluded subject matter." *McRO, Inc. v. Bandai Namco Games America Inc.*, 837 F.3d 1299, 1312 (Fed. Cir. 2016). If the claims are not directed to an abstract idea, the inquiry ends. *2019 Guidelines*. If the claims are "directed to" an abstract idea, then the inquiry proceeds to the second step of the *Alice* framework. *Id.*

Consequently, we consider whether the claimed dice game includes additional elements that integrate the judicial exception into a practical application. A claim that integrates a judicial exception into a practical

application will apply, rely on, or use the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.

See 2019 Guidelines.

The Examiner determines that Appellant's colored dice and associated game surface, considered both individually and in combination, do not amount to significantly more than the abstract idea of playing a dice game. Final Action 3. We agree.

Appellant's dice game is played on a game table that is similar to, but somewhat distinct from, a Craps table. Spec. ¶ 8. Craps and other well-known dice games are typically played with six-sided dice where each side is marked with a numbered indicia, from one to six, usually in the form of a number of dots. The "Rainbow Dice" that are used in Appellant's game have an even number of sides with a different colored symbol or geometric form on each side. *Id.* ¶ 12. The game table has a first side (the "Single Roll" side) and a second side (the "Multiple Roll" side). *Id.* ¶¶ 9, 10. The Single Roll side of the game table is divided into bets on the outcome of any roll of the dice at any point in the game. *Id.* ¶ 9, Fig. 4 (right side of board). The Multiple Roll side of the game table is divided into several sections on which bets may be placed, such as a "Pass" line, a "Don't Pass" line, a section for "Exact Doubles" combinations, a section for "Exact Craps" combinations, and a section for "Exact Point" combinations. *Id.* ¶ 10, Fig. 4 (left side of board).

The fact that Appellant plays the game with colored dice and an associated game surface does not contribute to the patentability of the claimed subject matter and, therefore, does not amount to a "practical

application” of the abstract idea. In a nearly identical case, our reviewing court assigned no patentable weight to unconventional indicia on gaming dice. *Guldenaar*, 911 F.3d at 1161. The *Guldenaar* court reasoned that:

The markings on Appellant’s dice, however, constitute printed matter, as pointed out by the Board, and this court has generally found printed matter to fall outside the scope of § 101. *See AstraZeneca LP v. Apotex, Inc.*, 633 F.3d 1042, 1064 (Fed. Cir. 2010). “Claim limitations directed to the content of information and lacking a requisite functional relationship are not entitled to patentable weight because such information is not patent eligible subject matter under 35 U.S.C. § 101.” *Praxair Distrib., Inc. v. Mallinckrodt Hosp. Prod. IP Ltd.*, 890 F.3d 1024, 1032 (Fed. Cir. 2018). Each die’s marking or lack of marking communicates information to participants indicating whether the player has won or lost a wager, similar to the markings on a typical die or a deck of cards. Accordingly, the recited claim limitations are directed to information. Additionally, the printed indicia on each die are not functionally related to the substrate of the dice.

Id.

Here, the dice and game surface are merely incidental to playing the game in accordance with the claimed method. The Federal Circuit considered a nearly identical situation in *Guldenaar* and concluded that the dice game recited therein is directed to an abstract idea. The *Guldenaar* court stated:

In re Smith, 815 F.3d 816 (Fed. Cir. 2016), is highly instructive in this case. In *Smith*, we concluded that the claimed “method of conducting a wagering game” using a deck of playing cards was drawn to an abstract idea. We likened the claimed method to the method of exchanging financial obligations at issue in *Alice* and the method of hedging risk at issue in *Bilski*. *Id.* at 819. We agreed with the Board’s reasoning that “[a] wagering game is, effectively, a method of exchanging and

resolving financial obligations based on probabilities created during the distribution of the cards.” *Id.* at 818–19.

Guldenaar, 911 F.3d at 1160.

Here, Appellant’s claimed “method of playing a dice game,” including placing wagers on whether certain die faces will appear face up, is, as with the claimed invention in *Smith*, directed to a method of conducting a wagering game, with the probabilities based on dice rather than on cards. Given the strong similarities to the ineligible claims in *Smith*, Appellant’s claims likewise are drawn to an abstract idea.

Id.

Given the strong similarity between the instant case and *Guldenaar*, where the dice game was deemed “directed to” an abstract idea, we determine that Appellant’s dice game fails to integrate the judicial exception into a practical application and, therefore, is directed to an abstract idea.

Step 2

Turning to step two of the *Alice/Mayo* framework, the Examiner considers whether the claims contain an inventive concept sufficient to transform the abstract idea into patent eligible subject matter. Final Action 4. The Examiner considers rolling dice to be a purely conventional activity. *Id.* The “Examiner concludes that the claims represent ‘an attempt to claim a new set of rules for playing a game,’ which ‘qualifies as an abstract idea.’” *Id.* at 5, citing *Alice, supra*.

In traverse, Appellant attempts to analogize claim 2 to the claims in *BASCOM Glob. Internet Servs. v. AT&T Mobility LLC*, 827 F.3d 1341, 1350–51 (Fed. Cir. 2016). Appeal Br. 21. In *BASCOM*, the court found that, although that claimed invention is directed to the abstract idea of filtering content, the invention is not claiming the idea of filtering content

simply applied to the Internet. *BASCOM*, at 1351. According to the *BASCOM* court:

The '606 patent is instead claiming a *technology-based solution* (not an abstract-idea-based solution implemented with generic technical components in a conventional way) to filter content on the Internet that overcomes existing problems with other Internet filtering systems. By taking a prior art filter solution (one-size-fits-all filter at the ISP server) and making it more dynamic and efficient (providing individualized filtering at the ISP server), the claimed invention represents a “software based invention[] that *improve[s] the performance of the computer system itself.*”

Id. (emphasis added). In other words, *BASCOM*'s invention is a technological advance as it improves the performance of the computer system. *Id.* In contrast, Appellant just substitutes colors for dot indicia on the face of game dice, which is hardly a technological advance. We fail to see any correlation between the facts of *BASCOM* and the instantly claimed method for playing a dice game.

Appellant argues that step two of the *Alice/Mayo* analysis focuses on pre-emption and that the instant claims do not preempt the use of all methods of playing a game. Reply Br. 3. However, Appellant's attempt to leverage certain language in *BASCOM* regarding preemption to support an argument for patent eligibility in the instant case is not persuasive. Appeal Br. 21. The Federal Circuit appropriately addressed and disposed of this concern adversely to Appellant in *Guldenaar*:

“Abstract ideas, including a set of rules for a game, may be patent-eligible if [the claims] contain an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Smith*, 815 F.3d at 819 (quoting *Alice*, 573 U.S. at 221). Preemption is the underlying concern behind the abstract idea exception, but, at the same time, the Supreme

Court has made clear that merely appending conventional steps to an abstract idea is not enough for patent eligibility. *Mayo*, 566 U.S. at 81 The claims here recite the steps of placing a wager, rolling the dice, and paying a payout amount if at least one wagered outcome occurs—none of which Appellant on appeal disputes is conventional, either alone or in combination. . . . Just as the claimed steps of shuffling and dealing playing cards fell short in *Smith*, and recitation of computer implementation fell short in *Alice*, the claimed activities here are purely conventional and are insufficient to recite an inventive concept.

Guldenaar, 911 F.3d at 1161; *see also Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (“Where a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, as they are in this case, preemption concerns are fully addressed and made moot”).

In the Answer, the Examiner points out, correctly, that appending purely conventional steps to an abstract idea does not supply a sufficiently inventive concept. Ans. 4. The Examiner considers rolling dice to be a purely conventional activity. *Id.* We agree. We view Appellant’s game steps as no less conventional than the dice game that the Federal Circuit found ineligible in *Guldenaar*.

In reply, Appellant asserts that the claimed steps cannot be performed in the human mind. Reply Br. 1. Appellant emphasizes that the claimed game requires non-standard, non-traditional pieces, features, and components. *Id.* “[W]agers are resolved based on interplay between colors generated by non-standard . . . specified sections of a non-standard gaming table.” *Id.*

Here, Appellant’s dice game relies heavily on the existing game of Craps. Spec. ¶¶ 8–10. As such, the claimed invention entails well-understood, routine, conventional activities previously known to the industry. *Alice*, 573 U.S. at 225. Essentially, all Appellant has done here is to take the casino gambling game of Craps and modify it by altering the indicia on the faces of each die and then make corresponding modifications to the surface of the game board for placing wagers and receiving game payout. In the Supplemental Brief, Appellant attempts to distinguish *Guldenaar* by arguing that the instant steps are not purely conventional. Supp. Br. 6. However, the aspects of the game that Appellant argues are not “purely conventional” relate to the colored dice and associated printed indicia on the game table. *See generally* Supp. Br. As our reviewing court explained in *Guldenaar*, such indicia is not entitled to patentable weight for purposes of a Section 101 analysis. *Guldenaar*, 911 F.3d at 1160–61.

Taking into account that the allegedly distinguishing features of Appellant’s game, namely, the printed indicia on the dice and game table, is not entitled to patentable weight, the recited elements of claim 2, considered individually and as an ordered combination, do not constitute an “inventive concept” that transforms independent claim 2 into patent-eligible subject matter. On this record, we affirm the Examiner’s § 101 rejection of claim 2, as well as claims 3–7, which fall with claim 2.

*35 U.S.C. § 103 - Unpatentability of Claims 1–22
over Brodrick*

Appellant argues claims 1–22 as a group. Appeal Br. 24–30. We select claim 1 as representative. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner finds that Brodrick discloses the invention substantially as claimed, except for the specific contents of printed indicia on the gaming table, which the Examiner regards as non-functional printed matter that is not entitled to patentable weight. Final Action 4–7. Furthermore, the Examiner considers that any differences between Brodrick and the claimed invention in terms of betting outcomes amount to nothing more than mere design choice, which would be obvious to include in the game to add excitement to game play. *Id.* at 6.

Appellant argues, among other things, that Brodrick fails to disclose the color combinations and arrangements that the claimed invention employs on the face of the dice. Appeal Br. 24. Appellant differentiates between Brodrick’s use of colored dots on otherwise standard numeric/dot indicia dice and the non-standard coloring scheme used on Appellant’s dice. *Id.* at 25.

In response, the Examiner states that both Brodrick and the claimed game coordinate wagering outcomes based on indicia on the faces of the dice. Ans. 5. The Examiner treats the specific content of information displayed on the faces of the dice as non-functional descriptive matter and concludes that “there is no novel and unobvious functional relationship between the printed matter and that which is required for patentability.” *Id.* at 6.

In reply, Appellant emphasizes that Brodrick is silent as to the specific color combinations and arrangements in claim 1. Reply Br. 3. “Brodrick teaches only a purely numbers-based game using standard six-sided dice.” *Id.* Furthermore, in their Supplemental Brief, Appellant attempts to distinguish *Guldenaar* by relying on *In re Miller*, 418 F.2d 1392

(CCPA 1969) and *In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983). Supp. Br. 4.

Appellant's arguments are not persuasive. Although the Federal Circuit did not reach the alternative Section 103 obviousness ground of rejection in *Guldenaar*, the Federal Circuit explicitly distinguished *Miller* and *Gulack* with respect to whether printed indicia on dice is entitled to patentable weight. *Guldenaar*, 911 F.3d at 1161. Although such findings were in the context of affirming the Board's Section 101 decision, the findings carry persuasive force here with respect to whether Appellant's dice markings are entitled to patentable weight in a Section 103 analysis. Moreover, when *Guldenaar* appeared before the Board, our colleagues acknowledged that the Examiner properly distinguished *Gulack* from the underlying facts related to die markings. *Guldenaar*, 2017 WL 2797662, *4.

Contrary to arguments asserted by Appellant in the Supplemental Brief, we discern no patentable distinction between the die markings in *Guldenaar* and the die markings in Appellant's invention with respect to the printed matter doctrine. *Id.* Consequently, on reconsideration, we now determine that the die markings and game surface indicia recited in Appellant's claims are not entitled to patentable weight under the non-functional descriptive matter doctrine.

Once the printed matter issue is resolved in the Examiner's favor, Appellant raises no other arguments that are indicative of Examiner error. Accordingly, we sustain the Examiner's Section 103 obviousness rejection of claims 1–22.

Appeal 2018-004222
Application 14/207,507

DECISION

The decision of the Examiner to reject claims 2–7 under 35 U.S.C. § 101 is AFFIRMED.

The decision of the Examiner to reject claims 1–22 under 35 U.S.C. § 103 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)(1)(iv). *See* 37 C.F.R. § 41.50(f).

AFFIRMED