



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/726,295	12/24/2012	Douglas M. Okuniewicz	0A9658-301006	4268
32009	7590	07/02/2020	EXAMINER	
BRADLEY ARANT BOULT CUMMINGS LLP 200 CLINTON AVE. WEST SUITE 900 HUNTSVILLE, AL 35801			PANDYA, SUNIT	
			ART UNIT	PAPER NUMBER
			3649	
			NOTIFICATION DATE	DELIVERY MODE
			07/02/2020	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

HSVIPDOCKETING@bradley.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DOUGLAS M. OKUNIEWICZ

Appeal 2018-006967
Application 13/726,295
Technology Center 3600

Before ANNETTE R. REIMERS, BRANDON J. WARNER, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

REIMERS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–22. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the term “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real parties in interest as Douglas M. Okuniewicz and AIM Management. Appeal Brief (“Appeal Br.”) 2, filed Jan. 2, 2018.

CLAIMED SUBJECT MATTER

The claims are directed to data-based awards for an electronic gaming device. Claims 1 and 2, the independent claims, reproduced below, are representative of the claimed subject matter:

1. A method for electronic gambling, comprising:
 - receiving a wager from a player at an electronic gaming device;
 - generating an outcome for the wager with the electronic gaming device;
 - displaying an outcome associated with the wager by the electronic gaming device; and
 - step for emailing an email attachment, where the attachment comprises an award comprised entirely of data as a payment to the player.

2. A method for electronic gambling, comprising:
 - receiving a wager from a player at an electronic gaming device;
 - generating an outcome for the wager with the electronic gaming device;
 - displaying an outcome associated with the wager by the electronic gaming device;
 - paying the player with a computer file; and
 - step for electronically delivering the payment into a player's possession via a network connection.

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Walker	US 6,364,765 B1	Apr. 2, 2002
Murray	US 2002/0094870 A1	July 18, 2002
LeMay	US 6,942,574 B1	Sept. 13, 2005

REJECTIONS

Claims 1–22 are rejected under 35 U.S.C. § 101 as being directed to ineligible subject matter.

Claims 1–20 and 22 are rejected under 35 U.S.C. § 103(a) as unpatentable over Walker and Murray.

Claim 21 is rejected under 35 U.S.C. § 103(a) as unpatentable over Walker,² Murray, and LeMay.

ANALYSIS

101 Rejection

Appellant presents arguments for claims 1 and 2, but does not present arguments for claims 3–22 separate from those presented for claims 1 and 2. *See* Appeal Br. 9–14. We select claims 1 and 2 as the representative claims, and claims 3–22 stand or fall with claims 1 and 2. *See* 37 C.F.R. § 41.37(c)(1)(iv).

As an initial matter, Appellant contends that

the Examiner has cited two cases that do not appear to have any relation to the Appellant’s claims absent any argument to the contrary, while providing an incorrect summation of the claims (i.e. “generating gameplay video in a cloud computing network”), and has therefore failed to provide Appellant

² The Examiner stated that “[t]he combination of Walker and Murray teach receiving a wager from a player at an electronic gaming device . . . generating an outcome and step for paying the player with an award comprised entirely of data However, the combination of *Brossard* and Murray fails to teach that the machine event is based on a player tracking measure.” Non-Final Office Action (“Non-Final Act.”) 11 (emphasis added), dated Dec. 29, 2016. We consider the Examiner’s statement of “Brossard” to be an inadvertent typographical error. *See id.* (“It would have been obvious for one with ordinary skill in the art, at the time of the invention, to have modified the combination of Walker and Murray, . . .”).

Appeal 2018-006967
Application 13/726,295

“sufficient notice of reasons for [ineligibility] [to] enable the [Appellant] to effectively respond” (Robert Bahr, Memorandum on Subject Matter Eligibility, May, 4 2016 [(sic)], p. 2).

Appeal Br. 10; *see also id.* at 11 (“[W]ithout any explanation as to how *Affinity v. Amazon*³ might apply to . . . Appellant’s claims, the Examiner only instructs Appellant to ‘see’ *Affinity v. Amazon*. Appellant is res[pec]tfully unable to effectively respond to such a rejection.”) (emphases added).

We disagree with Appellant for the following reasons. To the extent Appellant is arguing that the Examiner failed to provide Appellant sufficient notice “to effectively respond to” the ineligible subject matter rejection (*see* Appeal Br. 10–11), the proper recourse for Appellant would have been to file a petition to the Director under 37 C.F.R. § 1.181. *See* 37 C.F.R. § 1.113. Appellant’s failure to file a petition and Appellant’s filing of an Appeal Brief constitute a waiver of any procedural arguments that the Examiner failed to provide Appellant sufficient notice to effectively respond to the ineligible subject matter rejection.

Section 101 of the Patent Act provides that “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof” is patent eligible. 35 U.S.C. § 101. Claims 1 and 2 fall within the literal scope of this provision because each recites a process.

The Supreme Court, however, has long recognized implicit exceptions to this section: “Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014)

³ *Affinity Labs of Texas v. Amazon.com Inc.*, 838 F.3d 1266 (2016) (“*Affinity v. Amazon*”).

Appeal 2018-006967
Application 13/726,295

(quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)). To determine whether a claim falls within one of these excluded categories, the Court has set out a two-part framework. The framework requires us first to consider whether the claim is “directed to one of those patent-ineligible concepts.” *Alice*, 573 U.S. at 217. If so, we then examine “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.* (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 78, 79 (2012)). That is, we examine the claims for an “inventive concept,” meaning “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.’” *Alice*, 573 U.S. at 217–18 (alteration in original) (quoting *Mayo*, 566 U.S. at 72–73).

Under the 2019 Eligibility Guidance, to decide whether a claim is “directed to” an abstract idea, we evaluate whether the claim (1) recites an abstract idea grouping listed in the guidance *and* (2) fails to integrate the recited abstract idea into a practical application. *See* 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50, 51 (Jan. 7, 2019) (“2019 Eligibility Guidance”).⁴ Concepts that have been 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 v. Kappos*, 561 U.S. 593, 611 (2010)); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and

⁴ An update to the 2019 Revised Patent Subject Matter Eligibility Guidance issued in October 2019 (“October 2019 Update,” available at https://www.uspto.gov/sites/default/files/documents/peg_oct_2019_update.pdf).

Appeal 2018-006967
Application 13/726,295

mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)). 2019 Eligibility Guidance at 52.

If the claim is “directed to” an abstract idea, as noted above, we then determine whether the claim recites an inventive concept. The guidance explains that, when making this determination, we should consider whether the additional claim elements add “a specific limitation or combination of limitations that are not well-understood, routine, conventional activity in the field” or “simply append[] well-understood, routine, conventional activities previously known to the industry.” 2019 Eligibility Guidance at 56.

Step 2A, Prong One – Recitation of Judicial Exception

The Examiner determines that the claims are “directed to the abstract idea of generating gameplay video in a cloud computing network.” Non-Final Act. 7. The Examiner further determines that

the claims, when analyzed as a whole, are held to be [ineligible] because they are considered to be drawn to an abstract idea (i.e., Certain methods of organizing human activities, using categories to organize, store, and transmit information) without any limitation(s) which qualify as “significantly more” than the abstract idea itself, but which are merely implemented/applied on a computer.

Id. The Examiner also determines that “[t]he claimed invention relates to providing an award via email to a player as an outcome to a wagering game” and that “[t]his describes an abstract concept similar to those found by the courts [to] be abstract, such as a fundamental economic practice and method of organizing human activity, emphasizing on using categories to organize, store, and transmit information.” *Id.*

Citing *In re Smith*, 815 F.3d 816 (2016), the Examiner further determines that the Federal Circuit “has affirmed that a wagering game is

roughly identical to fundamental economic practices that the Supreme Court held to be abstract idea in *Alice* and *Bilski*.” Ans. 4.⁵ The Examiner reasons that “[s]ince claim 1 recites a method for electronic gambling, the claim[ed] invention is patent-ineligible,” and that “the method of claim 2 fails to set for the patent-eligible subject matter for substantially the same reason.” *Id.*

Appellant contends that the claims are “directed toward methods of payment by electronic gaming devices such as a slot machine, for example, where players are paid awards via email attachments and a network connection, for example.” Appeal Br. 10. Appellant also contends that the “claims are not directed to a mere card game.” Reply Br. 2.⁶ Appellant alleges that “*In re Smith* is directed toward conducting a simple game of cards (blackjack), which could be executed either manually or by a standard computer, and respectfully has no bearing on the Appellant’s claims.” *Id.* Appellant further alleges that, in contrast to *In re Smith*, the claims of the subject application “are directed toward the electronic delivery of electronically deliverable awards, and not to any underlying gambling game, let alone a simple game of cards.” *Id.*

The 2019 Eligibility Guidance provides that “[c]ertain methods of organizing human activity” including “managing personal behavior or relationships or interactions between people (including *social activities*, teaching, and following rules or instructions)” are abstract ideas. 2019 Eligibility Guidance at 50, 52 (emphasis added). Here, we agree with the

⁵ Examiner’s Answer (“Ans.”), dated Apr. 24, 2018.

⁶ Reply Brief (“Reply Br.”), filed June 25, 2018. We note that the Reply Brief is not paginated. We refer to the Reply Brief as if it is numbered consecutively starting from page 1.

Examiner that claim 1 recites such an abstract idea of organizing human activity. Non-Final Act. 7. In particular, claim 1 recites steps of organizing human activity, i.e., (1) “receiving a wager from a player,” (2) “generating an outcome for the wager,” (3) “displaying an outcome associated with the wager,” and (4) “step for emailing an email attachment . . . as a payment to the player.” *See* Appeal Br. 18 (Claims App.). The limitations of claim 1, under the broadest reasonable interpretation, are steps that recite a method of organizing human activity in the area of gambling, and, thus, constitute a method of organizing human activity under the 2019 Eligibility Guidance, and, thus, an abstract idea.

Claim 2 recites steps (1) through (3) listed above for claim 1 and further recites the steps of (4) “paying the player with a computer file,” and (5) “step for electronically delivering the payment into a player’s possession via a network connection.” *See id.* Similar to that discussed above for claim 1, the limitations of claim 2, under the broadest reasonable interpretation, are steps that recite a method of organizing human activity in the area of gambling, and, thus, constitute a method of organizing human activity under the 2019 Eligibility Guidance, and, thus, an abstract idea.

Step 2A, Prong 2 – Integrated Into a Practical Application

If a claim recites a judicial exception, then, in *Prong 2*, we determine whether the recited judicial exception is integrated into a practical application of that exception by: (a) identifying whether there are any additional elements recited in the claim beyond the judicial exception(s); and (b) evaluating those additional elements individually and in combination to determine whether they integrate the exception into a practical application. *See* 2019 Eligibility Guidance at 54–55. This evaluation requires an

Appeal 2018-006967
Application 13/726,295

additional element or a combination of additional elements in the claim to 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 exception. *See id.* at 54.

We note the 2019 Eligibility Guidance indicates that, in the context of *Prong 2* of Step 2A, an exemplary consideration indicative that an additional element (or combination of elements) may have integrated the exception into a practical application is that the additional element reflects an improvement in the functioning of a computer, or an improvement to other technology or technical field. *See* 2019 Eligibility Guidance at 55.

In this case, any new functions in the technical field of delivering a payment to a player (such as emailing, paying the player with a computer file, or electronically delivering via a network connection) are not an improvement to a technical field, but, at best, an improvement in one of certain methods of organizing human activity (i.e., a fundamental economic practice), which is an abstract idea. *See* Ans. 5–6; *See Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014) (showing an advertisement before delivering free content is abstract); *In re Ferguson*, 558 F.3d 1359, 1364 (Fed. Cir. 2009) (methods of organizing business or legal relationships in the structuring of a sales force are abstract); *Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044, 1054 (Fed. Cir. 2017) (processing an application for financing a purchase is abstract); *Interval Licensing LLC v. AOL, Inc.*, 896 F.3d 1335, 1348 (Fed. Cir. 2018) (providing additional information without disrupting the ongoing provision of an initial set of information is abstract); and *Accenture Global Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1338 (Fed. Cir. 2013) (generating tasks to be performed in an insurance organization is abstract); *see also* the 2019

Appeal 2018-006967
Application 13/726,295

Eligibility Guidance at 52 (identifying “fundamental economic principles or practices (including hedging, insurance, mitigating risk)” as among the certain methods of organizing human activity that are abstract ideas).

Accordingly, the additional elements of claim 1 or claim 2 of the subject invention do not integrate the judicial exception into a practical application. For these reasons, each of claims 1 and 2 are directed to an abstract idea, which is a judicial exception to patent-eligible subject matter under 35 U.S.C. § 101.

Step 2B – Well-Understood, Routine, Conventional Activity

Having determined that both claims 1 and 2 recite a judicial exception, and neither claim integrates that exception into a practical application, under *Step 2B*, we consider whether claim 1 or claim 2 adds a specific limitation beyond the judicial exception that is not “well-understood, routine, conventional” in the field.

Appellant contends that “[t]he United States Court of Appeals for the Federal Circuit has also addressed the *Alice/Mayo* test in several decisions, including *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (2014), upholding the patent claims at issue in that case.” Appeal Br. 12. Additionally, Appellant contends that the Patent Trial and Appeal Board (“PTAB”) “has also issued several opinions concerning the *Alice/Mayo* framework, including *Google, Inc. v. Simpleair, Inc.*, CBM 2014-00170 (Jan. 22, 2015),” “wherein the PTAB found that although the claims at issue were directed toward an abstract idea, they contained meaningful limitations that amounted to significantly more than the abstract idea itself.” Appeal Br. 13–14. However, Appellant fails to direct us to any limitations in claim 1 or claim 2 that amount to significantly more than the abstract idea itself. *See*

Appeal 2018-006967
Application 13/726,295

Appeal Br. 12–14; *see also* Non-Final Act. 8. In this case, the Examiner determines that “the physical components including gaming devices and displays considered individually and as an ordered combination merely implement the abstract idea at a high level of generality and fail to impose meaningful limitations to impart patent eligibility.” Non-Final Act. 8. Appellant does not apprise us of error as to these determinations by the Examiner. *See* Appeal Br. and Reply Br., *passim*.

As such, the claimed use of “an electronic gaming device” to carry out the abstract idea “simply appends well-understood, routine, conventional activities previously known to the industry.” *See* 2019 Eligibility Guidance at 56. Indeed, the Specification suggests that the electronic gaming device is well-known, routine, and conventional. *See, e.g.*, Spec. ¶¶ 3, 17. The Specification also suggests that the data based award could be any file, or code and the like, which can be sent electronically to a player via *any PC and any suitable network*. *See, e.g.*, Spec. ¶¶ 26–30, 39, 46, 56.

Accordingly, neither claim 1 nor claim 2 of the subject invention adds a sufficient inventive concept to the underlying abstract idea discussed above.

Appellant contends that the subject invention, “[o]n its own, . . . demonstrates at least novelty and [is] not seeking to *tie up* a market, additionally, the invention is useful at least insofar as it affords an additional payment method for the highly regulated gaming industry.” Appeal Br. 12. However, as our reviewing court has explained, “the principle of preemption is the basis for the judicial exceptions to patentability,” and “[f]or this reason, questions on preemption are inherent in and resolved by the § 101 analysis.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (citing *Alice*, 573 U.S. at 216). Although “preemption may

Appeal 2018-006967
Application 13/726,295

signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Id.* Moreover, “[w]here a patent’s claims are deemed only to disclose patent ineligible subject matter under the [*Alice/Mayo*] framework . . . , preemption concerns are fully addressed and made moot.” *Id.*; *see also OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015) (“[T]hat the claims do not preempt all price optimization or may be limited to price optimization in the e-commerce setting do not make them any less abstract.”). Appellant’s argument as to absence of preemption does not apprise us of error in the Examiner’s rejection.

Based upon the findings and legal conclusions above, on this record and in consideration of the 2019 Eligibility Guidance, we agree with the Examiner that each of claims 1 and 2 is directed to patent-ineligible subject matter, such that we sustain the Examiner’s rejection of claims 1 and 2 as being directed to patent-ineligible subject matter. We further sustain the rejection of claims 3–22, which fall with claims 1 and 2.

Obviousness over Walker and Murray

Claims 1–20 and 22

Appellant does not present arguments for claims 2–20 and 22 separate from those presented for claim 1. *See* Appeal Br. 14–17. We select claim 1 as the representative claim, and claims 2–20 and 22 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner finds that Walker discloses a method of electronic gambling having all the limitations of claim 1, except that “Walker does not disclose emailing the award.” Non-Final Act. 8–9. However, the Examiner notes that Walker “discloses presenting the award to the player on a game

display located at a gaming establishment or on a client device located via a server.” *Id.* at 9. The Examiner also finds that Murray discloses “emailing an award to one of [a] plurality of remotely located players (email being a vessel for a delivery system).” *Id.* (citing Murray ¶ 92). The Examiner reasons that it would have been obvious to a skilled artisan to modify the game device of Walker to include emailing an award to players, as taught by Murray, in order to “prevent players from receiving duplicate awards.” *Id.*

Appellant contends that Walker fails to disclose “a data based award.” Appeal Br. 14. In particular, Appellant contends that “no teaching or disclosure in the entirety of Walker . . . suggest[s] an electronic award as claimed by Appellant” and that “[i]n contrast, Walker merely discloses kiosks that print game instructions and dispense currency.” *Id.* (citing Walker, cols. 9–11). Appellant also contends that “Walker’s instructions on how a player is to go about receiving an award are simply not the award as claimed by Appellant” because “they are merely directions on how a player is to receive his or her payment.” *Id.* Appellant further contends that column 6 lines 4–20 of Walker “merely disclose[s] a kiosk that outputs currency, prints ‘coupons, reports, game instructions and coupons redeemable for free games, dinner merchandise, or cash.’” *Id.*

As an initial matter, we note that claim 1 does not recite “a data based award.” Appeal Br. 18 (Claims App.).⁷ Rather, claim 1 more broadly recites “an award comprised entirely of data.” *See id.* “[L]imitations are not to be read into the claims from the specification.” *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993); *see also In re Self*, 671 F.2d 1344, 1348

⁷ We note that claim 2 likewise does not recite “a data based award.” Appeal Br. 18 (Claims App.).

Appeal 2018-006967
Application 13/726,295

(CCPA 1982) (“[A]ppellant’s arguments fail from the outset because . . . they are not based on limitations appearing in the claims.”).

Appellant’s Specification provides examples of a data-based award (DBA) that include a digital key, player tracking points, bonus games, image files, or any digitized or data based items, etc. Spec. ¶ 25. Appellant’s Specification describes that a digital key may also be a code or password that allows access to a web page that provides the appropriate downloads. *Id.* ¶ 26. Appellant’s Specification also describes that “[t]he key could be in the form of a bar code printed from the player’s printer” and that “[a]t the casino, the data key may be verified by an attendant, a device for that purpose, or by a properly equipped EGD [(electronic gaming device)] prior to displaying an outcome or redeeming credits.” Spec. ¶ 72. In light of Appellant’s disclosure, we agree with the Examiner’s broadest reasonable interpretation that Walker’s disclosure of “print receipts, reports, . . . and coupons redeemable for free games, dinner, merchandise or cash” satisfies the limitation of “an award comprised entirely of data.” *See* Walker 6:12–17; *see also* Non-Final Act. 9; Ans. 7 (“As indicated by Walker, the awards provided to the players include data transmitted to the gaming kiosk’s printer, used by the players, to be printed and redeemed.”); Appeal Br. 18 (Claims App.).

Appellant contends that Murray “does not deliver an award comprised entirely of data.” Appeal Br. 15. In particular, Appellant contends that (1) “Murray simply notifies a person that they have won an award via email. The award itself is not delivered via email as claimed,” (2) “Murray’s real award is either discounted merchandise or money provided by the advertiser/sponsor, which are not things that can be emailed or electronically delivered into a player’s possession,” and (3) “Murray teaches pop-up

Appeal 2018-006967
Application 13/726,295

windows or emails linking a player to a third party vendor with whom the player can arrange delivery of an award. Murray’s awards are never delivered electronically.” Appeal Br. 15.

As an initial matter, the Examiner relies on the teachings of Walker, not Murray, for disclosure of “an award comprised entirely of data.” *See* Non-Final Act. 9. The Examiner relies on the teaching of Murray merely for disclosure of “emailing the award.” *See id.* Murray discloses “[b]ecause all players *must have email*, they are eligible *to receive payment through email.*” Murray ¶ 92 (emphases added); *see also* Non-Final 9; Ans. 7. As Murray discloses that because all players must have email, they are eligible *to receive payment through email*, we disagree with Appellant that “Murray’s awards are never delivered electronically.” Murray ¶ 92; *see also* Appeal Br. 15.

Appellant contends that “[t]he combination of Walker and Murray cannot deliver an electronic gambling award comprised entirely of data as payment to a player simply because Walker never generates a deliverable award that could be emailed, let alone provides it to Murray’s system for any kind of electronic delivery” and that “[n]either Walker nor Murray, either alone or in combination, disclose, teach, or otherwise suggest generating an award comprised entirely of data and then emailing or electronically delivering it to a player as a payment to the player.” Appeal Br. 14–16.

As an initial matter, the Examiner proposes to modify Walker in view of Murray, not Murray in view of Walker. *See* Non-Final Act. 9. As discussed above, in light of Appellant’s disclosure, we agree with the Examiner’s broadest reasonable interpretation that Walker’s disclosure of “print receipts, reports, . . . and coupons redeemable for free games, dinner, merchandise or cash” satisfies the limitation of “an award comprised entirely

of data.” *See* Walker 6:12–17; *see also* Non-Final Act. 9; Ans. 7; Appeal Br. 18 (Claims App.). Additionally, the Examiner notes that Walker “discloses presenting the award to the player on a game display located at a gaming establishment or on a client device located via a server.” Non-Final Act. 9. Appellant does not apprise us of Examiner error in this finding by the Examiner. *See* Appeal Br. 14–17. The Examiner also correctly finds that Murray discloses “emailing an award to one of [a] plurality of remotely located players (email being a vessel for a delivery system).” Non-Final Act. 9 (citing Murray ¶ 92). The Examiner reasons that it would have been obvious to a skilled artisan to modify the game device of Walker to include emailing an award to players, as taught by Murray, in order to “prevent players from receiving duplicate awards” *Id.* Appellant does not apprise us of error in the Examiner’s findings or reasoning. *See* Appeal Br. 14–17.

We also are not persuaded the Examiner engages in impermissible hindsight in combining the teachings of the references. *See* Appeal Br. 16. The Examiner cites specific teachings in Walker and Murray themselves, not Appellant’s disclosure, in support of the Examiner’s articulated reasoning for combining Walker and Murray as proposed in the rejection. *See* Non-Final Act. 8–9; *see also* Ans. 6–8. We further are not persuaded of error, because Appellant has not made a showing that the Examiner’s rationales were outside of the knowledge within the level of ordinary skill in the art at the time the claimed invention was made or were gleaned only from Appellant’s disclosure. *See* Appeal Br. 14–17.

Appellant contends that the Examiner took Official Notice in combining the teachings of Walker and Murray for claim 1. *See* Appeal Br. 16. We disagree. The Examiner does not take Official Notice in rejecting claim 1. *See* Non-Final Act. 8–9. Rather, the Examiner cites to specific

Appeal 2018-006967
Application 13/726,295

teachings in Walker and Murray and, in particular, cites to paragraph 92 of Murray, for why a skilled artisan would modify the game device of Walker to include emailing an award to players, namely, “to prevent players from receiving duplicate awards.” Non-Final Act. 9; *see also* Murray ¶ 92 (“Because all players must have email, they are eligible to receive payment through email. This payment scheme also *allows an additional crosscheck against* individuals having *duplicate enrollments* in the same team (using more than one email address) and *duplicate enrollments* in more than one team in the same contest.”) (emphases added). Appellant does not apprise us of error in the Examiner’s findings or reasoning. *See* Appeal Br. 14–17.

In summary, and based on the record presented, we are not persuaded the Examiner erred in rejecting independent claim 1 as unpatentable over Walker and Murray. Accordingly, we sustain the Examiner’s rejection of claim 1. We further sustain the rejection of claims 2–20 and 22, which fall with claim 1.

Obviousness over Walker, Murray, and LeMay

Claim 21

Appellant does not present arguments for claim 21 separate from those presented above against Walker and Murray. *See* Appeal Br. 17. As we find no deficiencies in the Examiner’s rejection over Walker and Murray for the reasons discussed above, we likewise sustain the Examiner’s rejection of claim 21 over Walker, Murray, and LeMay.

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1-22	101	Eligibility	1-22	
1-20, 22	103(a)	Walker, Murray	1-20, 22	
21	103(a)	Walker, Murray, LeMay	21	
Overall Outcome			1-22	

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