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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JUNICHI MASUDA and TORU NAGIHASHI

Appeal 2019-000243
Application 13/793,300
Technology Center 3700

Before MICHAEL L. HOELTER, LISA M. GUIJT, and
LEE L. STEPINA, *Administrative Patent Judges*.

HOELTER, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1 and 3–19. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as “Nintendo Co., Ltd.” Appeal Br. 3.

CLAIMED SUBJECT MATTER

The disclosed subject matter “relates to a game system, a computer-readable nontransitory storage medium, a game processing method and a game apparatus.” Spec. ¶ 1. System claims 1, 7, and 19, apparatus claims 12 and 14, and method claim 13 are independent. Claim 1 is illustrative of the claims on appeal and is reproduced below.

1. A game system including one or more game apparatuses, the game system comprising:

at least one input device;

a first game execution unit comprising at least one processor and configured to:

execute a first game in accordance with an instruction of a player inputted via the at least one input device;

set a first game mode of a first degree of difficulty accessible in the first game regardless of execution of a second game on a second game execution unit;

determine whether an execution result of the first game satisfies a predetermined condition, wherein the predetermined condition is that in accordance with the execution result of the first game in a second degree of difficulty, the first degree of difficulty becomes accessible in the first game; and

output predetermined first data indicating that the execution result of the first game satisfies the predetermined condition in response to the execution result of the first game having satisfied the predetermined condition; and

a second game execution unit comprising at least one processor and configured to:

execute a second game in accordance with an instruction of a player inputted via the at least one input device;

set a second game mode so as to be accessible in the second game regardless of execution of the first game on the first game execution unit; and

set a third game mode of the first degree of difficulty so as to be accessible in the second game in response to an execution result of the first game having satisfied the predetermined condition, the third game mode being set so as to (1) be inaccessible in the second game when the predetermined first data is yet to be received, and (2) in response to receiving the predetermined first data, be accessible in the second game,

wherein the first degree of difficulty is one of a plurality of degrees of difficulty of play available in the second game, and wherein the first degree of difficulty is different from degrees of difficulty of a game mode which are accessible in the second game when the execution result of the first game does not satisfy the predetermined condition, and

wherein the second game execution unit is configured to (a) receive the predetermined first data from the first game execution unit and (b) to not acquire the predetermined first data responsive to any execution result in the second game.

REJECTION²

Claims 1 and 3–19 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to a judicial exception (i.e., a law of nature, a natural phenomenon, or an abstract idea) without significantly more.

ANALYSIS

Appellant argues all the claims on appeal (i.e., claims 1 and 3–19) together. We select claim 1 for review, with the remaining claims standing or falling with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner finds that claim 1 “recites game program elements for managing a game” and that “[m]anaging or conducting a game as recited in

² “As amended, Claims 1 and 3 to 19 overcome the previous rejection under 35 U.S.C. [§] 103 over *Kawabata, Cooper and Hazama*. As such, this rejection has been withdrawn.” Ans. 7.

independent Claim 1 . . . is akin to the ‘organizing human activity’ at issue in Alice³ and Planet Bingo⁴.” Final Act. 7, 8 (*also referencing In re Smith*, 815 F.3d 816 (Fed. Cir. 2016)). To be clear, the Examiner concludes, “[c]laims 1 and 3 to 19 each describes rules for managing a game and therefore is directed to an abstract idea (Step 2A: YES).” Final Act. 8; *see also* Ans. 7, 8.

The Examiner next analyzes claim 1 to “determine whether there are additional limitations recited that amount to significantly more than the abstract idea. Final Act. 8; *see also* Ans. 8–14. The Examiner concludes, “[t]hese computer components are generically claimed” stating “that adding hardware that performs “‘well understood, routine, conventional activit[ies]’ previously known to the industry’ will not make claims patent-eligible.” Final Act. 8, 9; Ans. 10. Hence, in summation, the Examiner states, “[a]s such, the recitation of the computer limitations in Claims 1 and 3 to 19 amounts to mere instructions to implement the abstract idea on a computer.” Final Act. 9. Consequently, “none of the Claims 1 and 3 to 19 amounts to significantly more than the abstract idea itself (Step 2B: NO).” Final Act. 10; *see also* Ans. 14.

Appellant disagrees, relying on both *Finjan, Inc. v. Blue Coat Systems, Inc.*, 879 F.3d 1299 (Fed. Cir. 2018) and *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016). *See* Appeal Br. 13; *see also* Reply Br. 6. Appellant explains that in view of these decisions, “claims related to a database architecture that used a new, self-referential logical table were non-abstract because they focused on an improvement to computer functionality

³ *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208 (2014).

⁴ *Planet Bingo, LLC v. VKGS LLC*, 576 F. App’x 1005 (Fed. Cir. 2014).

itself, not on economic or other tasks for which a computer is used in its ordinary capacity.” Appeal Br. 13. Hence, Appellant contends that claim 1 “of the ’844 patent in *Finjan*” was deemed eligible subject matter because it enabled “a computer security system to do things it could not do before.” Appeal Br. 13–14. Likewise, Appellant asserts, “the claims of the subject application enables a computer game system ‘to do things it could not do before.’” Appeal Br. 14; *see also id.* at 18, Reply Br. 6. Appellant states that this is achieved “by configuring the second game execution unit to make the new game mode accessible . . . upon satisfying a predetermined condition in its game.” Appeal Br. 14; *see also* Reply Br. 8. Such an accomplishment “will not make a player easily get bored” and “provides new ways in which users can share games and news ways in which a user who owns multiple versions of game can enjoy the games.” Appeal Br. 14; *see also id.* at 20. This is because “there is no need for the user to switch between the external storage units 17a, 17b which store the game programs of the respective versions and to start up the game program of the other version, which is convenient for the user.” Appeal Br. 15.

However, a review of both *Finjan* and *Enfish* does not, in fact, support Appellant’s asserted position. This is because the *Finjan* court referenced *Enfish* stating that *Enfish*’s claim language was “non-abstract because they focused on ‘an improvement to computer functionality itself, not on economic or other tasks for which a computer is used in its ordinary capacity.’” *Finjan*, 879 F.3d at 1305 (*referencing Enfish*, 822 F.3d at 1336). Here, in contrast, Appellant’s claim language does not improve the “computer functionality itself,” but instead improves player satisfaction (“not make a player easily get bored”) by not having “to switch between the

external storage units . . . which is convenient for the user” *See supra*.

Thus, Appellant’s correlation of its claims to those of *Finjan* and *Enfish* is not a proper comparison.

Appellant further contends, “the subject matter of claim 1 is entirely different from any subject matter found to be non-statutory in the *Planet Bingo, Bilski*⁵ and *Alice* cases.” Appeal Br. 16; *see also* Reply Br. 2. This is because the subject matter of claim 1 “is not ‘akin to the “organizing human activity” at issue in *Alice* and *Planet Bingo*’ as alleged in the Final Rejection.” Appeal Br. 16; *see also* Reply Br. 2. Appellant also states, “the *In re Smith* court specifically relied on the wagering aspects to draw” its result and that in contrast to the *Alice*, *Planet Bingo*, *Bilski*, and *In re Smith* decisions, “claim 1 of the subject application does not recite wagering or financial aspects,” and as such is “not directed to any abstract idea.” Appeal Br. 17–18; *see also* Reply Br. 2–4, 6.

Appellant also contends, “claim 1 recites additional features that are ‘significantly more.’” Appeal Br. 19; *see also* Reply Br. 5, 7–8. Appellant argues that these “additional elements” include (a) the ability to communicate “between the two execution units;” (b) the ability to set “a game mode of a first degree of difficulty;” (c) the first game’s execution result “having an effect in the first game that is different than the effect caused in the second game;” and, (d) “a game mode that is not accessible by merely playing the game in the same execution unit.” Appeal Br. 19–20; *see also* Reply Br. 5–7. To be clear, Appellant argues that “[t]hese are not mere abstract rules,” “[r]ather, these additional features include specific

⁵ *Bilski v. Kappos*, 561 U.S. 593 (2010).

configurations in game execution units.” Appeal Br. 20; *see also* Reply Br. 8. According to Appellant, “as discussed above, the ‘additional elements’ in the Applicant’s claims are clearly not ‘previously known in the industry’” and hence “are not ‘well understood, routine, conventional activit[ies].” Appeal Br. 21; *see also* Reply Br. 9–10. As a result, “according to the USPTO’s April 2018 memorandum too, the ‘additional elements’ amount to ‘significantly more.’”⁶ Appeal Br. 21.

On January 7, 2019, the U.S. Patent and Trademark Office published revised guidance on the application of § 101. *See* 2019 Revised Patent Subject Matter Eligibility Guidance (“Revised Guidance”), 84 Fed. Reg. 50–57. Per the Revised 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 activities such as a fundamental economic practice, or mental processes) which is identified as “Prong One” of “*Step 2A*.” (Revised Guidance, 84 Fed. Reg. at 54, Section III.A.1.); and
- (2) additional elements that integrate the judicial exception into a practical application (see MPEP § 2106.05(a)–(c), (e)–(h))

⁶ On this latter point of “significantly more,” we are instructed that “use of the ineligible concept to which it is directed cannot supply the inventive concept that renders the invention ‘significantly more’ than that ineligible concept.” *BSG Tech LLC v. Buyseasons, Inc.*, 899 F.3d 1281, 1290 (Fed. Cir. 2018); *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.”).

which is identified as “Prong Two” of “*Step 2A.*” (Revised Guidance, 84 Fed. Reg. at 54, Section III.A.2.).

Only if a claim recites a judicial exception (*see* (1) above) and does not integrate that exception into a practical application (*see* (2) above), 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, and which are identified as “*Step 2B.*” Revised Guidance, 84 Fed. Reg. at 56, Section III.B.

STEP 2A, PRONG 1

Addressing (1) above, it is clear the Examiner found that claim 1 pertains to “managing or conducting a game.” Final Act. 8; *see also* Ans. 7–8. Appellant, on the other hand, contends, “the subject matter of claim 1 is entirely different from any subject matter” addressed in earlier cases, and further “the subject application does not recite wagering or financial aspects.” Appeal Br. 16, 18; *see also* Reply Br. 3–4. Granted, the subject application may not recite “wagering or financial aspects” as argued, but Appellant appears not to dispute that the subject application pertains to “managing or conducting a game” (albeit possibly different from other subject matter addressed in earlier cases). In *Smith*, our reviewing court stated that based upon their previous holding in *Planet Bingo* (“determining that methods of managing a game of bingo were abstract ideas”), “we

conclude that the rejected claims, describing a set of rules for a game, are drawn to an abstract idea.” *Smith*, 815 F.3d at 819. Hence, we cannot fault the Examiner for relying on both *Smith* and *Planet Bingo* as a basis for concluding in the present situation that rules for managing a game “are directed to an abstract idea.” Final Act. 8; *see also* Ans. 7–8.

We note the Examiner’s basis for such conclusion was that the limitations of claim 1 were “akin to [] ‘organizing human activity’” (Final Act. 8) whereas these earlier cases appear to instead rely on “fundamental economic practice” as the basis for their conclusions. However, on this point, we are provided guidance by our reviewing court which stated, in *In re Guldenaar*, 911 F.3d 1157, 1160–61 (Fed. Cir. 2018), that

In its brief, Appellant contends that the Patent Office uses a certain label—methods of organizing human activities—as a “catch-all abstract idea” and expresses concern that the Board has used the phrase improperly as an “apparent shortcut.” Appellant Op. Br. 16. We agree that this phrase can be confusing and potentially misused, since, after all, a defined set of steps for combining particular ingredients to create a drug formulation could be categorized as a method of organizing human activity. Here, however, 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 method of organizing human activity. In sum, we agree with the Board that Appellant’s claims are directed to the abstract idea of “rules for playing a dice game.”

Thus, as regarding “rules for playing games” (as is the case here, *see* Final Act. 8; *see also* Ans. 7–8), the Federal Circuit did not fault the Examiner’s rationale whether the basis was “methods of organizing human activities” or otherwise. We abide by this guidance and likewise do not fault

the Examiner for referencing these earlier cases while concluding that claim 1 “is akin to [] ‘organizing human activity.’”⁷ Final Act. 8.

STEP 2A, PRONG 2

We next turn to (2) above to ascertain whether there exist additional elements in claim 1 that integrate the judicial exception into a practical application. On this point the Revised Guidance specifically identifies “examples in which a judicial exception has not been integrated into a practical application.” Revised Guidance, 84 Fed. Reg. at 55 (emphasis added). One exception example is when the claim “merely includes instructions to implement an abstract idea on a computer, or merely uses a computer as a tool to perform an abstract idea.” Revised Guidance, 84 Fed. Reg. at 55. Another is an additional element that “merely recites the words ‘apply it’ (or an equivalent) with the judicial exception.” Revised Guidance, 84 Fed. Reg. at 55. A further exception to being integrated into a practical application includes where “an additional element adds insignificant extra-resolution activity to the judicial exception.” Revised Guidance, 84 Fed. Reg. at 55.

The above is the situation before us because claim 1 recites a “game system” comprising “a first game execution unit” which itself comprises “at least one processor.” This “processor” is “configured to” (a) “execute a first game;” (b) “set a first game mode of a first degree of difficulty;” (c) “determine” if the execution result “satisfies a predetermined condition;” (d)

⁷ We also note the Revised Guidance’s clarification of “methods of organizing human activity” as encompassing “managing . . . interactions between people (including social activities . . .).” Revised Guidance, 84 Fed. Reg. at 52.

generate an “output” that the “predetermined condition” has been satisfied; (e) “execute a second game;” (f) set a second game mode” “accessible in the second game;” and, (g) “set a third game mode.” *See also* Appeal Br. 19–20; Reply Br. 7–8. As indicated above, Appellant contends that “[t]hese are not mere abstract rules,” “[r]ather, these additional features include specific configurations in game execution units.” Appeal Br. 20; *see also* Reply Br. 8. However, regardless of whether such claim language is directed to “specific configurations in game execution units” or not, it is clear that such language is directed to the exceptions enumerated above. In other words, the additional elements pertain to a processor simply performing as processors are apt to do (i.e., execute programmed commands or rules), including using a processor as a tool to employ when performing the judicial exception in an electronic environment. Consequently, we conclude that in accordance with the Revised Guidance identified above, these additional elements do not integrate the judicial exception into a practical application.

STEP 2B

We next proceed to (3) above addressing whether the claim adds a specific limitation beyond the judicial exception that is “not well-understood, routine, conventional activity in the field.” Revised Guidance, 84 Fed. Reg. at 56. Or, in the alternative, we proceed to (4) above addressing whether the claim “simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.” Revised Guidance, 84 Fed. Reg. at 56. Here, the issue to be addressed surrounds the recited “processor” and whether the employment of such device in the manner recited is well-understood, routine, or conventional.

On this point, the Examiner states, “the specification makes clear that off-the-shelf computer technology is usable to carry out those rules. *See, e.g.*, paragraph 77 of Appellant’s specification wherein any information processor may be used to conduct the game, including a stationary game apparatus, a mobile phone, a smartphone, a desk top computer, a notebook computer, and the like.” Ans. 9–10. This is a correct reading of Paragraph 77 of Appellant’s Specification.

Regarding whether a limitation is well-understood, routine, or convention is a matter discussed by our reviewing court in *Berkheimer v. HP Inc.*, 890 F.3d 1369 (Fed. Cir. 2018). *See also* Appeal Br. 20; Reply Br. 9–10. In that case, it was clearly stated that “there must be evidence supporting a finding that the additional elements were well-understood, routine, and conventional.” *Berkheimer*, 890 F.3d at 1371. This court explained, however, that “[r]elying on the specification alone may be appropriate where, as in *Mayo*⁸, the specification *admits* as much.” *Berkheimer*, 890 F.3d at 1371.

Applying that same analysis here, Appellant is not persuasive in refuting the clear teaching in Paragraph 77 of Appellant’s Specification that “the present technology is not limited thereto, and any information processor (e.g., a stationary game apparatus, a mobile phone, a smartphone, a desk top computer, a notebook computer, and the like) may be used.” *See also* Ans. 9–10, 12. Consequently, we do not fault the Examiner for relying on specific provisions set forth in Appellant’s Specification, rather than relying on extrinsic evidence as to what is “**well understood, routine, and**

⁸ *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 79 (2012).

conventional as required by Berkheimer.” Reply Br. 9; *see also* Appeal Br. 20–21, Ans. 10.

In view of the above, we are not persuaded “the claim adds a specific limitation beyond the judicial exception that is not ‘well-understood, routine, conventional’ in the field.” Revised Guidance, 84 Fed. Reg. at 55.

Accordingly, based on the record presented and the above Revised Guidance, we sustain the Examiner’s rejection of claims 1 and 3–19 under 35 U.S.C. § 101.

CONCLUSION

In summary:

Claims Rejected	Basis	Affirmed	Reversed
1 and 3–19	§ 101	1 and 3–19	
Overall Outcome		1 and 3–19	

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

AFFIRMED