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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARK H. SMALL¹

Appeal 2018-005259
Application 14/047,370
Technology Center 3700

Before BIBHU R. MOHANTY, MICHAEL C. ASTORINO, and
CYNTHIA L. MURPHY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1, 2, and 4–30 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Small Games, Co. (App. Br. 2.)

THE INVENTION

The Appellant's claimed invention relates to a crossword-type game played with letters to make words on a grid (Spec. 1, lines 7–9). Claim 11, reproduced below with the italics added, is representative of the subject matter on appeal.

11. A method of operating a crossword game system for playing a crossword game in an electronic environment, including:
 - storing the game program on a system server;
 - connecting a plurality of player playing devices to said system server when each player logs on;
 - providing each player with an identical electronic grid *game board on which to build words and crosswords*;
 - providing each player with an identical set of electronic alphabet letter tiles* with the identical set of respective point values with which to build words and crosswords, *said tiles each electronically having a point value* selected from one to three, wherein there may be duplicate alphabet letter tiles with identical or different point values;
 - providing each player with a set of three wild tiles each, exclusively, having one of the point values from one to three, wherein each of said wild tiles may be interchanged with a tile of any alphabet letter, being assigned the same point value as the wild tile interchanged; and*
 - connecting an administrator console* to said server, said administrator console being usable *to upload* a new one of the set of electronic alphabet letter tiles and three wild tiles to said server for *each day as a DAILY CHALLENGE crosswords game competition to the players*;
 - wherein said set of electronic alphabet tiles contains 21 tiles, and wherein said electronic grid game board is 7-by-7 rows and columns, thereby providing 49 letter tile blocks; and
 - wherein each player plays the game individually* such that the play of each individual player during a game is not affected by the play of other players or any opponent.

THE REJECTIONS

The following rejections are before us for review:

1. Claims 1, 2 and 4–30 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter (i.e., an abstract idea) without significantly more.

2. Claims 1, 2 and 4–30 are rejected under 35 U.S.C. § 103(a) as unpatentable over Patnoe (US 2013/0231167 A1, pub. Sept. 5, 2013) and *Crossword Scrabble, SoloWords, Webcrosswords.com* (last visited: Aug. 20, 2010) (“SoloWords”).

FINDINGS OF FACT

We have determined that the findings of fact in the Analysis section below are supported at least by a preponderance of the evidence².

ANALYSIS

Rejection under 35 U.S.C. § 101

The Appellant argues that the rejection of claim 11 is improper because the claim is not directed to an abstract idea (App. Br. 18–25; Reply Br. 3–7). The Appellant further argues that the claim is “significantly more” than the alleged abstract idea (App. Br. 25, 35; Reply Br. 8–16).

In contrast, the Examiner has determined that the rejection of record is proper (Final Action 3–9, 24–35; Ans. 3–9, 20–39).

² See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

We agree with the Examiner. An invention is patent eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. However, the Supreme Court has long interpreted 35 U.S.C. § 101 to include implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g.*, *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

In determining whether a claim falls within an excluded category, we are guided by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 217–18 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012)). In accordance with that framework, we first determine what concept the claim is “directed to.” *See Alice*, 573 U.S. at 219 (“On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk.”); *see also Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk”).

Concepts determined to be abstract ideas, and thus patent ineligible, include certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 69 (1972)). Concepts determined to be patent eligible include physical and chemical processes, such as “molding rubber products” (*Diamond v. Diehr*, 450 U.S. 175, 192 (1981)); “tanning, dyeing, making waterproof cloth, vulcanizing India rubber, smelting ores” (*id.* at 182 n.7 (quoting *Corning v. Burden*, 56 U.S.

252, 267–68 (1854)); and manufacturing flour (*Benson*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

In *Diehr*, the claim at issue recited a mathematical formula, but the Supreme Court held that “[a] claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula.” *Diehr*, 450 U.S. at 187; *see also id.* at 191 (“We view respondents’ claims as nothing more than a process for molding rubber products and not as an attempt to patent a mathematical formula.”). Having said that, the Supreme Court also indicated that a claim “seeking patent protection for that formula in the abstract . . . is not accorded the protection of our patent laws, and this principle cannot be circumvented by attempting to limit the use of the formula to a particular technological environment.” *Id.* (internal citation omitted) (citing *Benson* and *Flook*); *see, e.g., id.* at 187 (“It is now commonplace that an *application* of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.”).

The PTO recently published revised guidance on the application of § 101. *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Guidance”). Under the Guidance, we first look to whether the claim recites:

- (1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activity such as a fundamental economic practice, or mental processes); and
- (2) additional elements that integrate the judicial exception into a practical application, i.e., evaluate whether the claim “appl[ies], rel[ies] on, or use[s] 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* Guidance, 84 Fed. Reg. at 54; *see also* MPEP § 2106.05(a)–(c), (e)–(h)).

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look to whether the claim:

(3) adds a specific limitation beyond the judicial exception that is not “well-understood, routine, conventional” in the field (*see* MPEP § 2106.05(d)); or

(4) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

See Guidance.

If the claim is “directed to” an abstract idea, we turn to the second step of the *Alice* and *Mayo* framework, where “we must examine the elements of the claim to determine whether it contains an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Alice*, 573 U.S. at 221 (citation omitted). “A claim that recites an abstract idea must include ‘additional features’ to ensure ‘that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].’” *Id.* (alterations in original) (quoting *Mayo*, 566 U.S. at 77). “[M]erely requir[ing] generic computer implementation[] fail[s] to transform that abstract idea into a patent-eligible invention.” *Id.*

The Specification at page 1 states that the invention generally relates to a “crossword-type game played with letters to make words on a grid”. The Examiner has determined that the claim sets forth a variation of a known crossword games having rules for conducting the game and are directed to organizing human activities and an abstract concept (Ans. 21). We substantially agree with the Examiner. Here, the claim sets forth a method of playing a crossword game subject to a series of rules which is a

certain method of organizing human activities i.e. a judicial exception. *In re Smith*, 815 F.3d 816 (Fed. Cir. 2016) held a claimed “method of conducting a wagering game” using a deck of playing cards was drawn to an abstract idea. *In re Marco Guldenaar Holding B.V.*, 911 F.3d 1157 (Fed. Cir. 2018) held that a method of playing a dice game with a wager was an abstract concept. In that case it was held that claims directed to the “rules for playing a dice game” were held to be an abstract concept. *Id.* at 1160, 1161. Here, the claims at issue here are largely drawn to a crossword game and similarly a game subject to a set of rules and we thus consider the claim set forth a certain method of organizing human activities, i.e., a judicial exception.

Thus, we consider the claim to recite a judicial exception as identified above.

We next determine whether the claim recites additional elements in the claim to integrate the judicial exception into a practical application. *See* Guidance, 84 Fed. Reg. at 54–55. The Revised Guidance references the MANUAL OF PATENT EXAMINING PROCEDURE (“MPEP”) §§ 2106.05(a)–(c) and (e)–(h).

Here, the claims do not improve computer functionality, improve another field of technology, utilize a particular machine, or effect a particular physical transformation. Rather, we determine that nothing in the claims imposes a meaningful limit on the judicial exception, such that the claims are more than a drafting effort to monopolize the judicial exception.

For example, in claim 11 the steps of [1] “storing the game program”, [2] “connecting a plurality of player playing devices to said system server”, [3] “providing each player with an identical electronic grid game board”, [4]

providing each player with an identical set of electronic alphabet letter tiles”, [5] “providing each player with a set of three wild tiles each”, and [6] “connecting an administrator console to said server” are merely steps performed by a generic computer that do not improve computer functionality. That is, these recited steps [1]–[6] “do not purport to improve the functioning of the computer itself” but are merely generic functions performed by a generic processor. Likewise, these same steps [1]–[6] listed above do not improve the technology of the technical field and merely use generic computer components and functions to perform the steps. Also, the recited method steps [1]–[6] above do not require a “particular machine” and can be utilized with a general purpose computer, and the steps performed are purely conventional. In this case the general purpose computer is merely a tool to perform the above-identified abstract idea. Further, the claim as a whole fails to effect any particular transformation of an article to a different state. The recited steps [1]–[6] fail to provide meaningful limitations to limit the judicial exception and rather are mere instructions to apply the abstract idea with a generic computer.

Considering the elements of the claim both individually, and as an ordered combination, the functions performed by the computer system at each step of the process are purely generic. Each step of the claimed method does no more than require a generic computer to perform a generic computer function. Thus, the claimed elements have not been shown to integrate the judicial exception into a practical application as set forth in the Revised Guidance which references the MANUAL OF PATENT EXAMINING PROCEDURE (“MPEP”) §§ 2106.05(a)–(c) and (e)–(h).

Turning to the second step of the *Alice* and *Mayo* framework, we determine that the claim does not contain an inventive concept sufficient to “transform” the abstract nature of the claim into a patent-eligible application. The claim both individually and as an ordered combination fails to add subject matter beyond the judicial exception that is not well-understood, routine, and conventional in the field. Rather the claim uses well-understood, routine, and conventional activities previously known in the art and they are recited at a high level of generality. The Specification at page 10 for example describes using conventional computer components such as a PC, the Internet, and a server in a conventional manner. The claim specifically includes recitations for computers to implement the method but these computer components are all used in a manner that is well-understood, routine, and conventional in the field. Thus, the record evidences that the claimed computer components which are used to implement the claimed method are well understood, routine, or conventional in the field; and the Appellant has not persuasively shown otherwise.

For these above reasons the rejection of claim 1 is sustained. The Appellant has provided the same or similar arguments for the remaining claims which are drawn to similar subject matter and the rejection of these claims is sustained as well.

Rejection under 35 U.S.C. § 103(a)

The Appellant argues that the rejection of claim 1 is improper because the cited prior art fails to disclose the claim limitations for:

providing each player with an identical electronic grid game board on which to build words and crosswords; providing each player with a set of three wild tiles each, exclusively, having

one of the point values from one to three, wherein each of said wild tiles may be interchanged with a tile of any alphabet letter, being assigned the same point value as the wild tile interchanged; and wherein said set of electronic alphabet tiles contains 21 tiles, and wherein said electronic grid game board is 7-by-7 rows and columns, thereby providing 49 letter tile blocks.

(App. Br. 69, 70).

In contrast, the Examiner at pages 36 and 37 of the Answer has determined that rejection of record discloses or suggests the cited claim limitations.

We agree with the Examiner. Here, Patnoe for instance discloses a grid board (Fig. 2), tiles with letter and point values (para. 20), the use of “wildcard tiles” (para. 22), as well as being used in an electronic game format. SoloWords describes using a “crossword” scrabble type format. We agree with the Examiner that the claimed use of 7-by-7 rows and column format would have been obvious in the cited combination as one of ordinary skill in the art would have readily inferred that the size of the game board could be varied based on the skill of the individual players. The Appellant also argues that neither Patnoe nor SoloWords disclose a “crossword where the words can overlap by having letters in common” (App. Br. 69), but this is not a limitation to the claim. Regardless, SoloWords does disclose a “crossword scrabble” game where such a feature is known.

The Appellant also argue that Patnoe is not a prior art reference by providing a Declaration to show the Appellant conceived and reduced to practice the invention of claims 1, 2, and 4–30 prior to the filing date of Patnoe (App. Br. 74). The Examiner has determined that the Declaration and Exhibit A (Wordstar) fail to disclose facts to establish the claim

limitation for “wherein each player’s total score is counted after the player has completed the game, as a function of word point values being cumulative of individual tile point values and any bonus points and any point deductions, for comparison of that player’s total score with one or more other players’ total scores” (Ans. 37, 38 (emphasis omitted)). We agree with the Examiner’s determination in this regard. With regard to claim 11, it is unclear that the Wordstar document provides support, for example, “duplicate alphabet letter tiles or different point values”. With regard to claim 25, the exhibit fails to provide support for the claimed connection to a “FACEBOOK play selection”. With regard to claim 26, the exhibit fails to provide support for the claim limitation “said server programmable structure being capable of manipulating the movement of said alphabet tiles to said grid game board in response to instructions from a player’s electronic communications device”.

Thus, we agree with and adopt the Examiner’s determination and the rejection of claim 1 is sustained. The Appellant has provided the same or similar arguments for claims 11, 25 and 26 which are drawn to similar subject matter and the rejection of these claims is sustained as well.

CONCLUSIONS OF LAW

We conclude that the Appellant has not shown that the Examiner erred in rejecting claims 1, 2 and 4–30 under 35 U.S.C. § 101.

We conclude that the Appellant has not shown that the Examiner erred in rejecting claims 1, 2 and 4–30 under 35 U.S.C. § 103(a) as unpatentable over Patnoe and SoloWords.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 2, 4-30	101	Eligibility	1, 2, 4-30	
1, 2, 4-30	103	Patnoe, SoloWords	1, 2, 4-30	
Overall Outcome			1, 2, 4-30	

TIME PERIOD FOR RESPONSE

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