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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* JO-ANNE DRESSENDOFER

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Appeal 2018-007955  
Application 14/810,459<sup>1</sup>  
Technology Center 3700

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Before LINDA E. HORNER, WILLIAM A. CAPP, and  
BRENT M. DOUGAL, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134(a) of the Examiner’s rejection of claims 1–16 and 21–24.<sup>2</sup> Final Office Action (July 27, 2017, “Final Act.”), as further modified in the Examiner’s Answer (June 14, 2018, “Ans.”). We have jurisdiction under 35 U.S.C. § 6(b).

The Examiner rejected all of the claims as being directed to patent ineligible subject matter under 35 U.S.C. § 101 and as unpatentable over

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<sup>1</sup> Jo-Anne Dressendofer (“Appellant”) is the applicant and the real party in interest. Appeal Brief 3 (February 19, 2018, “Appeal Br.”).

<sup>2</sup> Claims 17–20 are canceled.

various combinations of prior art under 35 U.S.C. § 103. For the reasons set forth below, we agree with the Examiner that the claims are directed to an abstract idea and do not contain an inventive concept sufficient to transform the claimed abstract idea into a patent-eligible application. Further, we agree with the Examiner that the subject matter of claims 1–16, 21, and 22 is unpatentable under 35 U.S.C. § 103 as obvious over the prior art. We find, however, that the Examiner failed to establish unpatentability of claims 23 and 24 over the prior art. Thus, we do not sustain the rejection of claims 23 and 24 under 35 U.S.C. § 103.

Because we sustain at least one rejection of each claim on appeal, we **AFFIRM**.

#### CLAIMED SUBJECT MATTER

The claimed subject matter on appeal relates generally to games that include instruction cards that dictate the move the player shall make after drawing the card. Specification ¶ 7 (“Spec.”).<sup>3</sup> The card may instruct the player, for example, to move his own game piece or the opponent’s game piece. *Id.*; *see also* claim 1. The card may, alternatively, instruct the player to switch sides with an opponent. *Id.*; *see also* claim 2. The instruction cards can be used with strategy games, such as chess, backgammon, checkers, the Parcheesi<sup>®</sup> board game, etc., and with word games like the Scrabble<sup>®</sup> board game. *Id.* ¶ 3.

Claims 1 and 23 are the independent claims. Claim 1 is representative of the subject matter on appeal and is reproduced below.

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<sup>3</sup> Citations to the Specification are to the Substitute Specification filed on September 22, 2015.



## REJECTIONS

The Final Office Action, as modified by the Examiner's Answer<sup>4</sup>, includes the following rejections:

1. Claims 1–16 and 21–24 are rejected under 35 U.S.C. § 101 as being directed to patent ineligible subject matter.
2. Claims 1–6, 15, 21, and 22 are rejected under 35 U.S.C. § 103 as unpatentable over Harmening.
3. Claims 7–14 and 16 are rejected under 35 U.S.C. § 103 as unpatentable over Harmening and Wordgame.
4. Claims 23 and 24 are rejected under 35 U.S.C. § 103 as unpatentable over Harmening, Wordgame, and Barker.

## ANALYSIS

### *Rejection under 35 U.S.C. § 101*

#### *Legal Principles*

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

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<sup>4</sup> The Examiner modified the rejection under 35 U.S.C. § 103 of claim 8 to correct a typographical error. Ans. 10, 17. Also, because claims 21 and 22 depend from claims 2 and 3, respectively, the Examiner modified the rejection of claims 21 and 22 under 35 U.S.C. § 103 to be rejected based on Harmening alone. *Id.* at 5. Appellant presented arguments in its Appeal Brief in keeping with the claim rejections as modified in the Examiner's Answer. Appeal Br. 13, 18.

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

Concepts determined to be abstract ideas, and thus patent ineligible, include certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)). Concepts determined to be patent eligible include physical and chemical processes, such as “molding rubber products” (*Diamond v. Diehr*, 450 U.S. 175, 191 (1981)); “tanning, dyeing, making water-proof cloth, vulcanizing India rubber, smelting ores” (*id.* at 182 n.7 (quoting *Corning v. Burden*, 56 U.S. (15 How.) 252, 267–68 (1854))); and manufacturing flour (*Benson*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

In *Diehr*, the claim at issue recited a mathematical formula, but the Supreme Court held that “a claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula.” *Diehr*, 450 U.S. at 187; *see also id.* at 191 (“We view respondents’ claims as nothing more than a process for molding rubber

products and not as an attempt to patent a mathematical formula.”). Having said that, the Supreme Court also indicated that a claim “seeking patent protection for that formula in the abstract . . . is not accorded the protection of our patent laws, . . . and this principle cannot be circumvented by attempting to limit the use of the formula to a particular technological environment.” *Id.* (citing *Benson* and *Flook*); *see, e.g., id.* at 187 (“It is now commonplace that an *application* of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.”).

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

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

- (1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing

human activity such as a fundamental economic practice, or mental processes); and

(2) additional elements that integrate the judicial exception into a practical application (*see* MPEP §§ 2106.05(a)–(c), (e)–(h) (9<sup>th</sup> ed. Rev. 08.2017, Jan. 2018)).

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

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

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

*See* Guidance, 84 Fed. Reg. at 54–56.

### *Claim Grouping*

Appellant argues claims 1–16, 21, and 22 as a group. Appeal Br. 9–12. We select claim 1 as representative of the group, and claims 2–16, 21, and 22 stand or fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Appellant further argues that claim 23, and its dependent claim 24, are patentable “for the same reasons cited above for claim 1.” Appeal Br. 13. Thus, the resolution of the appeal of the rejection under 35 U.S.C. § 101 turns on our analysis of the rejection as to claim 1.

### *Claim Scope*

The preamble of claim 1 is directed to a “game.” The remainder of the preamble, i.e., “wherein a player and an opponent each strategically

move both their own games pieces and their opponent's game pieces," recites the intended use of the game.

The body of claim 1 recites certain physical components of the game in a generic manner. Specifically, claim 1 recites that the game comprises "a plurality of player's game pieces" and "a plurality of opponent's game pieces." These recitations are not specific as to the form of the game pieces. The Specification describes an embodiment of the game suitable for use with conventional chess pieces. Spec. ¶ 91. In the case of a chess game, for example, the player's game pieces could be the white chess pieces and the opponent's game pieces could be the black chess pieces. *Id.* The Specification describes another embodiment of the game that may be used in conjunction with board games such as the Scrabble® board game. *Id.* ¶ 113. In the case of the Scrabble® board game, the game pieces used by both the player and the opponent can be conventional Scrabble® letter tiles. In this embodiment, the player's game pieces would not differ physically from the opponent's game pieces, i.e., both the player and the opponent select game pieces from the same pool of letter tiles. The Specification also describes that the claimed game can be used in conjunction with other games, including solitaire, backgammon, the Parcheesi® board game, and checkers. *Id.* ¶ 127. Like the Specification, the independent claims do not require that, for example, the player's game pieces differ physically from the opponent's game pieces. The recitations of player's game pieces and opponent's game pieces are so broad as to encompass any physical objects that can be used as game pieces.

The body of claim 1 further recites "a plurality of physical cards, each physical card having a face." The Specification describes that the

instruction cards can be dice, “wherein a player may roll the dice and play the move which appears on the top face of the dice.” Spec. ¶ 89. Figures 1A through 1L are illustrations of “piece cards” that are embodiments of the claimed “physical card[s] having a face.” Spec. ¶¶ 13–24. The generic recitation in claim 1 of “a plurality of physical cards” is claimed broadly and is not specific as to a particular number of cards, aside from having more than one card, and is not specific as to any physical attributes of the cards. Also, the fact that each card has a face is simply an inherent attribute of a card itself and does not further define or meaningfully limit the claimed cards.

We next look to the “wherein” clauses to help us further determine the scope of the claims. The first “wherein” clause of claim 1 recites that the plurality of physical cards comprise a first player piece card and a second player piece card, where these cards contain certain indicia on them. Each card’s marking communicates instructions to players indicating which game piece they should move. Thus, the recited claim limitation is directed to information. The printed indicia on each card are not functionally related to the substrate of the card. Unlike in *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983), where digits were printed on a *band* in such a manner that the digits exploited the endless nature of the *band* itself, and the particular sequence of digits was critical to the invention disclosed in the claims, or *In re Miller*, 418 F.2d 1392 (CCPA 1969), where the volumetric indicia on the side of a *cup* created a specialized measuring *cup*, the indicia on each of Appellant’s *cards* do not cause the *card* itself to become a manufacture with new functionality. Rather, similar to *In re Ngai*, 367 F.3d 1336 (Fed. Cir. 2004), where a new set of instructions added to a known kit was held to

simply teach a new use for an existing product, here, the printed indicia on each card simply teach a new use for an existing game, e.g., chess.

The second “wherein” clause of claim 1 recites that “the player must randomly select one of the plurality of physical cards before making each move.” This recitation describes rules for playing the game. In other words, this “wherein” clause describes how the game is played, but does not further limit any of the physical components of the game discussed above. This second “wherein” clause is simply a statement of intended use, i.e., rules for playing the game, using the claimed physical game pieces and cards.

Likewise, the third “wherein” clause of claim 1 recites additional rules that the player must follow depending on whether the selected physical card is a first player piece card or a second player piece card. Similar to the second “wherein” clause discussed above, this recitation describes how the game is played, but does not further limit any of the physical components of the game. Thus, in determining the scope of claim 1, this third “wherein” clause also is simply a statement of intended use, i.e., rules for playing the game, using the claimed physical game pieces and cards.

*Step One: Does Claim 1 Fall within a Statutory Category of § 101?*

We now examine whether the claim recites one of the enumerated statutory classes of subject matter, i.e., process, machine, manufacture, or composition of matter, eligible for patenting under 35 U.S.C. § 101.

Claim 1 is directed to a game, which is one of the statutory classes (i.e., a manufacture) under 35 U.S.C. § 101.

*Step 2A, Prong One: Does Claim 1 Recite a Judicial Exception?*

We next look to whether the claim recites any judicial exceptions, including certain groupings of abstract ideas, i.e., mathematical concepts,

certain methods of organizing human activity such as a fundamental economic practice, or mental processes.

Claim 1 recites “wherein the player must randomly select one of the plurality of physical cards before making each move.” This, the second “wherein” clause of claim 1, recites rules of the game, which rules call for the player to do an action before doing another action. For instance, the rule requires the player to randomly select a card by, for example, either drawing a playing card or rolling a die or set of dice, before moving a game piece. This “wherein” clause pertains to a player following rules or instructions on how to play the game, which relates to managing personal behavior or relationships or interactions between people. *See In re Marco Guldenaar Holding B.V.*, 911 F.3d 1157, 1160 (Fed. Cir. 2018) (holding that rules for playing games “is one type of method of organizing human activity.”). Managing personal behavior or relationships or interactions between people falls within the abstract idea exception subgrouping of methods of organizing human activity. Guidelines, 84 Fed. Reg. at 52. Thus, the second “wherein” clause of claim 1 recites a method of organizing human activity, which is a judicial exception.

Claim 1 further recites “wherein if the selected physical card is a first player piece card the player must move the corresponding player’s game piece and if the selected physical card is a second player piece card the player must move the corresponding opponent’s game piece.” This, the third “wherein” clause of claim 1, recites additional rules of the game, which rules call for the player to do a particular action based upon the indicia on a selected card. For instance, the Specification describes that “if the player draws a black knight card, he must move a black knight on the chessboard.

If he draws a white rook card, he must move a white rook.” Spec. ¶ 93. This “wherein” clause pertains to a player following rules or instructions on how to play the game, which relates to managing personal behavior or relationships or interactions between people. *See Marco Guldenaar* 911 F.3d at 1160. Managing personal behavior or relationships or interactions between people falls within the abstract idea exception subgrouping of methods of organizing human activity. Guidelines, 84 Fed. Reg. at 52. Thus, the third “wherein” clause of claim 1 recites a method of organizing human activity, which is a judicial exception.

Considered as a whole, the second and third “wherein” clauses discussed above, under their broadest reasonable interpretation, contribute to the rules of playing the game and recite steps for managing interactions between people, which are methods of organizing human activity. These limitations are similar to other processes that courts have determined are methods of organizing human activity. *See, e.g., Marco Guldenaar*, 911 F.3d at 1160–61 (holding that a claimed “method of playing a dice game” was drawn to an abstract idea); *In re Smith*, 815 F.3d 816, 819 (Fed. Cir. 2016) (holding that a claimed “method of conducting a wagering game” using a deck of playing cards was drawn to an abstract idea).

*Step 2A, Prong Two: Does Claim 1 Recite Additional Elements that Integrate the Judicial Exceptions into a Practical Application?*

Following our Office guidance, having found that claim 1 recites a judicial exception, we next determine whether the claim recites “additional elements that integrate the exception into a practical application” (*see* MPEP §§ 2106.05(a)–(c), (e)–(h)). *See* Guidance, 84 Fed. Reg. at 54.

Claim 1 further recites that the game comprises “a plurality of player’s game pieces,” “a plurality of opponent’s game pieces,” and “a plurality of physical cards, each physical card having a face.” As discussed above in our interpretation of the claim language, the player and opponent game pieces are recited generically and encompass any physical objects that can be used as game pieces. Also, as discussed above, the physical cards are recited generically and are not specific to any particular manifestation of the cards, e.g., playing cards or dice. The only physical requirement of the cards recited in this claim language is that each card has a face, which is an inherent characteristic of the card itself.

Claim 1 further recites “wherein said plurality of physical cards comprise a first player piece card, an indicia of one of the player’s game pieces on the face of the first player piece card, and a second player piece card, an indicia of one of the opponent’s game pieces on the face of the second player piece card.” As discussed above, this wherein clause recites printed matter that is not functionally related to the substrate of the card and is used to convey information for a new use for an existing game. Printed matter cannot be relied on as the practical application of an abstract idea. *See Marco Guldenaar*, 911 F.3d at 1161 (“this court has generally found printed matter to fall outside the scope of § 101”) (citing *AstraZeneca LP v. Apotex, Inc.*, 633 F.3d 1042, 1064 (Fed. Cir. 2010)). *See also Praxair Distrib., Inc. v. Mallinckrodt Hosp. Prod. IP Ltd.*, 890 F.3d 1024, 1032 (Fed. Cir. 2018) (“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.”).

Thus, the methods of organizing human activity of claim 1 are recited as being performed with generic game pieces and with generic physical cards containing printed matter that, when considered both individually and in combination, do not implement the judicial exception with, or use the judicial exception in conjunction with, a particular machine or manufacture that is integral to the claim. The recitations of the generic structures, with which the recited steps are performed, are merely instructions to apply the judicial exception in the context of a game. Thus, the claims do not apply, rely on, or use rules of playing the game, i.e., the methods of organizing human activity, in a manner that imposes a meaningful limit on those aspects of the claim. *See, e.g., Marco Guldenaar*, 911 F.3d at 1162 (holding that “[b]ecause the only arguably unconventional aspect of the recited method of playing a dice game is printed matter, which falls outside the scope of § 101, the rejected claims do not recite an ‘inventive concept’ sufficient to ‘transform’ the claimed subject matter into a patent-eligible application of the abstract idea.”). Rather, the claim is simply a drafting effort designed to monopolize the rules of playing the game of claim 1.

Under step one of the *Alice* inquiry, “we evaluate the focus of the claimed advance over the prior art to determine if the character of the claim as a whole, considered in light of the specification, is directed to excluded subject matter.” *Trading Technologies Int’l, Inc. v. IBG LLC*, 921 F.3d 1084, 1092 (Fed. Cir. 2019) (citations and internal quotation marks omitted). The claims are not directed to an improvement in the claimed game pieces. Rather, the claims are directed to an improvement in the way the conventional game is played through the use of playing cards, having printed matter, which provides instructions to the player on how to play the game.

This asserted improvement to the manner in which a conventional game, such as chess, is played does not reflect an improvement in the particular manufacture, i.e., the game. Rather, the improvement lies in the rules for playing the game, which is the judicial exception itself.

We acknowledge that the claims at issue are directed to a physical game (*see* Appeal Br. 11), unlike the claims in *Smith* and *Marco Guldenaar*, which were directed to a method of playing a game. This distinction does not necessitate a different outcome in this instance due to the generic manner in which the physical components of the game are claimed, and due to Appellant’s reliance on printed matter as the inventive contribution. We find the Court’s recent discussion in *Chamberlain Group, Inc. v. Techtronic Industries Co.*, No. 2018-2103 (Fed. Cir. August 21, 2019) instructive on this point.

The court in *Chamberlain Group* held that apparatus claims for communicating information about the status of a movable barrier, for example, a garage door, were directed to an abstract idea. Slip op. at 3 (claim 1 reciting a “movable barrier operator”). The court determined that the focus of the claimed advance over the prior art was directed to wirelessly communicating status information about a system. *Id.* at 5. The court held that “[t]he specification admits that the act of transmitting data wirelessly is ‘well understood in the art,’ and no other changes to the *generically* claimed movable barrier operator are recited in the asserted claims or described in the specification.” *Id.* at 7 (emphasis added). As to the physical nature of the claim elements, the court stated “the mere physical nature of [patentee’s] claim elements (*e.g.*, controller, interface, and wireless data transmitter) is not enough to save the claims from abstractness, where the claimed advance

is directed to the wireless communication of status information using off-the-shelf technology for its intended purpose.” *Id.* at 8 (citing *Marco Guldenaar*, 911 F.3d at 1161).

As in *Chamberlain Group*, the claims in this case use a generic game where the claimed advance is the printed matter on the cards and the rules for playing the game. Appellant does not assert that the general idea of using playing cards having indicia printed on them in a game is an advance in the field of gaming. *See generally* Appeal Br. 9–12. Rather, Appellant argues that *the particular indicia* printed on the claimed plurality of playing cards is the advance. *Id.* at 10 (arguing that the specific features of the physical cards recited in the first wherein clause of claim 1 “distinguish the cards from those of a standard deck,”<sup>5</sup> and arguing that “[t]hese distinguishing features of the physical cards are critical to play of the game” as claimed in the subsequent wherein clauses of claim 1.)

Thus, the additional elements do not add meaningful limits to the method of organizing human activity limitations recited in claim 1. Instead, the generic game limitations are no more than instructions to apply the judicial exception using generic game components.

For these reasons, the additional elements of claim 1 do not integrate the judicial exception into a practical application. Thus, claim 1 is directed

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<sup>5</sup> Appellant does not identify what is meant in this argument by “a standard deck.” Appeal Br. 11–12. We note that Harmening is directed to a modified game of chess which employs a 52-card deck, where each card has a face bearing indicia printed thereon representing one of the chess pieces. Harmening ¶¶ 4, 8. Thus, as discussed further below, Appellant’s assertion that the plurality of cards bearing the claimed indicia are a distinguishing aspect of the claimed game is without merit.

to an abstract idea, which is a judicial exception to patent eligible subject matter under 35 U.S.C. § 101.

*Step 2B: Does Claim 1 Recite an Inventive Concept?*

We next consider whether claim 1 recites any elements, individually or as an ordered combination, that transform the abstract idea into a patent-eligible application, e.g., by providing an inventive concept. *Alice*, 573 U.S. at 217–18. The guidance similarly states, under Step 2B, “examiners should . . . evaluate the additional elements individually and in combination . . . to determine whether they provide an inventive concept (*i.e.*, whether the additional elements amount to significantly more than the exception itself).” 84 Fed. Reg. at 56 (emphasis added).

As discussed above, the additional elements include generic recitations of game pieces and physical cards bearing printed matter. These additional elements do not add a specific limitation or combination of limitations that are not well-understood, routine, conventional activity in the field. Rather, the claimed game pieces are recited at such a high level of generality as to encompass any physical object capable of being used as a game piece. And as discussed above, the Specification describes that the game pieces can be conventional game pieces. Likewise, the claimed physical cards having a face are recited at such a high level of generality as to encompass a variety of physical objects, including conventional playing cards or dice. Further, Appellant does not contend that the use generally of playing cards and game pieces in combination is unconventional.

Appellant argues the specific claimed indicia on the cards correspond to the piece movement for the player, and that “[t]he claimed cards are not only a required physical apparatus of the game, but the indicia of the cards

transform conventional game play with the unconventional step of the player needed to move either their own or their opponent's game piece.” Appeal Br. 11; *see also id.* at 12 (arguing that the claimed “original deck of cards” survive step two of *Alice*). Reliance on printed matter, i.e., indicia printed on the face of the cards, to survive step two of *Alice*, was foreclosed by the court in *Marco Guldenaar*, 911 F.3d at 1161.

In our view, claim 1 fails to add a specific limitation beyond the judicial exception that is not “well-understood, routine, conventional” in the field, but instead “simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.” *See* Guidance, 84 Fed. Reg. at 56. For the reasons discussed above, we find no element or combination of elements recited in claim 1 that contains any “inventive concept” or adds anything “significantly more” to transform the abstract concept into a patent-eligible application. *Alice*, 573 U.S. at 221.

For these reasons, we find no error in the Examiner's rejection of claim 1, and claims 2–16 and 21–24, under 35 U.S.C. § 101.

### *Rejections under 35 U.S.C. § 103*

#### *Rejection of claims 1–6, 15, 21, and 22 over Harmening*

Appellant argues claims 1, 4–6, and 15 as a first group and claims 2 and 3 as a second group. Appeal Br. 16. We select claims 1 and 2 as representative claims for each group. Claims 4–6 and 15 stand or fall with claim 1, and claim 3 stands or falls with claim 2. *See* 37 C.F.R. § 41.37(c)(1)(iv).

In the rejection of claim 1, the Examiner found that Harmening teaches the claimed player and opponent game pieces and physical cards,

each having a face, comprising a first player piece card, an indicia of one of the player's game pieces on the face of the first player piece card, and a second player piece card, an indicia of one of the opponent's game pieces on the face of the second player piece card. Final Act. 5 (citing Harmening, Abst., ¶¶ 4, 10). The Examiner further found that Harmening teaches that the player must select one of the physical cards before making a move and that if the selected physical card is a first player piece card the player must move the corresponding player's game piece and if the selected physical card is a second player piece card the player must move the corresponding opponent's game piece. *Id.* at 6 (citing Harmening, Abst., ¶¶ 4, 10). The Examiner found that "Harmening may not explicitly teach certain aspects of the printed material on the cards or some of the specific rules for movements." *Id.* at 6. The Examiner noted that where the printed matter is not functionally related to the substrate, it will not patentably distinguish the invention from the prior art. *Id.*

Appellant argues that although Harmening's cards are marked with a game piece, they are not marked with indicia which distinguish between player's game pieces and opponent's game pieces. Appeal Br. 15. As noted above in our interpretation of the claim language, the claimed indicia marked on playing cards are printed matter that are not functionally related to the substrate. Such printed matter cannot be relied on to patentably distinguish the claimed playing cards from prior art cards bearing different indicia. *See In re Bryan*, 323 Fed. App'x. 898, 901 (Fed. Cir. 2009) (holding that printed matter indicia on touring band themed game cards and game board that are not functionally related to the substrate are nonfunctional printed matter that do not patentably distinguish over the prior art). The

court in *Bryan*, in response to arguments similar to those made by Appellant here, noted that Mr. Bryan's arguments that the printed matter is functionally related because it allows the cards to be collected, traded, and drawn during game play "pertain to the patentability of *methods or processes* of playing the game, which are irrelevant to the *apparatus* claims at issue." *Id.*

Applying the logic set forth in *Ngai*, 367 F.3d at 1339, the court in *Bryan* explained that "if we were to accept Mr. Bryan's arguments, it seems anyone could patent the structure of a pre-existing game simply by changing the game's theme without changing its structure." 323 Fed. App'x. at 901–902.

Appellant also argues that Harmening does not teach a player moving both the player's game pieces and the opponent's game pieces. Appeal Br. 15 (arguing that "the present application includes unconventional moves, such as the movement of an opponent's piece"). This argument, and the claim limitations relied on, do not distinguish the claimed game apparatus structurally from Harmening's game. Rather, the distinctions are directed to the method of playing the game. The limitations relied on by Appellant are directed to the intended use of the physical game components and do not patentably distinguish these components over Harmening's components. *See In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997) ("It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable.").

Claim 2 depends from claim 1 and recites that the plurality of physical cards further comprises "a switch card, a switch indicia on the face of the switch card, whereby when the switch card is drawn the player must switch positions with the opponent, so that the player takes control of the

opponent's game pieces and the opponent takes control of the player's game pieces." Appeal Br. 21.

The Examiner held that Harmening teaches a switch card. Final Act. 7 (citing Harmening ¶¶ 4, 10). Specifically, the Examiner explained that "[t]he switch card does not impart structure into the claim and is directed to printed matter and the intended use of the card. Such limitations are not seen as providing patentable distinction over the prior art." *Id.* at 7.

Appellant argues that "one skilled in the art would have no motivation to modify Harmening to include the limitations of claim 2" and that the use of the switch card of claim 2 "dramatically alters game play *away* from conventional objectives of a chess game as taught by Harmening." Appeal Br. 16. Appellant also directs our attention to the Chagrin, Gottlieb, and Gill declarations, which Appellant submitted to provide objective evidence of non-obviousness of claims 2 and 3. *Id.* at 17.

As in our analysis of the argued limitations of claim 1, Appellant's arguments and evidence as to the distinguishing features of claim 2 do not serve to patentably distinguish the claimed switch card from Harmening's cards. Specifically, the declarations focus on the use of the switch card in playing the game and do not identify any patentably distinguishing physical characteristic of the claimed switch card. Chagrin Dec. ¶¶ 6–8; Gill Dec. ¶¶ 6–7; Gottlieb Dec. ¶¶ 6–7. As with the indicia recited in claim 1, the claimed indicia printed on the switch card of claim 2 are not functionally related to the substrate of the card. Thus, the indicia aspect of claim 2 is printed matter that cannot be relied on to patentably distinguish over Harmening's cards. The remainder of claim 2 recites intended use of the card, similar to the last two wherein clauses of claim 1. Thus, for the same

reasons discussed above, claim 2 does not patentably distinguish over Harmening.

Appellant does not present additional arguments for claims 21 and 22, which depend from claim 1, apart from the arguments raised in support of claim 1. Appeal Br. 19.

For the reasons discussed above, we sustain the rejection of claims 1–6, 15, 21, and 22 under 35 U.S.C. § 103 as unpatentable over Harmening.

*Rejection of claims 7–14 and 16 over Harmening and Wordgame*

Appellant argues claims 7–14 and 16 as a group. Appeal Br. 18–19. We select claim 7 as representative. Claims 8–14 and 16 stand or fall with claim 7. *See* 37 C.F.R. § 41.37(c)(1)(iv). Claim 7 depends from claim 1 and recites “a game board, wherein the plurality of player’s game pieces and the plurality of opponent’s game pieces each represents a letter, and wherein a plurality of game pieces are placed on the game board to form a word.” Appeal Br. 22.

The Examiner found that Wordgame teaches game pieces each representing a letter and placed on a game board to form a word. Final Act. 10. Appellant argues that “player’s and opponent’s decks are separated in Wordgame, and a player is thereby prevented from selecting a card corresponding to an opponent’s game piece or moving an opponent’s game piece, as recited in claim 1 from which claim 7 depends.” Appeal Br. 18–19. Thus, Appellant contends that Wordgame does not cure the deficiency in Harmening asserted in the rejection of claim 1. *Id.* Having found no deficiency in the rejection of claim 1 over Harmening, we likewise sustain the rejection of claims 7–14 and 16 as unpatentable over Harmening and Wordgame.

*Rejection of claims 23 and 24 over Harmening, Wordgame, and Barker*

Independent claim 23, and dependent claim 24, are directed to an electronic game. Appeal Br. 24–25. Claim 23 recites, in relevant part, that when a first piece card is displayed on the screen of the electronic game, the available moves for the player to move the corresponding player’s game piece are highlighted on the board, and when a second piece card is displayed on the screen of the electronic game, the available moves for the player to move the corresponding opponent’s game piece are highlighted on the board. *Id.* at 25.

The Examiner found that Barker teaches an electronic device having a screen, a board displayed on the screen, and a virtual environment where cards can be displayed. Final Act. 16 (citing Barker, Figs. 1–3). The Examiner determined it would have been obvious to modify Harmening to include a virtual format of the game, as taught by Barker, so that Harmening’s game can be played on-line. *Id.* (citing Barker ¶ 2).

Appellant argues that Barker, which is cited as providing an electronic device having a screen, is not relied on to teach “virtual cards having indicia of player’s and opponent’s game pieces or *with respect to available moves corresponding to the indicia of virtual cards.*” Appeal Br. 19 (emphasis added).

We understand claim 23 to require that the electronic game is programmed to highlight the available moves based on the displayed virtual card. The Examiner has not addressed this aspect of claim 23 in the rejection and, particularly, has not explained what would have led one having ordinary skill in the art, modifying Harmening to include a virtual

format as disclosed in Barker, to include the functionality to provide highlighting of the available moves on the display.

For these reasons, we do not sustain the rejection of claims 23 and 24 under 35 U.S.C. § 103 as unpatentable over Harmening, Wordgame, and Barker.

#### DECISION

We sustain the rejection of claims 1–16 and 21–24 under 35 U.S.C. § 101, the rejection of claims 1–6, 15, 21, and 22 under 35 U.S.C. § 103 as unpatentable over Harmening, and the rejection of claims 7–14 and 16 under 35 U.S.C. § 103 as unpatentable over Harmening and Wordgame.

We do not sustain the rejection of claims 23 and 24 under 35 U.S.C. § 103 as unpatentable over Harmening, Wordgame, and Barker.

Because we sustain at least one ground of rejection as to each claim on appeal, the decision of the Examiner as to the unpatentability of claims 1–16 and 21–24 is affirmed.

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

AFFIRMED