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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SIMON BUTLER, ALEX BURSTEIN, and NICK GREEN

Appeal 2019-002761
Application 14/733,407
Technology Center 3700

Before CHARLES N. GREENHUT, MICHAEL L. HOELTER, and
BRETT C. MARTIN, *Administrative Patent Judges*.

HOELTER, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

Appellant¹ filed a Request for Rehearing (“Req. Reh’g”) dated February 6, 2020, of the Decision on Appeal mailed December 6, 2019 (“Decision”). This Decision affirmed the Examiner’s rejection of claims 1, 3–7, 11, 13, 14, and 16–21 (all the claims on appeal) under 35 U.S.C. § 101 because we agreed with the Examiner that the claimed invention was “directed to non-statutory subject matter.” Final Act. 2; *see also* Decision 5–10. The Decision also reversed the rejections of these same claims under 35 U.S.C. § 102(a)(1) and 35 U.S.C. § 103. *See* Decision 10–12. Thus, “Appellant’s Rehearing request is directed solely to the Section 101 rejection of Appellant’s claims (independent as well as dependent).” Req. Reh’g 3.

Upon consideration of Appellant’s Request, we do not modify our opinion.

A REQUEST FOR REHEARING

A request for rehearing “must state with particularity the points believed to have been misapprehended or overlooked by the [Patent Trial and Appeal Board, hereinafter “Board”].” *See* 37 C.F.R. § 41.52(a)(1). This section also states that arguments not raised in the briefs before the Board and evidence not previously relied upon in the briefs “are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) through (a)(4) of this section.” In addition, a request for rehearing is not an opportunity to express disagreement with a decision without setting forth

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 “Abacus Solutions International IP B.V.” Appeal Br. 1.

points believed to have been misapprehended or overlooked by the Board in rendering its Decision. The proper course for an Appellant dissatisfied with a Board decision is to seek judicial review, not to file a request for rehearing to reargue issues that have already been decided. *See* 35 U.S.C. §§ 141, 145.

ANALYSIS

The first matter we interpret from Appellant’s Request as allegedly being misapprehended or overlooked by the Board is Appellant’s assertion that “[t]he current rejections under Section 101/Alice are based upon comparisons to claims that are directed to games that are nothing at all like Appellant’s claims.” Req. Reh’g 1. To be clear, Appellant’s claim 1 (the claim selected for review, *see* Decision 5) recites, in the preamble, “an electronic gaming arrangement operatively connectable to a random number generator.” Appellant’s Specification provides additional guidance that the recited gaming arrangement refers to “a system and parts thereof that are arranged for providing a different type of lottery game.” Spec. 1:18–19. Thus, as understood, Appellant’s contention above is that their lottery game differs from “*Smith*’s² ‘playing cards’ or *Guldenaar*’s³ ‘dice,” which were addressed in the Decision. Decision 6 (the Decision also addressed *Planet Bingo*’s⁴ “game of Bingo,” (Decision 6–7)). Indeed, Appellant is correct that *Smith*, *Guldenaar*, and even *Planet Bingo* each pertain to a game different from Appellant’s, but the reference to these earlier cases “does not alter or invalidate the Examiner’s analogy” of their use to find that Appellant’s claim pertains to non-statutory subject matter. Decision 6. We

² *In re Smith*, 815 F.3d 816 (Fed. Cir. 2016).

³ *In re Guldenaar*, 911 F.3d 1157 (Fed. Cir. 2018).

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

do not change our agreement with the Examiner that *Smith* (and *Guldenaar*'s description thereof), as well as the games described therein, are a proper analogy to Appellant's lottery game, and thus could be properly relied upon for the guidance they contain. *See* Non-Final Act. 3–4, Decision 6–7. Accordingly, Appellant's above contention regarding a difference in the games being addressed is not persuasive that the Board misapprehended or overlooked this distinction when rendering its Decision.

Appellant next asserts, “*none of the examples of unpatentable games provides a technological improvement/enhancement over the existing art.*” Req. Reh'g 1; *see also id.* at Req. Reh'g 3–7. Fortunately, our reviewing court has provided guidance as to the scope of a “technological improvement” in the realm of a Section 101 analysis. For example, *Finjan, Inc. v. Blue Coat Systems, Inc.*, 879 F.3d 1299 (Fed. Cir. 2018) references an earlier holding (i.e., *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016)) stating:

In *Enfish*, for instance, the court determined that 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 itself, not on economic or other tasks for which a computer is used in its ordinary capacity.” *Id.* at 1336.

Finjan, 879 F.3d at 1304–5. Hence, our reviewing court distinguishes between improvements that affect the “computer functionality itself” with “economic or other tasks for which a computer is used in its ordinary capacity.”

In the matter before us, Appellant contends that the “claimed invention is directed to a technological improvement to (a practical

application of) known ‘rules for playing a wagering game.’”⁵ Req. Reh’g 4. Appellant does not explain how “rules for playing a wagering game” can be properly equated to “computer functionality itself,” and are not, instead, more properly directed to “economic or other tasks for which a computer is used.” *Finjan*, 879 F.3d at 1305. In other words, Appellant’s attempt to characterize claim 1 in terms of providing “a technological improvement” is not persuasive in view of the guidance our reviewing court has supplied on that point.

Appellant also “notes that, while not new, the evidentiary record does not support a conclusion that a ‘random value generator’ is a conventional and ordinary component -- at least in the context of a general purpose computer.” Req. Reh’g 6. The Decision addressed this matter of whether or not the recited “random number generator” is an additional element that integrates the judicial exception into a practical application. *See* Decision 7–8. The Decision referenced Appellant’s Specification where a description of “random number generator server 150” was provided. Decision 7 (referencing Spec. 4:12–5:30). Such passage addresses this generator in the following terms, “random number generator server 150 comprises a number generator communication module 152 for communicating with the server communication module” and “[t]he random number generator 150 further

⁵ Appellant further alleges, “Appellant’s claimed invention defines a practical application of gaming rules that enables a single user input terminal to support a virtually unlimited range of user-specified prize amounts” and also, “[f]rom a technology prospective, Appellant’s claimed invention provides a more efficient way (i.e. reducing a need for several distinct gaming terminal interfaces to support a wide variety/range of winning amounts) of presenting an odds-based payout gaming arrangement that supports a wide range of payout amounts.” Req. Reh’g 5.

comprises a random number microprocessor 154 as a randomizer module for providing a random number.” Spec. 5:17–22. Based on this, the Board, in its Decision, stated,

these additional elements are employed as generic tools merely to perform the above steps. Thus, the claims do not apply, rely on, or use these additionally recited elements in a manner that imposes a meaningful limit on those steps.

Decision 7. Appellant is not persuasive of any error in this analysis, or that such topic was misapprehended or overlooked by the Board in rendering its Decision.

CONCLUSION

Appellant’s request for rehearing has been granted to the extent that the board reconsidered its decision in light of the statements made in this request, but is denied with respect to the board making any modification to the decision.

TIME PERIOD FOR RESPONSE

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

DENIED