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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/318,353	06/27/2014	Mark E. Miller	997.03DIV1	2934
8685	7590	08/24/2020	EXAMINER	
DERGOSITS & NOAH LLP One Embarcadero Center Suite 350 SAN FRANCISCO, CA 94111			THOMAS, ERIC M	
			ART UNIT	PAPER NUMBER
			3715	
			MAIL DATE	DELIVERY MODE
			08/24/2020	PAPER

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MARK E. MILLER and JONATHON SPAETH

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Appeal 2019-002048  
Application 14/318,353  
Technology Center 3700

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Before KENNETH G. SCHOPFER, BRADLEY B. BAYAT, and  
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

BAYAT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant<sup>1</sup> appeals under 35 U.S.C. § 134(a) from the Examiner's final decision rejecting claims 1–11 and 13–17, which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b). A hearing was held on July 30, 2020.

We REVERSE.

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<sup>1</sup> We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies inventors “Mark Miller and Jonathon Spaeth” as the real parties in interest. Appeal Br. 1.

### CLAIMED SUBJECT MATTER

Appellant’s invention relates generally to virtual horse racing, and specifically, to a method “for creating a completely virtual horse racing environment, with virtual horses, a virtual racetrack, and a horse racing form generated and displayed using data on the virtual horses.” Spec. 1:13–16. Method claims 1, 5, and 11 are the only independent claims pending on appeal. Claim 1, reproduced below, is illustrative of the claimed subject matter.

1. A computer-implemented method for generating and displaying a horse racing form for use with a computer-implemented horse race simulation system comprising:
  - identifying to a processor a first group of virtual horses to run in a particular computer-implemented horse race simulation, the first group of virtual horses selected from a plurality of virtual horses created using the processor, each virtual horse having associated data stored in data storage accessible to the processor, the stored associated data including virtual attributes associated with the virtual horse including physical attributes, breeding attributes, and performance attributes including results from the processor running previous horse race simulations using a plurality of combinations of the plurality of virtual horses, the results from the previous horse race simulations including split times;
  - prior to running the particular horse race simulation, processing the stored associated data by the processor to generate for display to the user on a computer display a portion of the stored associated data for each of the first group of virtual horses as a single integrated document in a racing form format, the displayed single integrated document in racing form format including at least one data table containing at least the portion of the stored associated data about all of the virtual horses in the first group and the portion of the stored associated data organized and normalized based on the physical attributes, the breeding attributes, and the performance attributes including

split times associated with each of the virtual horses in the first group;

prior to running the particular horse race simulation, and after the generation and display of the single integrated document in racing form format to the user on the computer display, receiving by the processor a selection from the user of one virtual horse in the first group as the user's pick to win, place or show in the particular horse race simulation;

running by the processor the particular horse race simulation based at least in part on the virtual attributes of the virtual horses; and

transmitting the results of the particular horse race simulation by the processor to the computer display of the user.

Appeal Br. 33 (Claims App.).

#### REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Hisada	US 2002/0034981 A1	Mar. 21, 2002
Pacey et al. ("Pacey")	US 2004/0053686 A1	Mar. 18, 2004

#### REJECTION

Claims 1–11 and 13–17 are rejected under 35 U.S.C. § 103(a) as unpatentable over Hisada and Pacey.<sup>2</sup>

#### OPINION

We are persuaded by Appellant's argument that Hisada, on which the Examiner relies, fails to disclose a data table "*organized and normalized based on the physical attributes, the breeding attributes, and the*

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<sup>2</sup> We note that the Examiner inadvertently includes canceled claim 12 in the statement of the rejection. Final Act. 2; Ans. 3.

*performance attributes including split times associated with each of the virtual horses in the first group.”* Appeal Br. 11, 15–17; Reply Br. 5–6.

In rejecting independent claims 1, 5, and 11 as unpatentable over Hisada and Pacey, the Examiner finds that Figure 20 of Hisada shows a data table with performance attributes including split times associated with each of the virtual horses in the first group, as required by the claims.<sup>3</sup> Final Act. 3.

Alleging error in the rejection, Appellant argues that “*Hisada Does Not Teach That the Data In The Data Table Is Organized And Normalized Based on the Physical Attributes, Breeding Attributes and Performance Attributes including Split Times For All Horses In The Virtual Race.*”

Appeal Br. 15. According to Appellant, Figure 20 of Hisada only shows attribute information of one horse and there is no indication that split times are included. *Id.* (“Split times are a record of the horse’s time and position at certain intervals in the race, and are important to help a handicapper visualize previous race performance in order to determine how the horse may perform relative to other horses in a particular race with a particular race distance.”).

Responding to Appellant’s argument, the Examiner states that it is argued that Hisada does not disclose split times, time and interval position at certain intervals in the race. In other words, it is argued that the present invention provides more comprehensive data than that of the single horse view of the prior art. *The Examiner interprets this extra comprehensive data as the Appellants attempt at merely claiming and*

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<sup>3</sup> Claim 11 similarly requires “performance attributes including split times associated with all of the virtual contestants in the first group.” Appeal Br. 36 (Claims App.).

*displaying data in a consolidated, condensed format. Claiming and presenting data in a preferred format is just displaying data, it is not a novel and inventive concept.*

Answer 10 (emphasis added).

We are persuaded of Examiner error.

“A rejection based on section 103 clearly must rest on a factual basis.” *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967). The Examiner has the initial duty of supplying the factual basis for the rejection and may not resort to speculation, unfounded assumptions, or impermissible hindsight reconstruction to supply deficiencies in its factual basis. *Id.* We do not find in Figure 20 of Hisada, and the Examiner ostensibly acknowledges that Hisada’s profile screen of a “single horse” as shown in Figure 20, does not show split times associated with each virtual horse in the first group. Yet, the Examiner resorts to unfounded assumptions to supply deficiencies in its factual basis in maintaining the rejection of independent claims 1, 5, and 11. *See supra.* In Figure 2 of Appellant’s Specification, “the normalized distances and split times present a picture of how a horse runs on different tracks, different surfaces, different conditions, different distances, etc.” Reply Br. 5. According to Appellant, the claimed split times are “extremely useful for a handicapper when analyzing a field of virtual horses as it underlies a skilled analysis rather than luck. Such information can also provide an effective basis for comparison and analysis across different platforms, such as virtual race platforms hosted by different entities.” *Id.* We agree with Appellant that Hisada does not teach split times as required by the independent claims. The Examiner does not rely on Pacey to cure the deficiency in Hisada.

Therefore, we do not sustain the rejection of independent claims 1, 5, and 11 as unpatentable over Hisada and Pacey. For the same reasons, we also do not sustain the rejection of dependent claims 2–4, 6–10, and 13–17. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“dependent claims are nonobvious if the independent claims from which they depend are nonobvious”).

### CONCLUSION

The Examiner’s rejection of claims 1–11 and 13–17 under 35 U.S.C. § 103(a) is reversed.

### DECISION SUMMARY

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>References</b>	<b>Affirmed</b>	<b>Reversed</b>
1–11, 13–17	103(a)	Hisada, Pacey		1–11, 13–17

REVERSED