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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/330,545	10/06/2016	GUY L. MCCLUNG III	McWord	5761

7590 11/21/2019  
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EXAMINER
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MENDIRATTA, VISHU K

ART UNIT	PAPER NUMBER
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3711

MAIL DATE	DELIVERY MODE
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11/21/2019

PAPER

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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* GUY L. McCLUNG, III

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Appeal 2019-003596  
Application 15/330,545  
Technology Center 3700

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Before JAMESON LEE, JONI Y CHANG, and  
MICHAEL R. ZECHER, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the Examiner's decision to reject claims 1–18. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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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. Appellant identifies the real party in interest as Guy L. McClung, III. Appeal Br. 3.

### CLAIMED SUBJECT MATTER

The independent claims are claims 1 and 14. Both recite a method for playing a word game. Claims 2–13 each depend directly from claim 1, and claims 15–18 each depend from claim 14. Claims 1 and 14 are reproduced below:

1. A method for playing a word game, the word game playable by a plurality of players, the plurality of players comprising at least a first player and a second player, the word game comprising a game piece location structure, the game piece location structure having multiple game piece locations, the multiple game piece locations including a first plurality of first game piece locations each with a location designator indicating the first player and a second plurality of game piece locations each with a location designator indicating the second player, each location designator either preprinted on the game piece location structure or created on the game piece location structure before the game commences, the word game further comprising a plurality of lettered game pieces each placeable on a game piece location of the game piece location structure and positionable adjacent each other to form words produced by the players, a first group of the plurality of lettered game pieces having indicia thereon indicating the first player and a second group of the plurality of lettered game pieces having indicia thereon indicating the second player, the method comprising:

the players receiving joint scores of game points for producing a word;

the first player producing a first word, the first player producing the first word using at least one lettered game piece, the first player producing the first word by placing the at least one lettered game piece on a game piece location of the game piece location structure and positioning the at least one lettered game piece to spell out the first word, the first word produced by the first player alone in a first turn,

the first player receiving a first point score of game points for production of the first word,

the second player taking no action in the game during the first player's production of the first word during the first turn, and

the second player receiving a second point score of game points based on the first word if the at least one lettered piece used to produce the first word is from the second group indicating the second player.

14. A method for playing a word game, the word game playable by a plurality of players, the plurality of players comprising at least a first player and a second player, the word game comprising the word game comprising a game piece location structure, the game piece location structure comprising a board having multiple game piece locations, the multiple game piece locations including a first plurality of first game piece locations each with a location designator indicating the first player and a second plurality of game piece locations each with a location designator indicating the second player, each location designator either preprinted on the game piece location structure or created on the game piece location structure before the game commences, the word game further comprising a plurality of lettered game pieces each placeable on a game piece location of the game piece location structure and positionable adjacent each other to form words produced by the player, a first group of the plurality of lettered game pieces having indicia thereon indicating the first player and a second group of the plurality of lettered game pieces having indicia thereon indicating the second player, the method comprising:

the first player producing a first word, the first player producing the first word using at least one lettered game piece, the first player producing the first word by positioning the at least one lettered game piece to spell out the first word, the first word produced by the first player alone in a first turn,

the first player receiving a first point score of game points for production of the first word,

the second player taking no action in the game during the first player's production of the first word during the first turn,

the second player receiving a second point score of game points based on the first word if the at least one lettered piece used to produce the first word is from the second group indicating the second player,

the second player receiving an additional point score of game points if the first word includes any lettered game piece positioned on a game piece location with a location designator indicating the second player,

wherein the second point score is determined by chance.

The Specification states the following: “The present invention discloses, inter alia, word games in which an acting player achieves a word score and then one (or more than one) non-acting player(s) can achieve a score based on the acting player’s action and/or score.” Spec. ¶ 3. The Specification explains as follows: (1) “No word game known to the present inventor makes provision for the new and nonobvious possibility of a non-acting player receiving a score based on the action of an acting player”; and (2) “No word game known to the present inventor provides the new and nonobvious possibility for a non-acting player to receive a score based, in whole or in part, on chance.” *Id.* ¶ 5.

The Specification summarizes the invention as follows:

The present invention discloses, in certain aspects, games in which before an acting player receives a word score (e.g., for producing a word, making a word, finding a word), a determination is made regarding who, if any, of the other player(s) (and, in one aspect, the acting player himself or herself) will either receive an additional score or have the chance to receive an additional score. Such a determination may be made by chance or according to pre-set rules or agreement, a specific player is designated; e.g., if there are only two players, then it is the other player or, e.g., it is always a player to the right or to the left of an acting player, or it is all non-acting players; also e.g., if there are two players, tokens or game pieces (e.g., cards) are dealt

or chosen or distributed, and some indicator indicates which player will be able to receive an additional score or have the chance to receive an additional score.

*Id.* ¶ 6.

## REJECTION

Claims 1–18 stand finally rejected under 35 U.S.C. § 101 as not directed to patent-eligible subject matter. Final Act. 2–4.

## OPINION

### A. Rejection Under § 101 for Patent-Ineligible Subject Matter

Appellant appeals the final rejection of claims 1–18 as being directed to patent-ineligible subject matter under § 101. Appeal Br. 3, 8. Independent claims 1 and 14 are argued as a group. *See id* at 9–10. We, therefore, select claim 1 as representative of claims 1 and 14. *See* 37 C.F.R. § 41.37(c)(1)(iv).

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 held that § 101 includes implicit exceptions—laws of nature, natural phenomena, and abstract ideas—which are not patent-eligible. *See Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014); *Bilski v. Kappos*, 561 U.S. 593, 601 (2010). In January 2019, the Office issued the 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (“2019 Guidance”), which addresses the manner in which § 101 case law is to be applied by the

Office.<sup>2</sup> The Board is required to adhere to the 2019 Guidance as a matter of Office policy. 2019 Guidance 51. The 2019 Guidance sets forth a four-part analysis for determining whether a claim is eligible subject matter under § 101. The four parts are referred to as Step 1, Step 2A Prong 1, Step 2A Prong 2, and Step 2B. *See id.* at 53–56.

1. *2019 Guidance Step 1*

First, under “Step 1,” we consider whether the claimed subject matter falls within the four statutory categories set forth in § 101, namely “[p]rocess, machine, manufacture, or composition of matter.” 2019 Guidance 53–54; *see* 35 U.S.C. § 101. Claim 1 recites a “method” and, thus, falls within the “process” category. Consequently, we proceed to the next step of the analysis.

2. *2019 Guidance Step 2A Prong 1*

Second, under “Step 2A Prong 1,” we evaluate “whether the claim recites a judicial exception, i.e., an abstract idea, a law of nature, or a natural phenomenon.” 2019 Guidance 54; *see Alice*, 573 U.S. at 216 (2014);<sup>3</sup> *Bilski*, 561 U.S. at 601–602.<sup>4</sup> The Examiner determined that the rejected claims recite an abstract idea, because steps of “organizing human activity” are treated as abstract ideas. Final Act. 2. In support of that conclusion, the Examiner determined that the claims include steps of assigning and

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<sup>2</sup> A further update was issued in October 2019. October 2019 Patent Eligibility Guidance Update, 84 Fed. Reg. 55942 (October 18, 2019).

<sup>3</sup> In *Alice*, a method of exchanging financial obligations between two parties using a third-party intermediary to mitigate settlement risk is deemed an abstract idea. *Alice*, 573 U.S. at 219.

<sup>4</sup> In *Bilski*, a method of hedging or protecting against risk is deemed an abstract idea. *Bilski*, 561 U.S. at 611.

positioning lettered game pieces, making words and receiving points, and following a set of rules for playing a game. *Id.* at 2–3. The Examiner further explained as follows, citing *Alice*:

In the present application “steps of assigning, positioning letter pieces, making words and receiving points” is effectively a method of exchanging and resolving financial obligations based on rules of playing. Thus, the claim of the present application as recited, is akin to the “method of exchanging financial obligations” discussed in *Alice*.

*Id.*

For reasons discussed below, we agree with the Examiner that claim 1 recites an abstract idea.

The 2019 Guidance identifies the following as a sub-group of abstract ideas: “Certain methods of organizing human activity—fundamental economic principles or practices (including hedging, insurance, mitigating risk); commercial or legal interactions (including agreements in the form of contracts; legal obligations; advertising, marketing or sales activities or behaviors; business relations); managing personal behavior or relationships or interactions between people (*including social activities, teaching, and following rules or instructions*).” 2019 Guidance 52 (emphasis added).<sup>5</sup>

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<sup>5</sup> The 2019 Guidance identifies another subgroup of “abstract ideas,” i.e., mental processes—concepts performed in the human mind. 2019 Guidance 52. In addition to concluding that claims 1 recites “steps of organizing human activity, the Examiner also concludes that claim 1 recites a mental process. Ans. 6. We need not decide whether the claims also recite a mental process, because, as discussed below, we agree with the Examiner that the claims recite an abstract idea within the grouping of “Certain methods of organizing human activity.” *Id.* The same is true for claims 2–18.

Claim 1 is similar to the claims held to recite an abstract idea in *In re Marco Guldenaar Holding B.V.*, 911 F.3d 1157, 1160 (Fed. Cir. 2018) and *In re Smith*, 815 F.3d 816, 818–819 (Fed. Cir. 2016). The claims in *Marco* recite a method of playing a dice game including placing wagers on whether certain die faces will appear face up. *Marco*, 911 F.3d at 1160. The claims in *Smith* recite a method of conducting a card game, with wagering. *Smith*, 815 F.3d at 817–818. In *Smith*, the Federal Circuit likened the recited method for a wagering card game to a fundamental economic practice and agreed with the Board that the claimed method effectively is a method of exchanging and resolving financial obligations based on probabilities created during distribution of the cards. *Id.* at 818–819. On that basis, the Court determined that claimed invention was an abstract idea much like *Alice*'s method of exchanging financial obligations and *Bilski*'s method of hedging risk. *Id.* at 819. Likewise, in *Marco*, the Court determined that the claimed method was like that in *Smith*, except that the probabilities are based on dice rather than on cards. *Marco*, 911 F.3d at 1160. The claimed method of playing a dice game was determined to be an abstract idea. *Id.*

First, the Examiner determined that claim 1 includes the requirement of following a set of rules for playing a game. Final Act. 3. We agree. Appellant has not disputed that claim 1 includes such a requirement. The rules are these individual steps recited in claim 1, which are all of the steps recited in claim 1:

the players receiving joint scores of game points for producing a word;

the first player producing a first word, the first player producing the first word using at least one lettered game piece, the first player producing the first word by placing the at least one lettered game piece on a game piece location of the game

piece location structure and positioning the at least one lettered game piece to spell out the first word, the first word produced by the first player alone in a first turn,

the first player receiving a first point score of game points for production of the first word,

the second player taking no action in the game during the first player's production of the first word during the first turn, and

the second player receiving a second point score of game points based on the first word if the at least one lettered piece used to produce the first word is from the second group indicating the second player.

The U.S. Court of Appeals for the Federal Circuit has determined that a set of rules for a game constitutes an abstract idea. *Marco*, 911 F.3d at 1161; *Smith*, 815 F.3d at 819. For this reason alone, claim 1 recites an abstract idea.

For a separate reason, we conclude that claim 1 recites an abstract idea. Although it is true that the method of playing a wagering game in *Marco* (using dice) and in *Smith* (using playing cards) requires wagering and, thus, is likened to a way to resolve financial obligations between parties, and that the method of playing the game here according to claim 1 requires no wagering, that difference does not make the idea here any less abstract. Claim 1 recites that the players would receive "points" based on the specified rules. Thus, the game potentially can be played for money, based on points awarded to each player. The game can be played for money, or not. The claim is sufficiently broad to cover both. If a game, played for money, is an abstract idea, it would be even more of an abstract idea if played simply for fun without a financial consequence. Given that the methods for playing wagering games in *Marco* and in *Smith* constitute an

abstract idea, the method here according to claim 1 also constitutes an abstract idea.

Finally, Appellant also argues that a “specific apparatus is required for the implementation of the game.” Appeal Br. 11. The argument is misplaced. A similar argument was raised in *Marco, supra*, and the Federal Circuit explained as follows:

We disagree [that physical parts nullifies the abstract idea determination], because the abstract idea exception does not turn solely on whether the claimed invention comprises physical versus mental steps. The claimed methods in *Bilski* and *Alice* also recited actions that occurred in the physical world. See *Bilski*, 561 U.S. at 599, 130 S.Ct. 3218; *Alice*, 573 U.S. at 213–14, 134 S.Ct. 2347. The same is true of the claimed method of conducting a wagering game in *Smith*. *Smith*, 815 F.3d at 817. *Marco*, 911 F.3d at 1161–1162.

Because claim 14 is grouped with claim 1, it also recites an abstract idea. Because each of claims 2–13 and 15–18 depends from either claim 1 or claim 14, and they incorporate all the recitations of claim 1 or claim 14, they also recite the same abstract idea discussed and identified above.

### 3. 2019 Guidance Step 2A Prong 2

Having determined that claim 1 recites an abstract idea, we proceed to “Step 2A Prong 2” of the 2019 Guidance, which requires that we evaluate whether “the claim as a whole integrates the recited judicial exception into a practical application of the exception.” 2019 Guidance 54. “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.” *Id.*; *see also Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 78 (2012).

The 2019 Guidance specifies that this evaluation is conducted by first “[i]dentifying whether there are any additional elements recited in the claim beyond the judicial exception(s),” then “evaluating those additional elements individually and in combination to determine whether they integrate the exception into a practical application.” 2019 Guidance 54–55.

The Examiner identified all of the other elements recited in claim 1, i.e., (1) a game piece location structure having multiple game piece locations, where the game piece locations including a first plurality of first game piece locations each with a location designator indicating the first player and a second plurality of game piece locations each with a location designator indicating the second player, (2) each location designator either preprinted on the game piece location structure or created on the game piece location structure before the game commences, (3) a plurality of lettered game pieces each placeable on a game piece location of the game piece location structure and positionable adjacent each other to form words, and (4) a first group of the plurality of lettered game pieces having indicia thereon indicating the first player and a second group of the plurality of lettered game pieces having indicia thereon indicating the second player. Ans. 6–7.

The Examiner determined that these additional elements do not integrate the abstract idea into a practical application. *Id.* at 7. The Examiner finds claim 1 simply to be applying the abstract idea to a general technological environment or field of use. *Id.* We agree with the Examiner

that no additional element or combination of additional elements integrate the abstract idea into a practical application of the abstract idea.

The 2019 Guidance lists several non-exhaustive exemplary considerations tending to indicate that a judicial exception such as an abstract idea has been integrated into a practical application:

An additional element reflects an improvement in the functioning of a computer, or an improvement to other technology or technical field;

an additional element that applies or uses a judicial exception to effect a particular treatment or prophylaxis for a disease or medical condition;

an additional element implements a judicial exception with, or uses a judicial exception in conjunction with, a particular machine or manufacture that is integral to the claim;

an additional element effects a transformation or reduction of a particular article to a different state or thing; and

an additional element applies or uses the judicial exception in some other meaningful way beyond generally linking the use of the judicial exception to a particular technological environment, such that the claim as a whole is more than a drafting effort designed to monopolize the exception.

2019 Guidance (Footnotes omitted).

None of these exemplary considerations fit the facts of this case, and we have no other reason to support a conclusion that any additional element or combination of elements in claim 1 integrates the abstract idea into a practical application. In particular, the additional elements, alone or in combination, do not improve the functioning of a computer or any technology, do not effect a particular treatment or prophylaxis for a disease or medical condition, do not implement the abstract idea with a particular machine or manufacture, do not effect a transformation or reduction of a

particular article to a different state or thing, and do not apply the abstract idea in a meaningful way beyond linking it to a particular technological environment. Although the additional elements are physical, i.e., game piece location structure, lettered game pieces having indicia thereon, and location designator on game piece locations, they are recited as generic elements and, as such, do not set forth a particular machine or manufacture. We, therefore, are not persuaded by Appellant's assertion (Appeal Br. 9) that the claims "require specific and particular apparatus," with respect to claim 1.

For the foregoing reasons, we determine that no additional element or combination of elements in claim 1 integrates the abstract idea into a practical application. Claim 14 is separately argued by Appellant, but only to the extent that it adds an additional rule to the set of rules set forth in claim 1, i.e., "the second player receiving an additional point score of game points if the first word includes any lettered game piece positioned on a game piece location with a location designator indicating the second player." Appeal Br. 10. This additional rule does not add an element or combination of elements satisfying any of the above-reproduced considerations for Step 2A, Prong 2 of the 2019 Guidance. Therefore, we likewise are not persuaded by Appellant's assertion (Appeal Br. 9) that the claims "require specific and particular apparatus," with respect to claim 14. Consequently, no additional element or combination of elements in claim 14 integrates the abstract idea into a practical application.

Appellant has not separately argued the merits of dependent claims 4, 5, 7, 10, 11, and 18.<sup>6</sup> Consequently, they are grouped with claims 1 and 14. *See* 37 C.F.R. § 41.37(c)(1)(iv). No additional element or combination of elements in any of claims 4, 5, 7, 10, 11, and 15 integrates the abstract idea into a practical application.

Claim 2 depends from claim 1 and further recites “further comprising the second player receiving an additional point score of game points if the first word includes any lettered game piece positioned on a game piece location with a location designator indicating the second player.” This claim adds a rule to the set of rules set forth in claim 1, but does not add an element or combination of elements satisfying any of the above-reproduced considerations for Step 2A, Prong 2 of the 2019 Guidance. Therefore, we likewise are not persuaded by Appellant’s assertion (Appeal Br. 9) that the claims “require specific and particular apparatus,” with respect to claim 2. We find nothing in claim 2 to establish integration of the abstract idea into a practical application.

Claim 3 depends from claim 1 and further recites “wherein the game piece location structure is a board with multiple locations on which a game piece is placeable, the method further comprising the players forming words by placing lettered game pieces on at least one location of the board.” The additional element here is a generic game board. It is insufficiently specific to constitute a particular

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<sup>6</sup> On page 11 of the Appeal Brief, Appellant refers to claim 18 as requiring that the game be effected electronically. Claim 18 includes no such recitation. Rather, claim 15 does. We assume Appellant’s argument is directed to claim 15 and not claim 18.

machine or manufacture under the 2019 Guidance. Also, we agree with the Examiner (Ans. 7) that the recitation of a generic game board merely reflects application of the game rules to a particular technological environment or field of use, i.e., “the art area of board games.” As such, the element is insufficient under the 2019 Guidance to establish integration of the abstract idea into a practical application.

Claim 6 depends from claim 1 and further recites “wherein the lettered game pieces are one of die, tile, card, and electronic game piece.” This recitation is generic and not sufficiently specific under the 2019 Guidance to constitute a particular machine or manufacture. We also have considered other factors noted above for prong 2 of Step 2A, and we find nothing in claim 6 to establish integration of the abstract idea into a practical application.

Claim 8 depends from claim 1 and further recites “wherein the method is effected electronically.” This recitation merely reflects application of the game rules to a particular technological environment or field of use, i.e., electronically. As such, claim 8 has no additional element or combination of elements sufficient under the 2019 Guidance to establish integration of the abstract idea into a practical application.

Claim 9 depends from claim 1 and further recites “wherein the method is effected over the Internet.” This recitation merely reflects application of the game rules to a particular technological environment or field of use, i.e., over the Internet. As such, claim 9 has no additional element or combination of elements sufficient under the 2019 Guidance to establish integration of the abstract idea into a practical application.

Claim 12 depends from claim 1 and further recites as follows:

wherein the at least one lettered game piece is from the second group, and the method further comprising

determining a game point value for the second point score by using a die or dice by one of the following:

a die is rolled and shows a die face with a numeral thereon and the value of the numeral is the second point score;

a die is rolled and shows a die face with a numeral thereon and the value of the second point score is the first point score times the numeral value of the numeral;

two dice are rolled and a face of each die shows on a die face a numeral and the combined value of the two numerals is the second point score; and

two dice are rolled and each shows a die face with a numeral thereon and the second point score is the first point score times the combined numeral value of the two numerals.

The additional element here is one generic die or two generic dice. In either case, the recitation is not sufficiently specific to constitute a particular machine or manufacture under the 2019 Guidance. *Cf. Marco*, 911 F.3d at 1161–1162 (determining that a claimed method for playing a dice game involving the use of a first die, second die, and third die is not patent-eligible). We also have considered other factors noted above for prong 2 of Step 2A, and we find nothing in claim 12 to establish integration of the abstract idea into a practical application.

Claim 13 depends from claim 1 and further recites “wherein the game is an improved version of an existing word game, the existing word game being one of SCRABBLE (Trademark) game and BOGGLE (Trademark) game.” This claim is sufficiently broad so as to require only the adoption of certain rules of the pre-existing games and not any particular game piece structure or game piece location structure from the pre-existing games.

Therefore, nothing added by claim 13 is sufficiently specific to constitute a particular machine or manufacture under the 2019 Guidance. We also have considered other factors noted above for prong 2 of Step 2A, and we find nothing in claim 13 to establish integration of the abstract idea into a practical application.

Claim 15 depends from claim 14 and further recites “wherein the method is effected electronically or over the Internet.” For the same reasons discussed above in the context of claims 8 and 9, claim 15 has no additional element or combination of elements sufficient under the 2019 Guidance to establish integration of the abstract idea into a practical application.

Claim 16 depends from claim 14 and further recites “wherein the game piece location structure is a container with multiple compartments for holding a game piece, the method further comprising the players forming words by placing lettered game pieces in at least one compartment of the container.” The recited container with multiple compartments is not sufficiently specific, in the context of the 2019 Guidance, to constitute a particular machine or manufacture. It is generic and does not have expressed details. We also have considered other factors noted above for prong 2 of Step 2A, and we find nothing in claim 16 to establish integration of the abstract idea into a practical application.

Claim 17 depends from claim 14 and further recites “wherein the game piece location structure is a board with multiple locations on which a game piece is placeable, the method further comprising the players forming words by placing lettered game pieces on at least one location of the board.” For the same reasons discussed above in the context of claim 3, we find nothing in claim 17 to establish integration of the abstract idea into a practical application.

For the above reasons, Appellant has not shown that the Examiner erred in concluding that claims 1–18 do not integrate the recited abstract idea into a practical application.

4. *2019 Guidance Step 2B*

We now review claims 1–18, each of which recites an abstract idea that has not been integrated into a practical application, to determine whether any claim element, alone or in combination with others, provides an “inventive concept,” i.e., whether the additional elements beyond the abstract idea, individually and in combination, amount to “significantly more” than the abstract idea itself to make the claimed invention patent-eligible. 2019 Guidance 56; *see Alice*, 573 U.S. at 217–218. According to the 2019 Guidance, “[adding] a specific limitation or combination of limitations that are not well-understood, routine, conventional activity in the field” may indicate an inventive concept is present. *Id.* Conversely, “simply append[ing] well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality,” typically indicates an inventive concept is absent. *Id.*

The claim elements beyond the abstract idea itself already have been discussed above in the context of determining whether the abstract idea is integrated into a practical application. We now consider the same in the context of determining whether an “inventive concept,” i.e., something significantly more than the abstract idea itself, is provided in any claim.

The Examiner identified all of the other elements recited in claim 1, i.e., (1) a game piece location structure having multiple game piece locations, where the game piece locations including a first plurality of first game piece locations each with a location designator indicating the first

player and a second plurality of game piece locations each with a location designator indicating the second player, (2) each location designator either preprinted on the game piece location structure or created on the game piece location structure before the game commences, (3) a plurality of lettered game pieces each placeable on a game piece location of the game piece location structure and positionable adjacent each other to form words, and (4) a first group of the plurality of lettered game pieces having indicia thereon indicating the first player and a second group of the plurality of lettered game pieces having indicia thereon indicating the second player.  
Ans. 6–7.

The Examiner determined that in the art of the claimed invention, “game surfaces and game pieces are well known to include location designations for ownership of the game surface and game pieces.” Ans. 9–10. The Examiner determined that the additional elements are all well-understood, routine, and conventional. *Id.* at 8. We understand the Examiner to have made the same determination regarding the combination of game pieces on game surfaces, because the Examiner stated the following: “Viewed as a whole the additional items game pieces, game surface 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.* at 8–9.

With regard to the claimed game pieces being “lettered,” the requirement covers printed lettering on the game pieces. The Examiner correctly determined that content of printed matter, if not functionally related to the substrate on which printed matter appears, cannot serve as a basis for patentable distinction, citing *In re Gulack*, 703 F.2d 1381, 1385

(Fed. Cir. 1983). Ans. 8. Here, printed lettering would be mere information not functionally related to the structural game piece. *See Marco*, 911 F.3d at 1161 (“the printed indicia on each die are not functionally related to the substrate of the dice.”). Additionally, the Specification expressly acknowledges multiple pre-existing word games having lettered game pieces. Spec. ¶¶ 147–150, 180–183; Figs. 11A, 11C. On this record, “lettered” game pieces are well-known and conventional.

Although the Examiner cites no extrinsic evidence to support the conclusion that in the art of the claimed invention, “game surfaces and game pieces are well known to include location designations for ownership of the game surface and game pieces” (Ans. 9–10), that determination is fully supported by the intrinsic evidence, i.e., the Specification, and Appellant has not shown that finding to be erroneous.

The Specification, in numerous places, describes the invention as differing from the prior art in the specific rules for playing the word game—not as providing a novel or unconventional game board or game piece support structure, or game piece. We reproduce several examples below:

No word game known to the present inventor makes provision for the new and nonobvious possibility of a non-acting player receiving a score based on the action of an acting player. No word game known to the present inventor provides the new and nonobvious possibility for a non-acting player to receive a score based, in whole or in part, on chance.

Spec. ¶ 5.

The present invention is directed to word games with enhanced player participation in which all players have a possibility of scoring no matter who is in the process of producing a word; and even players with a limited vocabulary can win the game.

*Id.* ¶ 17.

In one particular aspect [of applying the invention], in an improved SCRABBLE (trademark) game, upon an acting player completing a turn [and] receiving a score for making a word, a non-acting player (chosen or designated; e.g., in any way described above) rolls two dice and, if the sum of the numerals on the up face is not 7, the non-acting player received half the word score previously achieved by the acting player, and, if the sum is 7 (or 7 or 11), the non-acting player receives the same score, the word score, which the acting player received. In another respect, the chosen or designated non-acting player receives a percentage of the acting player's word score, determined in any chosen way, e.g., as described above.

*Id.* ¶ 14.

In one particular aspect [of applying the invention], in an improved BOGGLE (trademark) game, upon an acting player completing adding up a total score for that turn of the game, and receiving the totaled score for finding words, a non-acting player (chosen or designated; e.g., in any way described above) rolls two dice and, if the sum of the numerals on the up faces is not 7, the non-acting player received half the totaled score previously achieved by the acting player, and, if the sum is 7 (or 7 or 11), the non-acting player receives the same totaled score which the acting player received. In another respect, the chosen or designated non-acting player receives a percentage of the acting player's totaled score, determined in any chosen way, e.g., as described above.

*Id.* ¶ 15.

In contrast, we find no description in the Specification indicating that the Appellant has invented a novel or nonobvious game piece and/or game piece support structure. We find the Examiner's determination that "game surfaces and game pieces are well known to include location designations for ownership of the game surface and game pieces" (Ans. 9–10) to be

supported by the Specification, notwithstanding Appellant's argument which we discuss below.

Appellant has not shown that finding, supported by the record, to be erroneous. Although Appellant asserts that the claimed method "requires for its implementation specific, new game apparatus, inter alia, a unique game piece location structure in combination with lettered game pieces,"

Appellant does not state with any meaningful degree of specificity what is that unique apparatus. Appeal Br. 7. We already discussed above in the context of prong 2 of Step 2A that the recited additional elements in claim 1 are generic. Appellant further argues the following:

The claim limitations requiring specific "location designators" for each player are, e.g., designators "pre-printed on the board" or they are "created before play commences with suitable indicators;" for example, but not limited to: different designators in the compartments of the game location structure of the apparatus of the game 60, shown in Fig[.] 6 and described in Application Paragraphs [0124] – [0126]; and "transparent indicators each of which covers a game board letter tile location" (Application Specification, Paragraph [0186]). Game location designators may, e.g., be in a pre-established position (Paragraph [0186]); placed by the players (Paragraph [0188]); or placed during the game (Paragraph [0190]).

*Id.* at 9–10. Location designators that are either pre-printed on the board or created before play commences are still generic and not unique. Even when referencing, in the above-quoted text, "different designators in the compartments of the game location structure of the apparatus of the game 60, shown in Fig. 6 and described in Application Paragraphs [0124] – [0126]," Appellant describes the reference as merely an example and not a limitation of the claims. Indeed, Appellant does not point out what specific location designator is required by the claims, and we can see none. For

instance, no claim requires a transparent indicator as a location designator. Furthermore, the claimed location designator covers a printed insignia, but as we have explained above, printed matter that merely constitutes information and is not functionally related to the underlying structure cannot serve as basis for patentable distinction. *See Marco*, 911 F.3d at 1161.

Appellant further asserts that “the required game apparatus are new and nonobvious, as established by the record in this application.” *Id.* at 7. The assertion is unpersuasive, as we explain below.

According to Appellant, during prosecution of the parent application (U.S. Patent Application No. 13/694,275 (“the ’275 application”), claims were initially rejected as unpatentable over prior art, but then the Appellant successfully responded to that prior art rejection by providing “points of differences” relative to the applied prior art. Appeal Br. 12 (citing response dated March 11, 2014 in the parent application). Appellant further notes that in this ensuing “offspring application,” there is no rejection by the Examiner based on prior art. *Id.*

These arguments are misplaced and are insufficient to rebut the Examiner’s determination, supported by the record, that “game surfaces and game pieces are well known to include location designations for ownership of the game surface and game pieces.” Ans. 9–10. We have reviewed the Applicant’s response dated March 11, 2014, in the ’275 application. We find only arguments by Applicant that distinguish the claimed invention from the applied prior art on the basis of the rules for playing the game, and not on the basis of differences in the structure or configuration of the game surface or game pieces.

Notably, Applicant argued in that response: “The Hyra reference . . . teaches only a second player completing a word begun by a first player. This reference has no teaching or suggestion of a second player who does nothing during a first player's turn receiving a point score based on what the first player alone does in producing a word.” ’275 Application, Response dated March 11, 2014 at 8. The Applicant further argued the following: “The Johnson II reference . . . teaches, inter alia, players acquiring ‘territory’ of other players, the territory made by making words. This reference has no teaching or suggestion of a second player who does nothing during a first player's turn receiving a point score based on what the first player alone does in producing a word.” *Id.*

Also, the lack of a prior art rejection by the Examiner in the application on appeal does not indicate novelty or non-obviousness of the claimed game surface and/or game pieces. None of the claims on appeal covers only the game surface and/or game pieces, without the rules for playing the game. As discussed above, the Specification indicates that novelty lies in the rules for playing a game and not in the structure or configuration of a game surface and/or game pieces.

Thus, for the reasons explained above, we agree with the Examiner (Ans. 8–9) that claim 1 does not recite an element or a combination of elements constituting an “inventive concept,” i.e., something significantly more than the abstract idea itself, sufficient to render claim 1 patent-eligible.

Claim 14 is separately argued by Appellant, but only to the extent that it adds an additional rule to the set of rules set forth in claim 1, i.e., “the second player receiving an additional point score of game points if the first word includes any lettered game piece positioned on a game piece location

with a location designator indicating the second player.” Appeal Br. 10. We are not persuaded by Appellant’s assertion (Appeal Br. 9) that the claims “require specific and particular apparatus,” with respect to claim 14. We agree with the Examiner (Ans. 8–9) that claim 14 does not recite an element or a combination of elements constituting an “inventive concept,” i.e., something significantly more than the abstract idea itself, sufficient to render claim 14 patent-eligible.

Because Appellant has not separately argued claims 4, 5, 7, 10, 11, and 18<sup>7</sup> apart from claims 1 and 14, they stand or fall with claims 1 and 14. 37 C.F.R. § 41.37(c)(1)(iv). Thus, we also agree with the Examiner that claims 4, 5, 7, 10, 11, and 18 do not recite elements, individually or in combination, constituting an “inventive concept,” i.e., something significantly more than the abstract idea itself, sufficient to render them patent-eligible.

Claim 2 depends from claim 1 and further recites “further comprising the second player receiving an additional point score of game points if the first word includes any lettered game piece positioned on a game piece location with a location designator indicating the second player.” This claim adds a rule to the set of rules set forth in claim 1, but does not add an element, alone or in combination with other elements, constituting an “inventive concept,” i.e., something significantly more than the abstract idea itself, sufficient to render them patent-eligible.

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<sup>7</sup> On page 11 of the Appeal Brief, Appellant refers to claim 18 as requiring that the game be effected electronically. Claim 18 includes no such recitation. Rather, claim 15 does. We assume Appellant’s argument is directed to claim 15 and not claim 18.

Claim 3 depends from claim 1 and further recites “wherein the game piece location structure is a board with multiple locations on which a game piece is placeable, the method further comprising the players forming words by placing lettered game pieces on at least one location of the board.” The additional element here, aside from the game rules, is a generic game board. The Examiner has determined that a generic game board is a well understood, routine, and conventional game surface. Ans. 10. For the same reasons as those discussed above in the context of claims 1 and 14, we reject Appellant’s assertion that claim 3 requires a specific and particular game apparatus that is novel and nonobvious. Thus, we agree with the Examiner (Ans. 8–9) that claim 3 does not recite an element or a combination of elements constituting an “inventive concept,” i.e., something significantly more than the abstract idea itself, sufficient to render claim 3 patent-eligible.

Claim 6 depends from claim 1 and further recites “wherein the lettered game pieces are one of die, tile, card, and electronic game piece.” This recitation is generic and the Examiner has determined that such elements are well understood, routine and conventional. Ans. 10. For the same reasons as those discussed above in the context of claims 1 and 14, we reject Appellant’s assertion that claim 6 requires a specific and particular game apparatus that is novel and nonobvious. Thus, we agree with the Examiner (Ans. 8–9) that claim 6 does not recite an element or a combination of elements constituting an “inventive concept,” i.e., something significantly more than the abstract idea itself, sufficient to render claim 6 patent-eligible.

Claim 8 depends from claim 1 and further recites “wherein the method is effected electronically.” This recitation merely reflects

application of the game rules to a particular technological environment or field of use, i.e., electronically. The prohibition against patenting abstract idea cannot be circumvented by attempting to limit the use of the formula to a particular technological environment. *Bilski*, 561 U.S. at 610–11; *Diamond v. Diehr*, 450 U.S. 175, 191–92 (1981). We agree with the Examiner (Ans. 8–9) that claim 6 does not recite an element or a combination of elements constituting an “inventive concept,” i.e., something significantly more than the abstract idea itself, sufficient to render claim 8 patent-eligible.

Claim 9 depends from claim 1 and further recites “wherein the method is effected over the Internet.” This recitation merely reflects application of the game rules to a particular technological environment or field of use, i.e., over the Internet. The prohibition against patenting abstract idea cannot be circumvented by attempting to limit the use of the formula to a particular technological environment. *Bilski*, 561 U.S. at 610–11; *Diamond*, 450 U.S. at 191–92. We agree with the Examiner (Ans. 8–9) that claim 9 does not recite an element or a combination of elements constituting an “inventive concept,” i.e., something significantly more than the abstract idea itself, sufficient to render claim 9 patent-eligible.

Claim 12 depends from claim 1 and further recites as follows:

wherein the at least one lettered game piece is from the second group, and the method further comprising

determining a game point value for the second point score by using a die or dice by one of the following:

a die is rolled and shows a die face with a numeral thereon and the value of the numeral is the second point score;

a die is rolled and shows a die face with a numeral thereon and the value of the second point score is the first point score times the numeral value of the numeral;

two dice are rolled and a face of each die shows on a die face a numeral and the combined value of the two numerals is the second point score; and

two dice are rolled and each shows a die face with a numeral thereon and the second point score is the first point score times the combined numeral value of the two numerals.

The additional element here is one generic die or two generic dice.

The Examiner has determined that generic dice is well understood, routine, and conventional. Ans. 10. For the same reasons as those discussed above in the context of claims 1 and 14, we are not persuaded by Appellant's assertion that claim 12 requires a specific and particular game apparatus that is novel and nonobvious. We agree with the Examiner (Ans. 8–9) that claim 12 does not recite an element or a combination of elements constituting an "inventive concept," i.e., something significantly more than the abstract idea itself, sufficient to render claim 12 patent-eligible.

Claim 13 depends from claim 1 and further recites "wherein the game is an improved version of an existing word game, the existing word game being one of SCRABBLE (Trademark) game and BOGGLE (Trademark) game." This claim is sufficiently broad so as to require only the adoption of certain rules of the pre-existing games and not any particular game piece structure or game piece location structure from the pre-existing games. Even if the same game board and game pieces from pre-existing games are adopted, it does not support that any structure beyond what is well understood, routine, or conventional is used. We agree with the Examiner (Ans. 8–9) that claim 13 does not recite an element or a combination of

elements constituting an “inventive concept,” i.e., something significantly more than the abstract idea itself, sufficient to render claim 13 patent-eligible.

Claim 15 depends from claim 14 and further recites “wherein the method is effected electronically or over the Internet.” For the same reasons discussed above in the context of claims 8 and 9, claim 15 does not recite an element or a combination of elements constituting an “inventive concept,” i.e., something significantly more than the abstract idea itself, sufficient to render claim 15 patent-eligible.

Claim 16 depends from claim 14 and further recites “wherein the game piece location structure is a container with multiple compartments for holding a game piece, the method further comprising the players forming words by placing lettered game pieces in at least one compartment of the container.” As discussed above in the context of claim 16 and prong 2 if Step 2A, the recited container with multiple compartments is generic and does not require a specific structure. The Examiner has determined that such generic game structure is well understood, routine, and conventional. Ans. 10. For the same reasons as those discussed above in the context of claims 1 and 14, we are not persuaded by Appellant’s assertion that claim 16 requires a specific and particular game apparatus that is novel and nonobvious. We note also that the Specification at page 30 refers to the pre-existing word game BOGGLE<sup>®</sup> having a container structure, and incorporates by reference U.S. Patent No. 8,002,280, which discloses a container with internal compartments for holding lettered dice pieces in a word game apparatus. Spec. 30. We, therefore, agree with the Examiner (Ans. 8–9) that claim 16 does not recite an element or a combination of elements constituting an

“inventive concept,” i.e., something significantly more than the abstract idea itself, sufficient to render claim 16 patent-eligible.

Claim 17 depends from claim 14 and further recites “wherein the game piece location structure is a board with multiple locations on which a game piece is placeable, the method further comprising the players forming words by placing lettered game pieces on at least one location of the board.” For the same reasons discussed above in the context of claim 3, we agree with the Examiner (Ans. 8–9) that claim 3 does not recite an element or a combination of elements constituting an “inventive concept,” i.e., something significantly more than the abstract idea itself, sufficient to render claim 17 patent-eligible.

### CONCLUSION

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1–18	101	Patent-Ineligible Subject Matter	1–18	

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

AFFIRMED