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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LIZ COON, LYNN CIFKA, and JOHN DANIELS

Appeal 2018-007249
Application 13/750,646
Technology Center 3700

Before MICHAEL L. HOELTER, WILLIAM A. CAPP, and
LEE L. STEPINA, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* CAPP

Opinion Dissenting-in-Part filed by *Administrative Patent Judge* HOELTER
CAPP, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134(a) of the final rejection of claims 23, 24, 27, 28, and 32–49. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

THE INVENTION

Appellants' invention is a board game. Spec. ¶ 2. Claim 24, reproduced below, is illustrative of the subject matter on appeal.

24. A method of playing a game, comprising:

providing a game board comprising a sinuous path between homelessness and having a home comprising a series of playing spaces, the playing spaces comprising: a homelessness end space representing homelessness at one terminus of the path; a home end space representing having a home at the opposite terminus of the path; a starting space at a substantial midpoint of said path, such that there are a substantially equivalent number of the playing spaces between the starting space and the homelessness end space as there are between the starting space and the home end space; and gameplay spaces;

providing a game piece for showing a player's position on said path;

providing a plurality of gameplay cards, the gameplay cards comprising: opportunity cards that contain an indication of good luck for the player in his goal of having a home and instructions that cause the player to move his piece on the path towards the home end space and away from the homelessness end space; and challenge cards that contain an indication of bad luck for the player in his goal of having a home and instructions that cause the player to move his piece on the path towards the homelessness end space and away from the home end space;

providing a plurality of credential cards that represent credentials that are difficult for the homeless to obtain, and that a player must collect to complete the game; the credential cards comprising two or more of: an identification card; a Bridge/Food Stamp Card; a Checking Account/Bank Account Card; a Healthcare/Health Insurance Card; and a Degree/Certificate Card, wherein:

the gameplay spaces comprise: spaces with no instructions; first instruction spaces that instruct the player to move his piece in a particular manner; second instruction spaces that instruct the player how to collect a credential card; and third instruction spaces that instruct the player to draw a gameplay card; and

the sinuous path is sectioned according to stages on the homelessness continuum, the method further comprising:

during a turn, the player uses a random number generating device, moves the game piece a number of spaces determined by the random number generating device, and, if the game piece lands on one of the first, second, or third instruction spaces, follows the instructions, wherein:

the game is complete for the player when the game piece is on the home end space and the player has possession of the plurality of credential cards.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Mock	US 4,871,177	Oct. 3, 1989
Barratt	US 5,813,671	Sept. 29, 1998
Bryant	US 6,142,473	Nov. 7, 2000
Herman	US 2008/0277870 A1	Nov. 13, 2008
Teal	US 2009/0045572 A1	Feb. 19, 2009

The following rejections are before us for review:

1. Claims 24, 28, 32, 35, 37, 39, 41, 43, 45, 47, and 49 (hereinafter sometimes the “Method Claims”) are rejected under 35 U.S.C. § 101 as directed to a judicial exception to patent eligible subject matter.¹

2. Claims 23, 24, 28, 33, 34, 36, 38, 40, 42, 44, 46, 47, and 48 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Herman.

3. Claims 27 and 28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Herman and Barratt.

¹ For purposes of convention, claims 23, 27, 33, 34, 36, 38, 40, 42, 44, 46, and 48 shall hereinafter be referred to collectively as the “Apparatus Claims.”

4. Claim 32 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Herman and Bryant.

5. Claims 24, 28, 32, 35, 39, 41, 45, 47, and 49 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mock and Herman.

6. Claims 37 and 43 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mock, Herman, and Teal.

OPINION

Unpatentability Under 35 U.S.C. § 101 over the Method Claims

Claims 24, 28, 32, 35, 37, 39, 41, 43, 45, 47, and 49 are all method claims and are argued as a group. Claims App., Appeal Br. 16–28. We select claim 24 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 Section 101. *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (Jan. 7, 2019) (“*2019 Guidelines*”). Under such 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.

In other words, under prong 1, we look to whether the claim recites an abstract idea. Then, if it does, under prong 2, we look at the claim, as a whole, and determine whether the claim is “directed to” the abstract idea or, instead, is “directed to” a “practical application” of the abstract idea.

Section 101 Analysis of Representative Claim 24

Prong 1

The *2019 Guidelines* identify three key concepts 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 people”; and (c) mental processes including “observation, evaluation, judgment, [and] opinion.”

The Examiner determines that the Method Claims are directed to an abstract idea. Final Action 2. More particularly, the Examiner finds that claim 24 entails generating random information, moving game pieces, and

collecting/earning cards. *Id.* The Examiner further finds that instructions to follow game rules, managing the playing of a board game, and allowing players to collect/exchange goods constitutes a method of organizing human activity, which is a type of abstract idea and a judicially recognized exception to patent eligible subject matter. *Id.* at 2–3.

Appellants argue that the Method Claims are not directed to an abstract idea, in general, or to a method of organizing human activity, in particular. Appeal Br. 19. Instead, according to Appellants, the claims are directed to using a particularly described game apparatus in a particular way. *Id.*

In response, the Examiner explains that the Method Claims require steps of generating random information, moving game pieces, and collecting/earning game cards. Ans. 18. The Examiner states that such activity is considered to be a judicially recognized exception to patent eligible subject matter. *Id.* at 18–19. According to the Examiner, the “steps [of] generating random information, moving game pieces, collecting/earning game cards are directed to a set of instructions and following a set of rules for playing a game and considered as abstract rules.” *Id.* at 19.

In reply, Appellants reiterate that the Method Claims are not a “method of organizing human activity” but, instead, are directed to using a particularly described game apparatus in a particular way. Reply Br. 4.

Claim 24 recites:

- providing a game board with a path and spaces that contain instructions;
- providing a game piece (for showing a position on the board);
- providing gameplay cards that represent good or bad luck;
- providing “credential cards” that must be collected;

- using a random number generating device;
- moving a game piece in accordance with the number generator;
- following instructions on the game spaces;
- completing the game by reaching an end space and possessing credential cards.

Claims App., claim 24.

Appellants' invention is a board game, which is played by humans. The game proceeds by players first obtaining the game instrumentalities, *i.e.*, the four "providing" steps.² The players then set-up the game board, game pieces, and game cards in accordance with rules and instructions. The players take turns rolling the dice or using some other number generating device. The players move their respective game pieces along the game board path to spaces thereon in accordance with the number indicated by the dice or other number generating device. During the course of the game, players obtain one or more "credential cards." Also during the course of the game, players encounter and respond to gameplay cards that represent good or bad luck. All of the foregoing activities of the human players proceed in an organized fashion and in accordance with game rules and associated instructions. In short, the human activity that takes place in playing the game is not random, rather, it is "organized" by the various rules and

² Contrary to the position taken by the Dissent, we view the four "providing" limitations as requiring little more than removing the game instrumentalities from a container such as is commonly furnished with well-known parlor games such as MONOPOLY or LIFE. We view such "providing" as merely incidental to playing a game. The preamble of claim 1, "[a] method of playing a game," is instructive here. The Dissent's "what with" position is an argument that was not even raised by Appellants. Rather, Appellants argue that the claims are directed to "using" a particularly described game apparatus in a particular way. Appeal Br. 19.

instructions for playing the game. With the foregoing in mind, we fail to see any distinction between the Examiner’s characterization of the game as a method of organizing human activity and Appellants’ characterization of “using a particularly described game apparatus in a particular way.”

Although Appellants’ characterization might perhaps be narrower in scope, it, nevertheless, falls within the category of methods of organizing human activity, which constitutes an abstract idea under our *2019 Guidelines*. See *In re Marco Guldenaar Holding B.V.*, 911 F.3d 1157, 1160 (2018)

(explaining that where the Patent Office further articulates a more refined characterization of the abstract idea (e.g., “rules for playing games”), there is no error in also observing that the claimed abstract idea is one type of a method of organizing human activity).

The Examiner’s determination that Appellants’ game recites a method of organizing human activity is consistent with the Federal Circuit’s decision in *Planet Bingo, LLC v. VKGS LLC*, 576 Fed.Appx. 1005, 1008 (Fed. Cir. 2014) (explaining that claims reciting methods and systems for managing a game of Bingo is similar to the organizing of human activity in *Alice*). Similarly, the Federal Circuit recently characterized rules for playing a dice game on a customized game board as a method of organizing human activity. *Guldenaar*, 911 F.3d at 1160.

In view of the foregoing discussion, we determine that claim 24 falls within the ambit of a method of organizing human activity and thus recites an abstract idea.

Prong 2

The Federal Circuit cautions us not to “overly abstract” claims when performing the *Mayo/Alice* analysis. *Natural Alternatives Intl., Inc. v.*

Creative Compounds, LLC, 918 F.3d 1338, 1350 (Fed. Cir. 2019).

Consequently, under Prong 2 of the *2019 Guidelines*, we do not assume that such claims are directed to patent ineligible subject matter because “[a]t some level, ‘all inventions . . . 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* (quoting *Mayo*). 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 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. *2019 Guidelines*.

Appellants argue that claim 24 is not directed to an abstract idea, analogizing the instant case to *McRO, supra*. Appeal Br. 27. Appellants also analogize the instant case to that of *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1258 (Fed. Cir. 2014). *Id.* In response, the Examiner reiterates that the claim just entails generating random information, moving game pieces, and collecting/earning game cards. Ans. 19. As such,

according to the Examiner, claim 24 is merely directed to a set of instructions and following a set of rules for playing a game, which is an abstract idea. Ans. 19.

We find Appellants' attempt to analogize a board game to the subject matter of *McRO* and *DDR Holdings* unpersuasive. The courts determined that *McRO* and *DDR Holdings* were not "directed to" an abstract idea, because the claims were drawn to technological improvements. In contrast, claim 24 is about playing a board game. Claims App. Except for the possibility of using an electronic random number generator instead of dice, the entire process is manual. Playing the game includes rolling dice or utilizing some other random number generator. *Id.* The game also includes a game board with a path that is subdivided into sequential spaces. *Id.* Players manually move physical game pieces along a physical game board path and following various instructions thereon that encompass, among other things, collecting "credential cards" and drawing gameplay cards that represent good or bad luck. *Id.* The information printed on the board and cards is manually read by human players. Essentially, the game is similar to almost every board game that simulates some aspect of human life, namely: (1) follows a predefined, sequential path in accordance with probabilities established by random number generation; and (2) generates rewards based on the probabilistic outcomes of events that are identified by game spaces and associated game cards.

The fact that Appellants play their game with particularized information printed on the game board, game play cards, and "credential cards" does not contribute to the patentability of the claimed subject matter. In a substantially similar game case, our reviewing court assigned no

patentable weight to indicia printed on game instrumentalities. *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 printed matter on the game board, gameplay cards, and credential cards is 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.

Finally, the prospect that claim 24 includes several limitations directed to “providing” various physical game instrumentalities does not save the claim from being directed to an abstract idea. Claims App. The claim at issue in *Guldenaar* similarly had limitations directed to “providing” game instrumentalities (dice). *Id.* at 1158. Nevertheless, the court held that mere recital of physical steps does not remove a claim from the abstract idea category.

Appellant also argues that his claimed method of playing a dice game cannot be an abstract idea because it recites a physical game with physical steps. *See, e.g.*, Appellant Op. Br. at 13. We disagree, because the abstract idea exception does not turn solely on whether the claimed invention comprises physical versus mental steps.

Id. at 1161. Given the similarity between *Guldenaar* and the instant case, we determine that Appellants’ wagering 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 game board spaces, cards, game pieces, and random selection devices such as dice to be conventional, well understood, and routine activities previously known in the pertinent industry.

Id. The Examiner further finds that the steps of collecting, rolling, moving, and receiving are performed by humans and not machine implemented.

Claimed method, while arguably reciting a number of physical steps of generating random information, moving game pieces, and collecting cards are viewed here as an attempt to claim a set of abstract ideas/rules for playing a board game. Viewed as a whole the additional items game pieces, game path with landing spaces, cards, and random selection devices do not provide meaningful limitations to transform the abstract idea into a patent eligible application of the abstract idea such that the claims amount to significantly more than the abstract idea itself.

Id.

Appellants argue that the rejected claims contain an inventive concept because they use a particular physical device and include limitations beyond what is conventional. Appeal Br. 20. For example, Appellants recite elements such as “credential” and “question” cards used in conjunction with other game elements as constituting an inventive concept. *Id.* at 20–21. Appellants emphasize that the Examiner fails to address elements that distinguish the rejected claims from the prior art. *Id.* at 22. Appellants assert that courts find that games with “new” components do comply with the patent eligible subject matter requirements of Section 101. *Id.* at 22–26 (citing cases).

In response, the Examiner cites *In re Smith*, 815 F.3d 816 (Fed. Cir. 2016) as a recent example of case authority that stands for the proposition that rules for conducting a game based on probabilities recite an abstract idea. Ans. 20. The Examiner notes that in the *Smith* case, using “physical

cards” is insufficient to transform an abstract idea into patentable subject matter.

In reply, Appellants argue that their “credential cards” are not conventional. Reply Br. 6. Appellants argue that claims similar to the instant claims are consistently allowed by the Board. *Id.* at 9. Appellants rely on *dicta* from the *Smith* case as indicating that games that use new or original game instrumentalities may survive step two of the *Alice* analysis. *Id.*

Appellants also argue that their game does not preempt categories of game play because the claimed are directed to specific processes using specific components, such as credential and question cards and related gameplay. Appeal Br. 16, 23, 26, 27, Reply Br. 9 (citing *DDR Holdings*, 773 F.3d at 1258). Appellants’ effort to leverage the preemption language from *DDR Holdings* is not persuasive. The Federal Circuit addressed and disposed of this concern adversely to Appellants 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. 20. The Examiner considers rolling dice, moving game pieces around a board, and reading and reacting to information on game cards to be a purely conventional activity. *Id.* We agree. We view Appellants’ game steps as no less conventional than the dice game that the Federal Circuit found ineligible in *Guldenaar*.

We find Appellants argument that the particularized content of the game board, game cards, and credential cards entail an inventive concept unpersuasive. Appellants confuse the additional elements that purportedly involve an inventive concept (the content of printed matter on game cards) with the abstract idea itself. However, for purposes of a Section 101 analysis, we may assume that the techniques claimed are “[g]roundbreaking, innovative, or even brilliant,” but that is not enough for eligibility. *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 591; accord *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1352 (Fed. Cir. 2014). Nor is it enough for subject-matter eligibility that claimed techniques be novel and nonobvious in light of prior art, passing muster under 35 U.S.C. §§ 102 and 103. *See Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 89–90 (2012); *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016) (“[A] claim for a *new* abstract idea is still

an abstract idea. The search for a § 101 inventive concept is thus distinct from demonstrating § 102 novelty.”); *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1315 (Fed. Cir. 2016) (same for obviousness) (*Symantec*). The claims here are ineligible because their purported innovation is an innovation in ineligible subject matter. Their subject is nothing but a group of rules and instructions for playing a game. No matter how much Appellants’ game differs from other board games, the difference lies entirely in the realm of abstract ideas, with no cognizable advance in the nonabstract application realm. Moreover, the inventive concept that Appellants rely on lies almost entirely in the content of printed matter that is not entitled to patentable weight for purposes of a Section 101 analysis. *Guldenaar*, 911 F.3d at 1161.

The basic concept of playing a board game by rolling dice, moving game pieces around a game board, and reacting to game cards dates back well over a century to time honored games such as MONOPOLY and LIFE. Well known board games, such as MONOPOLY and LIFE, establish that selecting random numbers with dice (or spinners, etc.), moving pieces around a game board, and reacting to information printed on game cards amount to well-understood, routine, conventional activities previously known to the industry. *Alice*, 573 U.S. at 225.

The recited elements of claim 24, considered individually and as an ordered combination, do not constitute an “inventive concept” that transforms the claim into patent-eligible subject matter. On this record, we affirm the Examiner’s Section 101 rejection of claim 24, as well as claims 28, 32, 35, 37, 39, 41, 43, 45, 47, and 49, which fall with claim 24.

*Unpatentability of
Claims 23, 33, 34, 36, 38, 40, 42, 44, 46, and 48
over Herman*

Claims 23 and 40

Claims 23 and 40 are independent apparatus claims that are argued together. Claims App., Appeal Br. 28–33. We select claim 23 as representative. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner finds that Herman discloses the invention substantially as claimed except for *per se* home and homeless end spaces. Final Action 5–6. The Examiner notes that Herman depicts a structure labeled “H” at one end space and depicts an apple at the opposite end space. *Id.* at 7. The Examiner concludes that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to print any suitable letter, numeral, word, picture or indicia to represent a desired theme. *Id.* The Examiner considers claim limitations directed to game rules and instructions to fall under the printed matter doctrine. *Id.* at 6.

Appellants argue that their game includes two different types or categories of cards, namely: (1) cards with written instructions; and (2) cards that must be collected. Appeal Br. 29. Appellants argue that the two types of cards do not just differ in what is printed on them, but are also different in form and function. *Id.* More particularly, Appellants argue that Herman fails to disclose “credential cards.” *Id.*

[T]he difference between *Herman's* instruction cards and the recited “credential cards” is more than simply a difference between what specific instructions are printed on a card. While the opportunity and challenge cards of the pending claims and the instruction cards 40 of *Herman* provide similar functionality to the respective games, the claimed “credential cards” are quite different. They do not provide instructions, but rather provide a

new and unobvious functional relationship with the substrate not taught or suggested by *Herman* - a set of credentials that must be collected to complete the game.

Id. at 31.

In response, the Examiner states that, in an apparatus claim, the rules for playing do not limit the apparatus. Ans. 21. “An apparatus claim is defined by its structure and not by how a user might want to use it for any intended purpose.” *Id.* Specifically in reference to Appellants’ “‘credential cards,’ the Examiner takes the position . . . [such] limitations . . . have no physical ties to the substrate [and, therefore,] printed matter [on the credential cards does] not patentably distinguish the invention from the prior art.” *Id.* (citing *In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983).

In reply, Appellants reassert that the credential cards have a functional relationship with the underlying substrate. Reply Br. 10–14.

Herman discloses a board game. *Herman*, Abstract. The game includes a game board (10), game pieces (50), and theme related game cards (40). *Id.* ¶ 12. To play, each participant places their game piece at a starting area (14) that is located at the mid-point of a game path printed on the game board. *Id.* Play proceeds along the path in either direction from the mid-point starting area (14) toward end-points representing wellness (18) or sickness (20). *Id.* Movement of a game piece along the path is determined by number indicia on the game cards. *Id.*

The physical appearance of *Herman*’s game differs from Appellants’ game with regard to the graphical/ornamental design of the game board and game pieces and the content of the printed matter on the game cards. We agree with the Examiner that it would have been obvious to modify the

graphical/ornamental design of the game board and game pieces in accordance with any suitable game theme.

In terms of the game cards component of the game, we consider separately Appellants' arguments that: (1) Appellants use two types of game cards instead of Herman's single type of card; and (2) that the printed matter on the cards does not fall under the printed matter doctrine because it is allegedly functionally related to the underlying substrate. With respect to the first argument, both Herman and Appellants recite structure in the form of "cards." Appellants' argument that their game includes two different kinds of cards is not a structural distinction, rather it is simply an arbitrary/abstract matter that the game provides differing instructions and rules depending on what is printed on each card.³

With respect to the second argument, whether the printed matter doctrine applies has recently been decided adversely to Appellants' position. *Guldenaar*, 911 F.3d at 1161 (explaining that claim limitations directed to printed indicia information on game instrumentalities are not functionally related to the substrate of the dice).

In view of the foregoing discussion, we determine that the Examiner's findings of fact are supported by a preponderance of the evidence and that the Examiner's legal conclusion of unpatentability is well-founded. Accordingly, we sustain the Examiner's unpatentability rejection of claims 23 and 40 over Herman.

³ For purposes of our analysis, it is patentably inconsequential to us whether Appellants' two different types of cards may be distinguished from one another by size, thickness, and/or stiffness of card stock, or color.

Claims 36 and 42

These claims depend, directly or indirectly, from claim 23 and are argued together. Claims App. Appeal Br. 33–34. We select claim 36 as representative. Claim 36 adds the limitation: “wherein the gameplay cards further comprise a plurality of question cards that contain questions for the player to answer; the questions on the question cards do not affect the player's position on the sinuous path; and the questions relate to aspects of homelessness.” Appellants argue that the printed matter doctrine does not apply to this limitation. Appeal Br. 34–34. For reasons previously discussed, we disagree. *Guldenaar*, 911 F.3d at 1161.

We sustain the Examiner’s unpatentability rejection of claims 36 and 42 over Herman.

Claim 48

Claim 48 depends from claim 40 and adds the limitation: “wherein: the plurality of credential cards comprises each of: an identification card; a Bridge/ Food Stamp Card; a Checking Account/ Bank Account Card; a Healthcare/ Health Insurance Card; and a Degree/ Certificate Card.” Claims App. The sole argument raised by Appellants is a renewal of their previously discussed argument regarding the printed matter content on the credential cards. For reasons previously discussed, we sustain the Examiner's unpatentability rejection of claim 48. *Guldenaar*, 911 F.3d at 1161.

Claims 33, 34, 38, 44, and 46

The claims depend from either claim 23 and are not separately argued apart from what we previously considered and found unpersuasive with respect to claim 23. Claims App., Appeal Br. 34–35. We sustain the

Examiner's unpatentability rejection of claims 33, 34, 38, 44, and 46 over Herman.

*Unpatentability of Claim 27
over Herman and Barratt*

Claim 27 depends from claim 23 and is not separately argued apart from what we previously considered and found unpersuasive with respect to claim 23. Claims App., Appeal Br. 35. We sustain the Examiner's unpatentability rejection of claim 27 over Herman and Barratt.

*Unpatentability of Claims 24, 28, 32, 35, 39, 41, 45, 47, and 49
over Mock and Herman*

Claims 24 and 41

Claims 24 and 41 are independent method claims. Claims App., Appeal Br. 37–39. The Examiner finds that Mock discloses the invention substantially as claimed except for the game path being sinuous and the start space being at the midpoint of the game board, for which the Examiner relies on Herman. Final Action 13–15. Relying on the printed matter doctrine, the Examiner assigns no patentable weight to the printed matter on Appellants' game board and cards. *Id.* The Examiner concludes that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Mock with the teachings of Herman to achieve the claimed invention. *Id.* at 15.

Appellants argue that Mock and Herman fail to disclose “credential cards” as claimed. Appeal Br. 37. In particular, Appellants argue that Mock's stock certificates are not credential cards. *Id.* at 38. Appellants argue that the event(s) of completion of Mock's game differ from that of the instantly claimed game. *Id.*

Mock does not teach any necessary gamepiece position for game completion. Nor does *Mock* teach or suggest that any **particular** stock certificates should be collected, or that those particular stock certificates that must be collected are the “same for each player,” as is recited in claim 41. Rather, *Mock's* stock certificates reflect company ownership shares and therefore cannot be the same for each player as the ownership is, by its nature, zero-sum.

Id.

In response, the Examiner states that *Mock* teaches that a game is complete when a victor’s game piece is on a home end space and when the victor has collected a plurality of cards. Ans. 23. In regard to the cards’ content, the Examiner reiterates that the printed matter on game cards falls under the printed matter doctrine. *Id.* (citing case authorities).

In reply, Appellants reiterate that *Mock's* stock certificates are not “credential cards.” Reply Br. 20. Appellants also reiterate that *Mock* teaches a different method of concluding the game. *Id.* at 21. With respect to the printed matter doctrine, Appellants argue that their credential cards have a distinct interrelationship with the underlying game, which entitles the printed matter to patentable weight. *Id.* at 22 (citing *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983)).

The Examiner’s position on the printed matter doctrine is correct. As previously discussed in connection with Section 101 rejection, the Federal Circuit treats information printed on game instrumentalities under the printed matter doctrine such that the printed information is not entitled to patentable weight. *Guldenaar*, 911 F.3d at 1161. In *Guldenaar*, the Federal Circuit distinguished printed matter on gaming instrumentalities from cases

such as *In re Gulack*,⁴ where digits were printed on a band in such a manner that the digits exploited the endless nature of the band and the particular sequence of digits was critical to the invention disclosed in the claims. In *Guldenaar*, the Board affirmed Examiner rejections based on Section 101 and 103 grounds. *Ex Parte Guldenaar*, Case No. 2015-003656, 2017 WL 2797662 (PTAB, June 20, 2017). The Board’s decision relied on the printed matter doctrine in affirming the Section 103 rejection, but not the Section 101 rejection. In the subsequent appeal to Federal Circuit, the court did not reach the 103 rejection, but relied on the printed matter doctrine in affirming the Section 101 rejection. *Guldenaar*, 911 F.3d at 1161.; *see also Praxair*, 890 F.3d at 1032 (explaining that although the rationale underlying the printed matter doctrine lies in subject matter eligibility, its application has been in analyzing other patentability requirements, including novelty under Section 102 and nonobviousness under Section 103).

Thus, having determined that the printed matter on the “credential cards” is not entitled to patentable weight under *Guldenaar*, we turn to Appellants remaining arguments. With respect to completing Mock’s game, we agree with Appellants that Mock does not disclose a “home end space” *per se* and, therefore, does not complete the game by arriving at a “home end space.” The Examiner’s citation to column 14 of Mock does not provide evidentiary support for the Examiner’s finding of fact. Ans. 23

Thus, the Examiner’s findings of fact are not supported by a preponderance of the evidence. Consequently, we do not sustain the

⁴ *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983). The *Guldenaar* court similarly relied on *In re Miller*, 418 F.2d 1392 (CCPA 1969).

rejection of either claim 24 or 41, each of which have “home end space” limitations.

Claims 28, 32, 35, 39, 45, 47, and 49

These claims depend from claim either claim 24 or 41. Claims App. The Examiner’s rejection of these claims suffers from the same infirmity that was identified above with respect to claims 24 and 41. Thus, for essentially the same reason expressed above in connection with claims 24 and 41, we do not sustain the rejection of claims 28, 32, 35, 39, 45, 47, and 49.

*Unpatentability of Claims 24, 28, and 47
over Herman*

For reasons previously discussed in connection with the Examiner’s unpatentability rejection of these same claims over Mock and Herman, we agree with Appellants that Herman does not teach that a player’s accomplishment (such as arriving at a home end space) ends the game. *See* Appeal Br. 34. Thus, we do not sustain the Examiner’s unpatentability rejection of claims 24, 28, and 47 over Herman.

*Unpatentability of Claim 28
over Herman and Barratt*

Claim 28 depends from claim 24 and adds the limitation: “wherein the playing spaces are shaped and positioned so that adjacent spaces do not touch.” Claims App. The Examiner finds, and Appellants do not dispute, that Barratt discloses this limitation. Final Action 12–13, Appeal Br. 35. In traversing the rejection, Appellants argue patentability based solely on arguments advanced with respect to claim 24. Appeal Br. 35. For

essentially the same reason expressed above in connection with claim 24, we do not sustain the rejection of claim 28.⁵

*Unpatentability of Claim 32
over Herman and Bryant*

Claim 32 depends from claim 24 and adds the limitation: “wherein a particular second instruction space comprises instructions for the player to collect a particular first credential card if the player obtains a particular number on the random number generating device, and instructions for the player's turn to end if the player does not obtain the particular number.” Claims App. The Examiner finds, and Appellants do not dispute, that Bryant discloses rolling a number to collect a card. Final Action 13, Appeal Br. 35. However, Bryant does not cure the deficiency noted above with respect to the unpatentability of claim 24 over Herman. Thus, for essentially the same reason expressed above in connection with claim 24, we do not sustain the rejection of claim 32.

⁵ Barratt arguably cures the deficiency noted above with respect to Mock and Herman not disclosing an end space. *See* Barratt, col. 5, l. 16–17 (“The object of the game is for a player to move his/her game piece **20** across the finish with the most fun points”). However, the Examiner failed to rely on Barratt as satisfying the end space limitation in the rejection. Final Action 10–11. Furthermore, the Examiner arguably could have cured the deficiency that we noted above in connection with the rejection of claims 24, 28, 32, 35, 39, 41, 45, 47, and 49 over Mock and Herman by combining such references with Barratt. The Board enters a new ground of rejection at its discretion, and no inference should be drawn from a failure to exercise that discretion here with respect to Barratt’s finish. 37 C.F.R. § 41.50(b).

*Unpatentability of Claims 37 and 43
over Mock, Herman and Teal*

These claims depend, directly or indirectly, from claim 24. Claims App. Claims 37 and 43 each respectively adds the limitation: “wherein the gameplay cards further comprise a plurality of question cards that contain questions for the player to answer; the questions on the question cards do not affect the player's position on the sinuous path; and the questions relate to aspects of homelessness.” *Id.* The Examiner’s rejection of these claims suffers from the same infirmity that was identified above with respect to claim 24, which infirmity is not cured by any findings by the Examiner based on Teal. Thus, for essentially the same reason expressed above in connection with unpatentability rejection of claim 24, we do not sustain the unpatentability rejection of claims 37 and 43.

DECISION

The decision of the Examiner to reject claims 24, 28, 32, 35, 37, 39, 41, 43, 45, 47, and 49 under 35 U.S.C. § 101 as directed to a judicial exception to patent eligible subject matter is AFFIRMED.

The decision of the Examiner to reject claims 23, 33, 34, 36, 38, 40, 42, 44, 46, and 48 as unpatentable under 35 U.S.C. § 103 over Herman is AFFIRMED.

The decision of the Examiner to reject claim 27 as unpatentable under 35 U.S.C. § 103 over Herman and Barratt is AFFIRMED.

The decision of the Examiner to reject claims 24, 28, and 47 as unpatentable under 35 U.S.C. § 103 over Herman is REVERSED.

The decision of the Examiner to reject claims 24, 28, 32, 35, 39, 41, 45, 47, and 49 as unpatentable under 35 U.S.C. § 103 over Mock and Herman is REVERSED.

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The decision of the Examiner to reject claim 28 as unpatentable under 35 U.S.C. § 103 over Herman and Barratt is REVERSED.

The decision of the Examiner to reject claim 32 as unpatentable under 35 U.S.C. § 103 over Herman and Bryant is REVERSED.

The decision of the Examiner to reject claims 37 and 43 as unpatentable under 35 U.S.C. § 103 over Mock, Herman and Teal is REVERSED.

No time period for taking any subsequent action in connection with this appeal may be extended. *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LIZ COON, LYNN CIFKA, and JOHN DANIELS

Appeal 2018-007249
Application 13/750,646
Technology Center 3700

Before MICHAEL L. HOELTER, WILLIAM A. CAPP, and
LEE L. STEPINA, *Administrative Patent Judges*.

HOELTER, *Administrative Patent Judge*, dissenting-in-part.

I respectfully dissent, but only with respect to the majority’s decision that claims 24, 28, 32, 35, 37, 39, 41, 43, 45, 47, and 49 (i.e., the Method Claims) fall within the ambit of a method of organizing human activity. To be clear, I would reach a different conclusion at the end of Prong 1. In effect, I am persuaded by Appellants’ arguments that the Method Claims do not run afoul of 35 U.S.C. § 101.

As expressed above, the Examiner characterizes the Method Claims as requiring the steps of generating random information, moving game pieces, and collecting/earning game cards. However, we have been cautioned by our reviewing court to not “overly abstract” the claims when performing the *Mayo/Alice* analysis; but that is exactly what the Examiner appears to have done.

It is not disputed that claim 24 recites multiple steps of “providing” certain apparatus (i.e., a game board (having a certain arrangement), a game piece, gameplay cards, credential cards, and a number generating device). Although providing such might be conventional and/or obvious (an inquiry for another day), the provision of such structure is simply that, providing structure. It is not understood how the steps of providing physical structure for subsequent use can, instead, be depicted as a rule of, or the management of, game play, without relying on an “overly abstract” characterization of these steps.⁶

Of particular note is the majority’s reference to *Guldenaar*, whose pertinent claim recited the steps of providing marked die, placing a wager, rolling the die, and paying a payout. These claims were determined to be directed to rules for playing a dice game. Judge Mayer’s concurring opinion in *Guldenaar* analogized these claims to other “how to” claims that addressed human action.⁷ I would agree that claims addressing “how to” do an activity require further attention, but the present claims under appeal are not “how to” claims. They are, instead, more properly described as being “what with” claims.

⁶ To be fair, claim 1 also includes two limitations directed to what is to be accomplished during a turn, and concluding the game. However, in my opinion, these two limitations pale in comparison to the provision of the above cited structure.

⁷ “[I]deas about how to improve or influence human thought and behavior fail to pass section 101 muster. This is why claims telling people how to mitigate settlement risk, *Alice*, . . . how to hedge against risk in consumer transaction, *Bilski*, . . . or how to play a game of cards, *In re Smith*, . . . are directed to non-statutory subject matter.” *Guldenaar* 911 F.3d at 1165.

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Thus, because I view the present claims differently, and because, if the claims are not directed to an abstract idea, the subject matter eligibility inquiry ends, I respectfully dissent from the majorities' 35 U.S.C. § 101 analysis.