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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CAMERON A. FILIPOUR

Appeal 2018-005263
Application 14/169,869
Technology Center 3700

Before JENNIFER D. BAHR, LINDA E. HORNER, and
MICHELLE R. OSINSKI, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON REHEARING

STATEMENT OF THE CASE

Appellant¹ filed a request for rehearing under 37 C.F.R. § 41.52 (“Request”) of our decision of February 13, 2020 (“Decision”). In the Decision, we affirmed the Examiner’s rejection of claims 1–20 under 35 U.S.C. § 101. Appellant argues in the Request that the Board “misapprehended significant portions of representative claim 1 as being directed to abstract ideas, when those portions of claim 1 are in fact not abstract ideas but instead are ‘additional elements’ that integrate the judicial

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as IGT. Appeal Br. 2.

exception into a practical application.” Request 1. Appellant also argues that the Board “failed to review the claim as a whole” when it determined whether claim 1 recites such additional elements, and the Board “misapprehended [Appellant’s] arguments” advanced in its Supplemental Brief and at the oral hearing. *Id.* at 1–2.

For the reasons provided below, Appellant’s Request is *denied*.

ANALYSIS

A request for rehearing “must state with particularity the points believed to have been misapprehended or overlooked by the Board.” 37 C.F.R. § 41.52(a).

Step 2A, Prong 1

Appellant first argues in its Request that the Board erred in finding each of steps (a) through (h) of claim 1 to be a “fundamental part of exchanging and resolving financial obligations based on probabilities” akin to the “fundamental economic practice” in *Alice*.² Request 4. Specifically, Appellant argues that steps (f) and (g) of claim 1 are not directed to a fundamental economic practice. *Id.* at 4–6. We address each of the specifically argued steps below.

Step (f)

As to step (f), Appellant argues that the “specificity” of step (f), which “is carried out in software and results in a special-purpose gaming system/machine, takes step (f) outside of the realm of an abstract idea.”³ *Id.*

² *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208 (2014).

³ According to Appellant, step (f) “introduces the concept of a secondary game” and “makes clear [that] the secondary game progresses based at least in part on certain events that randomly occur during play of the primary game.” Request 4.

at 4. Appellant explains that this specificity is directed to the “structure and functionality” of the gaming system:

The structure is the components found in the claim (e.g., primary game, secondary game having object visitation areas (each area being associated with one of the primary themes from the primary game), a secondary game object, etc.), while the function describes the operation of the components (e.g., displaying the secondary game object in association with the determined object visitation area, determining if the primary theme associated with the determined object visitation area is different than the primary theme of the current primary theme of the primary game, and changing the theme of the primary game to the theme associated with the determined object visitation area).

Id. at 5. Appellant argues that “[s]tep (f) is not some fundamental economic practice like hedging or mitigating settlement risk.” *Id.*

Appellant argues that the Board “tacitly admitted as much” by finding that even if step (f) goes beyond exchanging and resolving financial obligations based on probabilities, the recited limitations pertain to managing personal behavior. *Id.* at 5 (citing Decision 12). Appellant argues that this alternative finding by the Board also is erroneous because “step (f) has nothing to do with ‘managing’ the player;” it pertains to “how the gaming system software is designed and constructed.” *Id.*

Appellant also takes issue with the Board’s finding that step (f) recites “merely ‘rules’ for how to play the game.” Request 6. Appellant argues that “[t]he specificity in the claim is directed to how the gaming system/machine is structured and functions, not on any rules that the player has to follow.” *Id.*

In the Decision, we found that step (f), including substeps (A) through (D), “amounts to instructions for determining a particular award, i.e., the

award of a secondary game, based on play of the primary game.” Dec. 12 (discussing steps as described in Spec. ¶¶ 44, 46). Based on the description provided in the Specification, we determined that “[t]his step and its subordinate steps are merely rules of conducting the wagering game, including how the game is displayed to the user based on the user’s past play” and, thus, “[t]his step and its subordinate steps are a fundamental part of exchanging and resolving financial obligations based on probabilities.” *Id.*

Contrary to Appellant’s characterization, our Decision made no “tacit admission” that the steps are more than exchanging and resolving financial obligations based on probabilities. Rather, in our Decision we further noted the limitations also are directed to “managing personal behavior” by awarding a secondary game and selection of theming based on the user’s past play. *Id.* at 12–13.

Appellant’s arguments on rehearing simply reiterate arguments presented in its briefs and at oral hearing. We considered these arguments in reaching our Decision. Specifically, we understood that step (f) introduces a secondary game that progresses based on events occurring during play of a primary game. Dec. 12. Appellant has not pointed out any aspect of Appellant’s arguments that we misapprehended or overlooked as to step (f) in our Decision.

Step (g)

As to step (g), Appellant argues that “[d]etermining which video segment to play based on the location of the secondary game object upon a second triggering event that happens during the play of the primary game

can hardly be considered a fundamental economic practice like ‘mitigating settlement risk’ or ‘hedging risk.’” Request 6.

Appellant argues that the Board “tacitly admitted as much” by finding that even if step (g) goes beyond exchanging and resolving financial obligations based on probabilities, the recited limitations pertain to managing personal behavior. *Id.* (citing Decision 13). Appellant argues that this alternative finding by the Board also is erroneous because “step (g) has nothing to do with ‘managing’ the player;” it pertains to “how the gaming system software is designed and constructed.” *Id.*

Appellant also takes issue with the Board’s finding that step (g) recites “merely ‘rules’ for how to play the game.” Request 6. Appellant argues that “[t]he specificity in the claim is directed to how the gaming system is structured and functions, not on any rules that the player has to follow.” *Id.*

In the Decision, we found that step (g), including substeps (A) and (B), “amounts to instructions for determining a particular award for the secondary game, i.e., the award of display of a video segment, based on play of the primary game.” Dec. 13 (discussing steps as described in Spec. ¶ 59). Based on the description provided in the Specification, we determined that “[t]his step and its subordinate steps are merely rules of conducting the wagering game and how awards are provided to the user based on the user’s play” and, thus, “[t]his step and its subordinate steps are a fundamental part of exchanging and resolving financial obligations based on probabilities.” *Id.*

Contrary to Appellant’s characterization, our Decision made no “tacit admission” that the steps are more than exchanging and resolving financial

obligations based on probabilities. Rather, in our Decision we further noted the limitations also are directed to “managing personal behavior” by awarding a video segment for play of a secondary game so as to keep the player interested in playing the game. *Id.*

Appellant’s arguments on rehearing simply reiterate arguments presented in its briefs and at oral hearing. We considered these arguments in reaching our Decision. Specifically, we understood that step (g) determines which video segment to play (an award) based on certain conditions recited in the claim. Dec. 13. Appellant has not pointed out any aspect of Appellant’s arguments that we misapprehended or overlooked as to step (g) in our Decision.

Step 2A, Prong Two

Appellant argues that because the Board misapprehended steps (f) and (g) of claim 1, the Board further erred by not considering these steps in its analysis of whether claim 1 recites additional elements that integrate the alleged abstract idea into a practical application. Request 7. Appellant argues that steps (f) and (g) integrate the wagering game into a practical application that is “a special-purpose gaming system/machine configured to operate in a very particular manner.” *Id.* As discussed above, we do not find error in our determination, discussed above under Step 2A, Prong One, that the claimed subject matter of steps (f) and (g), when considered individually and as a whole, recite a judicial exception. *See also* Dec. 14–15 (considered the claimed steps individually and in combination).

Appellant argues that the Board misapprehended Appellant’s argument. Request 8–9. Specifically, Appellant argues that the Board did not understand Appellant’s reliance on the specificity of steps (f) and (g).

Id. For instance, Appellant asserts that the Board misapprehended its argument distinguishing the claimed subject matter from the claims found patent eligible in *Smith*.⁴ *Id.* at 9. Appellant argues “that the gaming system in claim 1 is analogous to a new, unique and unconventional deck of cards that the Federal Circuit said would not be abstract.” *Id.*

Rather than misapprehend or overlook this asserted distinction, we considered and specifically addressed this argument on pages 18–20 of our Decision and concluded:

Appellant’s argument that the combination of its specific rules for conducting a wagering game on a general-purpose computer creates a special purpose computer that amounts to a practical application of the abstract idea misses the mark. Appellant is asking us to ignore the holding of *Smith*. In *Smith*, the court did not find that the combination of the new rules for playing a game with a conventional deck of cards creates a special purpose deck of cards. Likewise, in this case, Appellant has not imposed meaningful limits on the rules for playing a game simply by programming a general-purpose computer to perform them.

Dec. 20.

Appellant’s arguments in rehearing reiterate arguments presented in the briefs and at oral argument. As shown from the excerpt of our Decision provided above, we understood Appellant’s arguments in these pleadings but disagreed with them. Appellant has not persuaded us that we misapprehended these arguments.

Appellant also argues that the Board misapprehended Appellant’s focus in the Supplemental Appeal Brief and at oral hearing on other aspects of claim 1 as an abandonment of previous arguments made in its earlier

⁴ *In re Smith*, 815 F.3d 816, 817–18 (Fed. Cir. 2016).

briefs about the physical elements of the claim. Request 9–10. Appellant argues that just because it chose not to emphasize these physical components at the hearing does not mean that it abandoned the argument. *Id.* at 10.

At the oral hearing, Appellant was asked to clarify its position on appeal, and Appellant responded that the basis of its argument for patent eligibility of the claimed subject matter was not based on the claimed “physical components” of “an acceptor or an input or an output device”:

MS. HORNER: So you’re not contesting -- I understood your argument to say that this had to be, because of the way the claim was written, it had to be performed on a I’ll call it a dedicated gaming machine because there’s an acceptor. So are you changing that? Are you conceding that the examiner’s position, this could be done with a general purpose computer and a scanner is a correct interpretation of the claim language?

MR. GANNON: I think that part of it using a, you know, an acceptor or an input or an output device, those physical components, those were added to the claim, but *that’s not the basis of the argument.*

The basis of the argument is what’s new, again, is the new 52 card deck. It’s the new software carried out -- the new system carried out in the software is our argument on step 2.

Tr. 10:17–11:8 (emphasis added). Appellant’s belated attempt to characterize this statement as something other than a shift in its argument away from reliance on components of an asserted dedicated gaming machine is disingenuous.

Even if we treat these arguments as not conceded, we agree with the Examiner’s claim construction that the “physical components” are broadly recited to encompass a general purpose computer, and are not limited to a dedicated gaming machine. The basis for this claim construction is set forth in detail on pages 7–8 and 13–15 of the Examiner’s Answer. *See also* Dec.

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16–18 (adopting the Examiner’s interpretation of the claim language as reading on a general-purpose computer, and determining, alternatively, that these components are not adequate to impose a meaningful limit on the judicial exception).

CONCLUSION

For the reasons provided above, Appellant’s Request for Rehearing is denied.

DECISION SUMMARY

Final Outcome of Decision on Rehearing

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Denied	Granted
1–20	101	Patent ineligible subject matter	1–20	

Final Outcome of Appeal after Rehearing:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–20	101	Patent ineligible subject matter	1–20	

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).

DENIED