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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* ATHANASIOS ANGELOPOULOS

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Appeal 2019-006278  
Application 14/034,530  
Technology Center 3700

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Before JENNIFER D. BAHR, MICHELLE R. OSINSKI, and  
SEAN P. O'HANLON, *Administrative Patent Judges*.

BAHR, *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 decision rejecting claims 1, 2, 4–8, 11, 27, and 29–39. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> We use the term “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as White Knuckle Gaming, LLC. Appeal Br. 4.

## THE CLAIMED SUBJECT MATTER

Claim 1, reproduced below, is illustrative of the claimed subject matter.

1. A game medium consisting of read-only memory (ROM), the game medium configured to provide a sports video game in conjunction with a video game machine, the video game including a plurality of video game characters that simulate real-life sports athletes, the video game characters arranged into video game sports teams that simulate real-life sports teams of a real-life sports league, each video game character configured to perform in the video game based at least in part on a player performance parameter associated therewith, the game medium being configured to cause the video game machine to perform a method when loaded thereon, the method comprising:

    during a single sports season, receiving a series of updated video game character performance parameters in a plurality of transmissions from a data server via a network including the Internet, wherein each of the updated video game character performance parameters in the series is (i) based at least in part on one or more most recent real-life athlete performance characteristics of a particular real-life sports athlete performing in one or more most recent sporting events during the single sports season, wherein the sporting events are a team event of a particular team of the real-life sports league to which the the [*sic*] particular real-life sports athlete is a member of [*sic*];

    during the single sports season, updating a performance attribute of a particular video game character of the sports video game a plurality of times using the series of updated video game character performance parameters received, wherein each of the updating includes loading the particular updated video game parameter into RAM and the particular updated parameter changes a manner in which the particular individual video game character performs in the sports video game such that the particular individual video game character more closely simulates the most recent real-life athlete performance characteristics of the particular real-life sports athlete; and

enabling a user to control the video game character.

### EVIDENCE

The prior art relied upon by the Examiner is:

Swanberg            US 2002/0155893 A1            Oct. 24, 2002

*EA Sports Madden NFL<sup>(TM)</sup> 2000 Reference Card* (1999) (hereinafter “Madden00”).

*EA Sports Madden NFL<sup>(TM)</sup> 2000 Roster Update–Playoff Week 1* (January 7, 2000) (hereinafter “MaddenPlayoff”).

*EA Sports Madden NFL<sup>(TM)</sup> 2000 Roster Update–EA Super Bowl* (January 28, 2000) (hereinafter “MaddenSuperBowl”).

*EASports.com—Madden 2000* (March 2, 2000), available at [https://web.archive.org/web/20000302192248/http://www.easports.com/99/madden2000/downloads\\_pc.cfm](https://web.archive.org/web/20000302192248/http://www.easports.com/99/madden2000/downloads_pc.cfm) (hereinafter “MaddenDownloads”).

*EA Sports FIFA 2001* (April 25, 2001), available at <https://web.archive.org/web/20010425215945/http://www.fifa2001.com/archive/arc11-2000.shtml> (hereinafter “FIFA”).

*EA Sports Madden NFL<sup>(TM)</sup> 2003 Playstation2 Manual* (2002) (hereinafter “Madden03”).

### REJECTIONS

- I. Claims 11, 35, and 38 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite.
- II. Claims 1, 2, 4–8, 11, 27, and 29–39 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.

- III. Claims 1, 2, 5–8, 11, 27, and 29–38 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Madden03, Madden00, MaddenSuperBowl, MaddenPlayoff, MaddenDownloads, and Swanberg.
- IV. Claim 4 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Madden03, Madden00, MaddenSuperBowl, MaddenPlayoff, MaddenDownloads, Swanberg, and FIFA.
- V. Claim 39 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Madden03 and Swanberg.

## OPINION

### *Rejection I – Indefiniteness*

Appellant does not present any arguments contesting this rejection. *See* Appeal Br. 9 (stating that “Appellant holds in abeyance a response to the . . . rejection[] under Section 112 for correction post-appeal”); *see also id.* at 9–56 (presenting arguments only with respect to the rejections under 35 U.S.C. §§ 101 and 103(a)). Consequently, Appellant has waived any argument of error, and we summarily sustain the Examiner’s rejection of claims 11, 35, and 38 under 35 U.S.C. § 112, second paragraph, as indefinite. *See In re Berger*, 279 F.3d 975, 984–85 (Fed. Cir. 2002) (holding that the Board did not err in sustaining an indefiniteness rejection when the appellant failed to contest the rejection on appeal); *see also* 37 C.F.R. § 41.31(c) (“An appeal, when taken, is presumed to be taken from the rejection of all claims under rejection unless cancelled by an amendment filed by the applicant and entered by the Office.”).

*Rejection II – Subject Matter Eligibility*

*Principles of Law*

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

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

Concepts determined to be abstract ideas, and thus patent ineligible, include certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)). Concepts determined to be patent eligible include physical and chemical processes, such as “molding rubber products” (*Diamond v. Diehr*, 450 U.S. 175, 191 (1981)); “tanning, dyeing, making water-proof cloth, vulcanizing India

rubber, smelting ores” (*id.* at 182 n.7 (quoting *Corning v. Burden*, 56 U.S. 252, 267–68 (1853))); and manufacturing flour (*Benson*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

In *Diehr*, the claim at issue recited a mathematical formula, but the Supreme Court held that “a claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula.” *Diehr*, 450 U.S. at 187; *see also id.* at 191 (“We view respondents’ claims as nothing more than a process for molding rubber products and not as an attempt to patent a mathematical formula.”). Having said that, the Supreme Court also indicated that a claim “seeking patent protection for that formula in the abstract . . . is not accorded the protection of our patent laws, . . . and this principle cannot be circumvented by attempting to limit the use of the formula to a particular technological environment.” *Id.* (citing *Benson* and *Flook*); *see, e.g., id.* at 187 (“It is now commonplace that an *application* of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.”).

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

“[M]erely requir[ing] generic computer implementation[] fail[s] to transform that abstract idea into a patent-eligible invention.” *Id.*

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

- (1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activity such as a fundamental economic practice, or mental processes); and
- (2) additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h)).

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

- (3) adds a specific limitation beyond the judicial exception that is not “well-understood, routine, conventional” in the field (*see* MPEP § 2106.05(d)); or
- (4) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

*See* 2019 Eligibility Guidance.

#### *Analysis*

In contesting the 35 U.S.C. § 101 rejection, Appellant references certain limitations recited in independent claims 1, 30, 38, and 39, but otherwise presents arguments without regard to any particular claim. Appeal Br. 9–24; Reply Br. 2–8. We select claim 1 as representative to decide the

appeal of this rejection, and claims 2, 4–8, 11, 27, and 29–39 stand or fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv) (providing that when multiple claims subject to the same ground of rejection are argued as a group by an appellant, the Board may select a single claim from the group to decide the appeal with respect to the group as to the ground of rejection on the basis of the selected claim alone).

The Examiner determines that claim 1 is “directed to the abstract idea of rewriting software to produce an updated version, which corresponds to concepts identified as abstract ideas by the courts.” Final Act. 3 (citing *White Knuckle Gaming, IP, LLC, v. Elec. Arts Inc.*, 2016 WL 3129133 (D. Utah 2016), *aff’d without op.* 683 F. App’x. 931 (Fed. Cir. 2017)). The Examiner explains that the steps recited in claim 1

describe the concept of sending and receiving updated software over the Internet which is well-known, long-practiced and fundamental to the software industry. The claims are directed [to] a patent-ineligible concept because they describe a simple internet-based method of updating software that is performed on conventional equipment. It is a longstanding business practice in the video game industry to update sports video games parameters to reflect real-world developments.

*Id.* at 4. The Examiner also determines that “the additional computer elements, which are recited at a high level of generality, provide conventional computer functions that do not add meaningful limits to practicing the abstract idea.” *Id.* at 3. In particular, the Examiner explains that claim 1

recites . . . additional limitations of a “data server” for receiving updated data, and a “network” and the “Internet” for transmission of data. The claimed invention doesn’t have an additional element that transforms the abstract idea into an inventive concept, because it doesn’t rely on anything other

than generic computer equipment in order to be accomplished. Though the video game updates . . . are able to happen frequently over the internet, they use the network in a normal manner. This use of technology “is exactly the type” of generic computer implementation that the Supreme Court in *Alice* said does not qualify as an additional feature that can make the material patent-eligible.

*Id.* at 5.

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

Appellant argues that claim 1 does not fall within any of the groupings of abstract ideas identified in the 2019 Eligibility Guidance. Reply Br. 5. Appellant asserts that the claim is “directed to a game medium configured to provide a sports video game in conjunction with a video game machine. . . . The game medium is not a mathematical concept, a method for organizing human activity, or a mental process.” *Id.* at 5–6. This argument is unpersuasive.

Claim 1 recites a game medium configured to cause a video game machine to perform a method comprising the steps of receiving, via the internet, a series of video game character performance parameters updates based on recent real-life athlete performance characteristics during a sports season, updating a performance attribute of a particular video game character a plurality of times using the received performance parameters by loading updated parameters into RAM, and enabling user control of the video game character. *See* Appeal Br. 58–59 (Claims App.). In other words, the process recited in claim 1 amounts to a simple internet-based method of updating sports video game software. *See White Knuckle Gaming, IP, LLC*, 2016 WL at \*3. These limitations describe what the 2019 Eligibility Guidance calls “commercial interactions” (or “business

relations”), which is a variety of judicially excepted abstract ideas—specifically, “[c]ertain methods of organizing human activity.” 2019 Eligibility Guidance, 84 Fed. Reg. at 52. Thus, the Examiner correctly determines that claim 1 recites a judicial exception, namely, an abstract idea. *See* Final Act. 3.

*(2) Step 2A, Prong Two: Is There Integration into a Practical Application?*

Having found that claim 1 recites a judicial exception, namely, an abstract idea, we are instructed by the 2019 Eligibility Guidance to determine whether each claim recites “additional elements that integrate the exception into a practical application.” *See* 2019 Eligibility Guidance, 84 Fed. Reg. at 54; *see also* MPEP § 2106.05(a)–(c), (e)–(h). This evaluation requires us to determine whether an additional element or a combination of additional elements in a claim applies, relies on, or uses 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 exception. If the recited judicial exception is integrated into a practical application, the claim is not “directed to” the judicial exception.

Here, the only additional elements recited in claim 1 beyond the judicial exception are “[a] game medium consisting of read-only memory (ROM),” “a video game machine” carrying out the method steps, “a plurality of transmissions from a data server via a network including the Internet,” “loading the particular video game parameters into RAM,” and “enabling a user to control the video game character.” Appeal Br. 58–59 (Claims App.). However, these additional elements are described only generically in the Specification. *See, e.g.*, Spec. ¶¶ 27, 29, 30. We find no indication in the Specification, nor does Appellant direct us to any evidence, that these steps

recited in claim 1 invoke any assertedly inventive programming, require any specialized computer hardware or other inventive computer components, i.e., a particular machine, or that the claimed invention is implemented using other than generic computer components to perform generic computer functions. *See DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014) (“[A]fter *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible.”). For example, the step of receiving a plurality of transmissions from a data server via network is simply a generic data gathering step, which constitutes insignificant extra-solution activity. *See, e.g., CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011) (“We have held that mere ‘[data-gathering] step[s] cannot make an otherwise nonstatutory claim statutory.’” (alterations in original) (quoting *In re Grams*, 888 F.2d 835, 840 (Fed. Cir. 1989))); *see also* 2019 Eligibility Guidance, 84 Fed. Reg. at 55 (identifying “add[ing] insignificant extra-solution activity to the” abstract idea as an example of when an abstract idea has not been integrated into a practical application). Moreover, the ROM, video game machine, server, network, and RAM elements are merely generically-recited computer components that do “no more than generally link the use of a judicial exception to a particular technological environment or field of use.” 2019 Eligibility Guidance, 84 Fed. Reg. at 55; *see also Bilski*, 561 U.S. at 610–11 (“[T]he prohibition against patenting abstract ideas ‘cannot be circumvented by attempting to limit the use of the formula to a particular technological environment’ or adding ‘insignificant postsolution activity.’”) (quoting *Diehr*, 450 U.S. at 191–92).

Appellant argues “that the claims integrate the judicial exception into a practical application and are therefore patent eligible.” Reply Br. 6. In particular, Appellant asserts that claim 1 is “comparable to the claims in *Enfish*, *LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016)] in that [it] relate[s] to particular improvements in computer technology. This improvement of the Applicant’s invention define[s] the innovative features of more dynamic, reliable, seamless, accurate, flexible and versatile video game.” Appeal Br. 16; *see also id.* at 19 (asserting that the “claimed invention is related to a concrete improvement in computer technology just like *Enfish*”). Appellant asserts that the subject matter “is directed to, and claims, a specific type of improvement to sports video games.” *Id.* at 23 (emphasis omitted); *see also id.* at 20–21 (citing *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016)). According to Appellant, the “[S]pecification specifically identifies the improvement as easily providing a video game that simulates athletes from the current season (i.e., ‘new events of the week, day, or hour’) rather than ‘last season’s teams.’” Reply Br. 6 (quoting Spec. ¶ 9). We are not persuaded by this line of argument.

In *Enfish*, our reviewing court found that “the self-referential table recited in the claims on appeal is a specific type of data structure designed to improve the way a computer stores and retrieves data in memory.” *Enfish*, 822 F.3d at 1339. The *Enfish* court found they were “not faced with a situation where general-purpose computer components are added post-hoc to a fundamental economic practice or mathematical equation,” but “[r]ather, the claims are directed to a specific implementation of a solution to a problem in the software arts.” *Id.* Here, Appellant does not identify any

evidence, or any disclosure in the Specification, that the claimed invention improves the operation of a computer (e.g., video game machine), or causes it to function in a different manner. In other words, Appellant does not explain, nor do we discern, how the claimed receiving and updating steps of claim 1 cause the video game machine to function any differently than without these steps. As discussed above, claim 1 recites only generic computer elements in performing the claimed steps, and Appellant does not provide persuasive evidence or technical reasoning to show that these computer elements operate in other than a generic manner. Any improvement in the method of claim 1 appears to reside in the abstract idea itself (i.e., the commercial interactions or business relations representing certain methods of organizing human activity), not in the additional elements recited in the claim.

We are also unpersuaded by Appellant's attempt to analogize the instant claims to the claim determined to be eligible in *McRO*. See Appeal Br. 20–21. In *McRO*, the claim at issue was directed to automatically animating the lip synchronization and facial expressions of three-dimensional animated characters. *McRO*, 837 F.3d at 1307–08. There, the Federal Circuit determined that the claimed invention, considered as a whole, used limited rules in a computer process specifically designed to achieve a technological improvement over existing, manual 3-D animation techniques. *Id.* at 1316. As such, the court determined that *McRO*'s claim was not directed to an abstract idea, and was patent-eligible under 35 U.S.C. § 101. *Id.* According to *McRO*, the relevant question is whether the claim as a whole “focus[es] on a specific means or method that improves the relevant technology” or is “directed to a result or effect that itself is the

abstract idea and merely invoke generic processes and machinery.” *Id.* at 1314. As the Federal Circuit made clear in *Two-Way Media Ltd. v. Comcast Cable Communications*, the improvement must be a technical one. *See Two-Way Media Ltd. v. Comcast Cable Commc’ns, LLC*, 874 F.3d 1329, 1338–39 (Fed. Cir. 2017) (reciting an abstract idea performed on generic computer and network components that operate according to their ordinary functions does not contain an inventive concept). Here, Appellant’s claim does not recite a technical improvement tied to a specific apparatus that solves a technical problem. Instead, the claim, as a whole, relates to providing an improved video game experience for a user (i.e., providing a “dynamic, reliable, seamless, accurate, flexible and versatile video game” (Appeal Br. 16); “being an enjoyable video game” (*id.* at 23)), not an improvement in technology.

Appellant argues that the Examiner’s rejection “ignores the specific and meaningful claim elements that describe ‘how’ the ‘updating’ is performed to give rise to [a] vastly more efficient video game that is more fun to play and more realistic.” Reply Br. 2 (citing *Core Wireless Licensing S.A.R.L. v. LG Elecs., Inc.*, 880 F.3d 1356 (Fed. Cir. 2018)). Appellant asserts that claim 1 is similar to the eligible claims in *Core Wireless* “because the claim contains precise language delimiting the type of data to be displayed and how to display it, thus improving upon conventional sports video games to increase the realism and efficiency of the video game machine.” *Id.* at 4. According to Appellant,

Configuring a video game with player performance parameters that control an attribute of the video game character and then configuring the video game to receive a series of updates from a server during the season to increase the realism

of the video game is “precise language delimiting the type of data to be displayed and how to display it,” thus improving upon conventional sports video games to increase the realism and efficiency with which that realism can be delivered and is therefore patent eligible in view of *Core Wireless*.

*Id.* at 4–5. This argument is unpersuasive.

The claims at issue in *Core Wireless* were directed to “an improved user interface for electronic devices, particularly those with small screens.” *Core Wireless*, 880 F.3d at 1363. The specification described that “prior art interfaces had many deficits relating to the efficient functioning of the computer, requiring a user ‘to scroll around and switch views many times to find the right data/functionality,’” and disclosed that the claimed invention improved the “efficiency of using the electronic device by bringing together ‘a limited list of common functions and commonly accessed stored data,’ which can be accessed directly from the main menu.” *Id.* The specification also described that “[t]he speed of a user’s navigation through various views and windows” was improved because it “saves the user from navigating to the required application, opening it up, and then navigating within that application to enable the data of interest to be seen or a function of interest to be activated.” *Id.* The Federal Circuit concluded that this disclosure “clearly indicates that the claims are directed to an improvement in the functioning of computers, particularly those with small screens.” *Id.*

Here, claim 1 does not recite any limitations pertaining to a user interface or displaying information. As discussed above, claim 1 merely recites generic computer components performing generic computer functions associated with receiving information (i.e., performance parameter updates), sending information (i.e., transmissions from a data server), and inputting

(i.e., enabling a user to control the game character) without any technological improvement to the computer components themselves. In other words, we find no indication in the claims or Specification that claim 1 is directed to an improved interface analogous to the one in *Core Wireless* or any other technical improvement that provides an improvement in computer functionality.

Additionally, we find no indication in the Specification that the claimed invention effects a transformation or reduction of a particular article to a different state or thing. Nor do we find anything of record that attributes an improvement in computer technology and/or functionality to the claimed invention or that otherwise indicates that the claimed invention integrates the abstract idea into a “practical application.” *See* 2019 Eligibility Guidance, 84 Fed. Reg. at 55.

For the above reasons, we determine that the additional elements recited in independent claim 1 beyond the judicial exception, whether considered alone or in combination, do not integrate the abstract idea into a practical application. In other words, claim 1 is “directed to” an abstract idea.

*(3) Step 2B: Does claim 1 Recite an Inventive Concept?*

Because we determine that claim 1 fails to recite additional elements that integrate the judicial exception into a practical application, in accordance with the 2019 Eligibility Guidance, we next consider whether the claim adds a specific limitation beyond the judicial exception that is not “well-understood, routine, conventional” in the field or instead “simply appends well-understood, routine, conventional activities previously known

to the industry, specified at a high level of generality, to the judicial exception.” *See* 2019 Eligibility Guidance, 84 Fed. Reg. at 56.

Appellant argues that the claim “would be patent eligible at step 2B based on the recently decided Federal Circuit decision in [*Berkheimer v. HP, Inc.*, 890 F.3d 1369, 1374 (Fed. Cir. 2018)].” Reply Br. 7. In particular, Appellant asserts that the Examiner “has not shown that updating a particular attribute of a video game character a plurality of times during a season is conventional or routine or established that the benefits would be well-understood to one of skill in the art at the time the Application was filed.” *Id.* at 8. According to Appellant, the “claimed invention is clearly directed to something narrower than ‘updating software’ and is clearly directed to a useful and ‘inventive concept’ specific to sports video games.” Appeal Br. 20. This argument is unpersuasive.

The receiving and updating video game character performance attributes during a season represents *the abstract idea itself* (i.e., certain methods of organizing human activity, namely, commercial interactions or business relations). However, the inventive concept under step two of the *Mayo/Alice* test cannot be the abstract idea itself. *See Berkheimer*, 890 F.3d at 1374 (Moore, J., concurring) (“It is clear from *Mayo* that the ‘inventive concept’ cannot be the abstract idea itself, and *Berkheimer* . . . leave[s] untouched the numerous cases from this court which have held claims ineligible because the only alleged ‘inventive concept’ is the abstract idea.”); *see also BSG Tech LLC v. BuySeasons, Inc.*, 899 F.3d 1281, 1290–91 (Fed. Cir. 2018) (“Our precedent has consistently employed this same approach. If a claim’s only ‘inventive concept’ is the application of an abstract idea

using conventional and well-understood techniques, the claim has not been transformed into a patent-eligible application of an abstract idea.”).

For the reasons discussed above, we find no element or combination of elements recited in claim 1 beyond the judicial exception that is not “well-understood, routine, conventional” in the field or that contains any “inventive concept” or adds anything “significantly more” to transform the abstract concept into a patent-eligible application. *Alice*, 573 U.S. at 221. Accordingly, we sustain the rejection of claim 1, and claims 2, 4–8, 11, 27, and 29–39 falling therewith, under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.

*Rejection III – Obviousness based on Madden03, Madden00, MaddenSuperBowl, MaddenPlayoff, MaddenDownloads, and Swanberg*

In contesting this rejection, Appellant presents arguments without regard to any particular claim. *See* Appeal Br. 24–53. Thus, we select claim 1 as representative, and claims 2, 5–8, 11, 27, and 29–38 stand or fall with claim 1.

The Examiner finds that Madden03 discloses a game medium configured to provide a sports video game and cause a video game machine to perform a method that includes,

during a single sports season, receiving a series of updated video game character performance parameters (pps. 27, 28, and 31 discloses changing attributes of any player) a plurality of transmissions from a data server via a network including the Internet (pps. 15–17 discloses online connection and updates to current NFL roster), wherein the sporting events are a team event of a particular team of the real-life sports league to which the particular real-life sports athlete is a member of (pg. 10, where football teams in video game are

created after real-life NFL athletes and teams, where the sporting events are football video games played on the game console); and

enabling a user to control the video game character (pps. 4–8 discloses basic controls).

Final Act. 7 (boldface omitted). The Examiner finds that Madden03 does not disclose

each video game character configured to perform in the video game based at least in part on a player performance parameter associated therewith,

a series of updated video game character performance parameters in a plurality of transmissions from a data server, wherein each of the updated video game character performance parameters in the series is (i) based at least in part on one or more most recent real-life athlete performance characteristics of a particular real-life sports athlete performing in one or more most recent sporting events during the single sports season, [and,]

during the single sports season, updating a performance attribute of a particular video game character of the sports video game a plurality of times using the series of updated video game character performance parameters received, wherein each of the updating includes loading the particular updated video game parameter into RAM and the particular updated parameter changes a manner in which the particular individual video game character performs in the sports video game such that the particular individual video game character more closely simulates the most recent real-life athlete performance characteristics of the particular real-life sports athlete.

*Id.* at 8 (emphasis omitted). However, the Examiner finds that “Madden00 teaches each video game character configured to perform in the video game based at least in part on a player performance parameter associated therewith (pg. 32 discloses ‘rating abbreviations’ related to athlete abilities in video game).” *Id.* The Examiner explains that “Madden03 and Madden00 are part of the Madden football video game series where progressively over time

enhancing the play, performance, and entertainment value to sports video game players is the goal.” *Id.* The Examiner determines that it would have been obvious to combine the teachings of Madden00 with the video game of Madden03 in order “to enhance Madden game play features over time in hopes to make the game progressively more fun for game players.” *Id.* at 9.

The Examiner finds that “MaddenSuperBowl and MaddenPlayoff disclose[] adjusted rosters and player abilities; and MaddenDownloads discloses a number of roster patches available for downloading, where the roster patches are relatively recent to . . . when a game player decides to download the patch.” Final Act. 9. The Examiner determines that it would have been obvious to combine the teachings of MaddenSuperBowl, MaddenPlayoff, and MaddenDownloads with the Madden03 video game “in order to give game players a feeling that they are actually playing a real life game which adds to the excitement and fun of playing a sports-related video game.” *Id.* at 10.

The Examiner also finds that “Swanberg teaches loading the particular updated video game parameter into RAM (¶32). The Playstation of Madden03 is a form of a computer system where it [is] commonly known that computer system[s] comprise . . . some form of RAM to process programs and software.” Final Act. 10. The Examiner determines that it would have been obvious to combine the teachings of Swanberg with the video game of Madden03 “in order to continually store game downloads on the gaming console and assist in providing the modified game play.” *Id.*

Appellant argues that Swanberg teaches away from the claimed invention. Appeal Br. 24; *see also id.* at 27 (asserting “that Swanberg

teaches away from the application to the Madden references” (italics omitted)). Appellant asserts that

Swanberg relates to smart trading cards. For the smart trading cards of Swanberg to be useful for trading, the smart cards must be different from one another. That is, a person with a trading card would have no incentive to trade their card for the exact same trading card. It is also unlikely that the smart trading card holder would have held, or played with, all of the cards of an entire league or team. It is this inherent bartering system of unique trading cards in Swanberg that clearly differentiates the teachings of Swanberg from the Applicant’s claimed invention.

*Id.* at 25 (italics omitted). We are not persuaded by this argument.

A reference teaches away from a claimed invention or a proposed modification if “a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Kubin*, 561 F.3d 1351, 1357 (Fed. Cir. 2009) (quoting *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)). Prior art does not teach away from claimed subject matter merely by disclosing a different solution to a similar problem unless the prior art also criticizes, discredits, or otherwise discourages the solution claimed. *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). Here, Appellant does not point to, nor do we find, any disclosure in Swanberg criticizing, discrediting, or otherwise discouraging the combination of teachings proposed by the Examiner in the rejection. The fact that Swanberg relates to smart trading cards does not constitute a teaching away from the Examiner’s proposal to modify Madden03 to include loading updated video game parameters into RAM (*see* Final Act. 10; Ans. 25–26).

Appellant argues that Swanberg is non-analogous art. Appeal Br. 24. Appellant asserts that “the problems and solutions apparent in Swanberg are specifically related to trading cards and are not directed as analogous art to the Applicant’s claimed invention under the broadest reasonable interpretation consistent with the Applicant’s specification.” *Id.* at 27 (italics omitted). This argument is unpersuasive.

Regarding the issue of analogous art, the established precedent of our reviewing court sets up a two-fold test for determining whether art is analogous: “(1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor’s endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.” *In re Klein*, 647 F.3d 1343, 1348 (Fed. Cir. 2011) (quoting *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004)). Here, Swanberg is analogous art at least because the reference is in the same field of endeavor as Appellant’s disclosure. Appellant’s Specification describes sports video games. *See* Spec. ¶ 1. Swanberg relates to “electronic games that use read/writeable media.” Swanberg ¶ 2. In particular, Swanberg “is directed to smart trading cards used to play a game on a computer terminal.” *Id.* ¶ 3; *see also id.* ¶ 5 (discussing electronic video gaming devices). Swanberg discloses a

version of the game using sports teams and players. In this system, each smart card collectible/trading card represents a team of players (e.g. 5 players for a basketball card or 9 players for a baseball card). The team functions as a whole when the card is used during games such as action/arcade, strategy, rotisserie leagues etc.

*Id.* ¶ 83; *see also id.* ¶ 86 (disclosing that “game play would be available to Team Card holders that would allow them to play an arcade[-]style baseball

games using the players on the Team Card”). Thus, Swanberg is in the same field as Appellant’s endeavor. Moreover, Swanberg discloses that “[t]he abilities of the players on the card could reflect the current statistics of the corresponding live player combined with the skill of the user playing the game.” *Id.* ¶ 86. In other words, “[w]hen the game play begins 241, the players on the Team Card will perform based upon the statistics loaded in step 239. For example, if Roger Clemens has had a bad week of pitching, then the ‘virtual Roger Clemens’ will not pitch as well as before.” *Id.* ¶ 95 (boldface omitted). Thus, Swanberg is also reasonably pertinent to a problem with which Appellant was concerned, namely, that sports video game character performance parameters are fixed at the time the game is produced, whereas “performance characteristics of real life sports players, teams and environments change throughout the year.” Spec. ¶¶ 3, 5. Consequently, Appellant’s assertion does not apprise us of error in the Examiner’s conclusion that Swanberg is analogous art. *See* Ans. 26.

Appellant argues that “Swanberg is not programmed to update, transmit, or download . . . a series of new player performance parameters for a particular league, team, or player to the smart trading car[d] throughout a season.” Appeal Br. 25 (italics omitted). We are not persuaded by this argument against Swanberg because it attacks the reference individually rather than as combined by the Examiner in the rejection. “Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references.” *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (citing *In re Keller*, 642 F.2d 413, 425 (CCPA 1981)). As discussed above, the Examiner relies on MaddenSuperBowl, MaddenPlayoff, and MaddenDownloads, not Swanberg,

for disclosing “a series of updated video game character performance parameters in a plurality of transmissions from a data server.” Final Act. 9. The Examiner relies on Swanberg only for disclosing a step of loading updated video game parameters into RAM. Final Act. 10 (citing Swanberg ¶ 32).

Appellant argues that one of ordinary skill in the art would not have a reasonable expectation of success in modifying Madden03 based on the teachings of Swanberg. Appeal Br. 25. According to Appellant, a server sending a series of updates for a particular sports video game character “is irrelevant to the teachings of Swanberg and would likely render the teachings of Swanberg non-functional if the trading cards of Swanberg had the same entities and/or updates thereto as each player is intended to be traded at some point.” *Id.* (italics omitted). This argument is unpersuasive because the Examiner’s rejection does not propose a modification of Swanberg. Instead, as discussed above, the Examiner proposes further modifying Madden03 to include loading updated video game parameters into RAM, as taught by Swanberg. Appellant does not proffer factual evidence or persuasive technical reasoning to explain how combining the teachings of Madden03 with the teachings of Swanberg in an operable manner would have been beyond the level of ordinary skill in the art. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (Fed. Cir. 2007) (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”).

Appellant argues that the cited references “do not teach a ‘series of updated video game character performance parameters’ based on performances of ‘a particular real-life sports athlete.’” Appeal Br. 28 (emphasis omitted). Appellant asserts that “the Office Action provides no

evidence that the Madden Updates disclose updating these [player] ratings in a series for a particular athlete or a particular video game character.” *Id.* (emphasis omitted) (citing Final Act. 8). Appellant asserts that “a series of roster updates does not produce a series of updated character performance parameters for a particular player.” *Id.* at 29. According to Appellant, “there is no evidence that any of the particular football player[’]s ratings changed more than one time in the Madden Updates and therefore is not a ‘series’ as required by the claims.” *Id.* We are not persuaded by this argument.

MaddenPlayoff discloses that “[t]his Roster is the first with *adjusted* rosters and *player abilities* leading into the NFL playoffs. *Each week* the roster file will be *updated to denote player performance in each eligible team[’]s playoff game.*” MaddenPlayoff 1 (emphasis added). MaddenSuperBowl similarly discloses that “[t]his Roster includes adjusted rosters and player abilities including performance during the NFL playoffs. Each week the roster file will be updated to denote player performance in each eligible team[’]s playoff game.” MaddenSuperBowl 1. In other words, each of MaddenPlayoff and MaddenSuperBowl discloses that a “Roster” update includes updates to team rosters *and* player abilities (i.e., game character performance parameters) in the Madden NFL video game based on a real-life player performance in actual NFL football games. Given MaddenPlayoff’s and MaddenSuperBowl’s disclosure that updates occur “each week” to denote playoff game performances by a player, Appellant does not apprise us of error in the Examiner’s finding that the cited references disclose a *series* of updates to player abilities based on

performances of real-life athletes. *See also* MaddenDownloads 1 (disclosing Madden NFL updates for playoff weeks 1–3).

Appellant argues that a person of ordinary skill in the art at the time of the invention did not recognize the need to provide parameters that were updated based on changing real-life events on a real-time or near real-time basis. Rather, sports video games in the late 1990s and early 2000s were only adding static features that simulated real life sports and at most required the creation of ‘mods’ or ‘patches’ to fix or update a video game.

Appeal Br. 33. Appellant asserts that MaddenSuperBowl, MaddenPlayoff, and MaddenDownloads disclose “patches [that] have not been shown to consistently update a particular video game player based on a series of athletic performances of a particular real-life athlete as opposed to a series of updated roster variations.” *Id.* According to Appellant, “[i]n the context of a sports video game, a ‘roster’ is the list of players on a particular sports team and the player’s position.” *Id.* at 34. We are not persuaded by these arguments.

As discussed above, MaddenPlayoff and MaddenSuperBowl disclose weekly updates to the video game that include, in addition to roster updates (i.e., personnel lists), updates to player abilities (i.e., game character performance parameters) reflecting performances by real-life players in actual NFL playoff games. *See* MaddenPlayoff 1 (disclosing that a “Roster” update includes adjustments to rosters and player abilities); MaddenSuperBowl 1. In other words, although Appellant contends that there was no recognized need for providing updated video game character parameters based on real-life events (Appeal Br. 33), MaddenPlayoff and MaddenSuperBowl evidence that it was known in the video game art, at the

time of the claimed invention, to provide a series of updates to sports video game character performance parameters based on real-life player performances during a sports season. *See also* Swanberg ¶¶ 86, 95 (disclosing that it was known to provide an arcade-style baseball game with in-game character abilities that reflect current statistics of real-life players, such as weekly pitching performances).

Appellant also argues that secondary considerations demonstrate non-obviousness of the claimed invention. *See* Appeal Br. 39–53. In particular, Appellant asserts that Exhibits I–V, submitted with the Appeal Brief, evidence commercial success, long-felt but unsolved need, industry praise, and copying. *Id.*

Appellant argues that “those of ordinary skill in the video game industry praise the claimed invention . . . as practiced by the EA [Sports] Dynamic DNA, EA [Sports] Adidas Live Season, and Take Two Sports Living Roster features released in 2008 over five years after the applicant’s priority date.” Appeal Br. 39 (emphasis omitted). Appellant cites to Exhibits I–T (*id.* at 40–48), which include various company press releases and video game blog and forum posts describing EA Sports’ Dynamic DNA and Take Two’s Living Roster features, and asserts that “those of ordinary skill in the art, including those who make sports video games and those who use sports video games[,] both praise the claimed invention as implemented in Dynamic DNA as new and innovative” (*id.* at 48). Appellant also argues that “the claimed invention has found commercial success . . . in the sports video game commercial market.” *Id.* at 39 (emphasis omitted). Appellant asserts that “both Dynamic DNA and Living Roster have been seen as an overwhelming success by those who design the sports video games, those

who designate a video game feature as the Best Innovation of 2008, as well as their customers who play the sports video games.” *Id.* at 50 (emphasis omitted). According to Appellant, “it appears that the Dynamic DNA and Living Roster features are one of the most important features which form the basis of consumer purchasing decisions between the two competing video games.” *Id.* at 51 (emphasis omitted); *see also id.* at 50–51 (citing to Exhibit M and asserting that exemplary quotes<sup>2</sup> show the importance of the Dynamic DNA and Living Roster features with respect to the consumer market’s interest).

“For objective evidence of secondary considerations to be accorded substantial weight, its proponent must establish a nexus between the evidence and the merits of the claimed invention.” *In re Kao*, 639 F.3d 1057, 1068 (Fed. Cir. 2011) (citation omitted). A patent applicant is entitled to a presumption of nexus when it is shown “that the asserted objective evidence is tied to a specific product and that product ‘embodies the claimed features, and is coextensive with them.’” *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1373 (Fed. Cir. 2019) (quoting *Polaris Indus., Inc. v. Arctic Cat, Inc.*, 882 F.3d 1056, 1072 (Fed. Cir. 2018)). If the claimed invention is only a component of a commercially successful machine or process, the patentee is not entitled to a presumption of nexus. *Id.* (reaffirming the importance of the “coextensiveness” requirement). If a secondary consideration results from something other than what is claimed and novel in the claim, there is no nexus to the merits of the claimed invention. *Id.*; *see also Tokai Corp. v. Easton Enters., Inc.*, 632 F.3d 1358, 1369 (Fed. Cir.

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<sup>2</sup> We note that the quotations provided on pages 50–51 of the Appeal Brief appear in Exhibit N, not Exhibit M.

2011) (“If commercial success is due to an element in the prior art, no nexus exists.”); *Ormco Corp. v. Align Tech., Inc.*, 463 F.3d 1299, 1312 (Fed. Cir. 2006) (“[I]f the feature that creates the commercial success was known in the prior art, the success is not pertinent.”).

Here, Appellant has not established a sufficient nexus between the claimed invention and the alleged industry praise and commercial success of the EA Sports and Take Two products discussed in Appellant’s exhibits. Appellant contends that “[a] nexus between the claims of the claimed invention and the secondary considerations based on [EA Sports’] NBA Live 09, [EA Sports’] [A]didas Live Season, and [Take Two’s] NBA 2K9 is presumed because these products are covered by the claimed invention.” Appeal Br. 51. According to Appellant, “[t]he Dynamic DNA and Living Rosters features are directed to the exact same concept as the inventions presently claimed.” *Id.* at 52. However, Appellant has not adequately explained how the EA Sports and Take Two video games that implement these features are coextensive with the scope of claim 1. The Dynamic DNA and Living Rosters features that are allegedly “the exact same” as the updating feature of the claimed invention (*id.*) are merely components of commercially successful video game products (i.e., EA Sports’ NBA Live and Take Two’s NBA 2K9 video games). Appellant has not persuasively shown that the alleged praise and commercial success of the EA Sports and Take Two video games is attributable to the features recited in claim 1. Thus, Appellant has not established a sufficient nexus between the praise and commercial success of the EA Sports and Take Two products and the claimed game medium, such that the proffered evidence does not

demonstrate that the praise and commercial success is sufficiently tied to the claimed subject matter.

Moreover, the alleged “novel” feature of the claimed game medium is updating video game character performance attributes using a series of updated video game character performance parameters that are based on real-life athlete performance in recent sporting events during a sports season, to which Appellant attributes the praise and commercial success of the EA Sports and Take Two products. *See, e.g.*, Appeal Br. 40–42, 48, 52. Even assuming that Appellant’s proffered evidence was attributable to this feature, the evidence of record shows that this feature already existed in the prior art, as discussed above with respect to MaddenPlayoff, MaddenSuperBowl, and MaddenDownloads. In other words, Appellant’s evidence of praise and commercial success, insofar as it concerns updating character performance parameters in sports video games based on real-life athlete performance during a sports season, must fail because it is “focused on conventional features in the prior art.” *ClassCo, Inc. v. Apple, Inc.*, 838 F.3d 1214, 1220 (Fed. Cir. 2016).

With respect to Appellant’s assertion of commercial success (*see* Appeal Br. 50–53), Appellant has not provided any objective evidence to support its position. As noted by the court in *In re Huang*, 100 F.3d 135, 139 (Fed. Cir. 1996), “the PTO lacks the means or resources to gather evidence which supports or refutes the applicant’s assertion that the sales constitute commercial success.” Thus, the court noted that the PTO must rely upon the applicant to provide hard evidence of commercial success. *Id.* at 140. Here, Appellant’s exhibits provide subjective evidence in the form of user feedback, reviews, and ratings, but do not provide any hard evidence

or objective data (e.g., market share) to support Appellant’s assertion of commercial success. Moreover, Appellant has not demonstrated that any evidence provided by the exhibits relates to commercial success of Appellant’s product; rather, it appears that any such commercial success is related to EA Sports’s and Take Two’s products. *See* Appeal Br. 50–53. On the basis of the limited information of commercial success provided in the exhibits, we find that the Appellant has failed to prove meaningful commercial success of the claimed invention.

Appellant argues that “the claimed invention has . . . fulfilled a long felt but unsolved need in the sports video game commercial market.” Appeal Br. 39 (emphasis omitted). Appellant asserts that “the Dynamic DNA feature by EA Sports and the Living Roster feature by Take Two have found sweeping success and addressed a long felt need in the industry for sports video games to more closely simulate the real-life attributes of athletes during a sports season.” *Id.* at 50 (emphasis omitted).

As explained by our reviewing court:

Long-felt need is closely related to the failure of others. Evidence is particularly probative of obviousness when it demonstrates both that a demand existed for the patented invention, and that others tried but failed to satisfy that demand. *See, e.g., In re Piasecki*, 745 F.2d 1468, 1475 (Fed.Cir.1984) (finding nonobviousness where the evidence demonstrated a failure of others to provide a feasible solution to a longstanding problem); *Alco Standard Corp. v. Tenn. Valley Auth.*, 808 F.2d 1490, 1500 (Fed.Cir.1986) (affirming a nonobviousness finding where the evidence showed that the relevant industry had searched for more than a decade for a reliable solution and that major manufacturers in the industry had tried but failed to develop such a solution).

*In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Patent Litig.*, 676 F.3d 1063, 1082–83 (Fed. Cir. 2012); *but see In re Depomed, Inc.*, 680 F. App'x. 947, 952–53 (Fed. Cir. 2017) (non-precedential) (stating, “While ‘[e]vidence is particularly probative of obviousness when it demonstrates both that a demand existed for the patented invention, and that others tried but failed to satisfy that demand,’ a patent owner may establish a long-felt but unmet need without presenting evidence of failure of others.”) (quoting *In re Cyclobenzaprine*, 676 F.3d at 1082).

Here, Appellant fails to establish a long-felt need in the industry. Establishing long-felt need requires objective evidence that an art-recognized problem existed in the art for a long period of time without solution. In particular, the evidence must show that the need was a persistent one that was recognized by those of ordinary skill in the art. *In re Gershon*, 372 F.2d 535, 538 (CCPA 1967). Appellant’s proffered evidence does not show that the purported “need in the industry for sports video games to more closely simulate the real-life attributes of athletes during a sports season” (Appeal Br. 50) was a persistent one or that others tried to meet the need and failed. “[L]ong-felt need is analyzed as of the date of an articulated identified problem and evidence of efforts to solve that problem.” *Texas Instruments, Inc. v. U.S. Int’l Trade Comm’n*, 988 F.2d 1165, 1178 (Fed. Cir. 1993). As such, we find that Appellant has failed to set forth sufficient evidence to establish a long-felt need in the industry.

Appellant argues that “the invention as recited in the claims has been copied by . . . large corporations with ample resources in the video game industry.” Appeal Br. 39 (emphasis omitted); *see also id.* at 48–50 (citing Exhibits U, V). Appellant asserts that it “filed this patent application more

than five years before EA Sports announced the Dynamic DNA feature and over five years before Take Two announced the Living Roster feature.” *Id.* at 48. Appellant asserts that “EA Sports and Take Two have argued over who came up with the novel feature first.” *Id.* at 49. According to Appellant, “[w]hether EA Sports copied Take Two or vice-versa, it is clear that those skilled in the art believe the feature was copied by one of them.” *Id.* (emphasis omitted).

“[C]opying requires evidence of efforts to replicate a specific product, which may be demonstrated through . . . access to the patented product combined with substantial similarity to the patented product.” *Wyers v. Master Lock Co.*, 616 F.3d 1231, 1246 (Fed. Cir. 2010). “[A] showing of copying is only equivocal evidence of non-obviousness in the absence of more compelling objective indicia of other secondary considerations.” *Ecolochem, Inc. v. Southern Cal. Edison Co.*, 227 F.3d 1361 (Fed. Cir. 2000).

Here, Appellant’s allegation that “the invention as recited in the claims has been copied” (Appeal Br. 39) lacks adequate evidentiary support. It is unclear from the evidence whether EA Sports or Take Two actually copied Appellant’s claimed invention, or whether the updating features of EA Sports’s and Take Two’s video game products were a result of the companies’ own efforts developing the video games. Appellant has not pointed to any evidence showing that EA Sports or Take Two copied Appellant’s invention after expending great effort to develop their own solutions. *See Pentec, Inc. v. Graphic Cntrls. Corp.*, 776 F.2d 309, 317 (Fed. Cir. 1985) (giving little weight to a copying argument where the alleged copy is not identical to the claimed product, and the alleged copier

has not expended great effort to develop its own solution). That the EA Sports and Take Two video games allegedly include features that are “covered by the claimed invention” (*id.* at 51) is not persuasive evidence of copying. *Iron Grip Barbell Co. v. USA Sports, Inc.*, 392 F.3d 1317, 1325 (“Not every competing product that arguably falls within the scope of a patent is evidence of copying. Otherwise every infringement suit would automatically confirm the nonobviousness of the patent.”). Even assuming, *arguendo*, that one of EA Sports and Take Two copied the other’s product, we discern no evidence that a specific product of Appellant’s was copied. *See id.* (“[C]opying requires the replication of a specific product.”).

Having considered all the evidence presented by Appellant against obviousness and weighing all the evidence, both of obviousness and of nonobviousness, it is our conclusion that the evidence of obviousness outweighs the evidence of nonobviousness of the subject matter of claim 1. *See Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (agreeing that “given the strength of the prima facie obviousness showing, the evidence on secondary considerations was inadequate to overcome a final conclusion that [the claimed subject matter] would have been obvious”). Accordingly, we sustain the rejection of claim 1, and claims 2, 5–8, 11, 27, and 29–38 falling therewith, as unpatentable over Madden03, Madden00, MaddenSuperBowl, MaddenPlayoff, MaddenDownloads, and Swanberg.

*Rejection IV – Obviousness based on Madden03, Madden00, MaddenSuperBowl, MaddenPlayoff, MaddenDownloads, Swanberg, and FIFA*

In contesting the rejection of claim 4, Appellant relies on the aforementioned arguments asserted against the rejection of independent claim 1. *See* Appeal Br. 9 (stating that, “[f]or purposes of this appeal only claim 4 may stand or fall with respect to independent claim 1 and is therefore not separately discussed”). For the reasons discussed above, Appellant’s arguments fail to apprise us of error in the rejection of claim 1 and, likewise, fail to apprise us of error in the rejection of claim 4, which we sustain.

*Rejection V – Obviousness based on Madden03 and Swanberg*

The Examiner finds that Madden03 discloses most of the limitations of independent claim 39, including, in relevant part,

means for directly contacting a data server through only a modem and the Internet to download video game character parameters of the video game league over the Internet during a single real-life sports season of the real-life sports league (pps. 15–17 discloses online connection and updates to current NFL roster using a modem to connect to the Internet).

Final Act. 18 (boldface omitted). The Examiner finds that “Madden03 fails to explicitly disclose download up-to-the-minute video game character performance parameters.” *Id.* at 19 (emphasis omitted). However, the Examiner finds that “Swanberg teaches download[ing] up-to-the-minute video game character performance parameters (¶96 teaches the latest live players’ statistics are downloaded).” *Id.* The Examiner determines that it would have been obvious to combine the teachings of Madden03 and

Swanberg “in order to continually store game downloads on the gaming console and assist in providing the modified game play.” *Id.*

Appellant initially relies on the same arguments presented in contesting Rejection III. *See* Appeal Br. 53–54 (asserting that “Swanberg teaches away from the Applicant’s claimed invention, Swanberg is non-analogous art, and one of ordinary skill in the art would not modify the Madden 2000 references in view of [Swanberg] to obtain the claimed invention with a reasonable expectation of success” (italics omitted)). For the same reasons discussed above, we are not persuaded by these arguments.

Appellant argues that the Examiner’s rejection of claim 39 is in error because “claim 39 includes a means-plus-function limitation and the proper analysis has not been made of record.” Appeal Br. 54. Appellant points to Figure 3 of the Drawings and asserts that “the Video Game Machine is directly connected to the data server (82) through only a modem (107) and the network (85) including the Internet. This means is devoid of user intervention or user operation for the up-to-the-minute video game character performance parameters of the video game league.” *Id.* at 56. According to Appellant, “[n]either Madden03 nor Swanberg teach[es] or suggest[s] such claimed means as shown and described in the specification and drawings nor would these references be able to accomplish such function as they require user intervention to obtain such updates.” *Id.* (italics omitted). We are not persuaded by this argument.

First, Appellant’s argument is not commensurate with the scope of claim 39. As stated by our reviewing court in *In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998), “the name of the game is the claim.” It is well established that limitations not appearing in the claim cannot be relied upon

for patentability. *See In re Self*, 671 F.2d 1344, 1348 (CCPA 1982). Here, claim 39 recites, in relevant part, “means for directly contacting a data server through only a modem and the Internet to download up-to-the-minute video game character performance parameters of the video game league over the Internet during a single real-life sports season of the real-life sports league.” *Id.* at 68 (Claims App.). Appellant points to Figures 1–6 of the Drawings and paragraph 38 of the Specification (*id.* at 55–56), but does not identify any disclosure to support an interpretation of the claim limitation as precluding user intervention in the update process.

Moreover, we are unpersuaded by Appellant’s argument that Madden03 and Swanberg would be unable to perform the function of directly contacting a server to download video game character performance parameters through only a modem and the internet. *See* Appeal Br. 56. The Examiner responds in the Answer that

Madden03 (see pps. 2 and 3 disclose Madden game disc), and Swanberg (see ¶[5, 39, and 50] discloses CDROM) disclose[] a game media where upon being read by a computing device such as a game console/machine is capable of modification as taught by downloadable data of MaddenSuperBowl, MaddenPlayoff, MaddenDownloads, and Swanberg (see ¶[30, 32, 40, and 95]). In regards to the “download up-to-the-minute” limitation the combination of Madden references and Swanberg can receive downloads as soon as new data is made available for downloading to a game console/machine of Madden or Swanberg.

Ans. 32. In this regard, Appellant does not persuasively refute the Examiner’s position. In particular, Appellant does not proffer any evidence or persuasive technical reasoning to support the assertion that the means identified by the Examiner in Madden03 and Swanberg would be incapable of performing the claimed function.

For the above reasons, Appellant does not apprise us of error in the Examiner’s determination that the subject matter of claim 39 would have been obvious. Accordingly, we sustain the rejection of claim 39 as unpatentable over Madden03 and Swanberg.

CONCLUSION

In summary:

<b>Claim(s) Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
11, 35, 38	112	Indefiniteness	11, 35, 38	
1, 2, 4–8, 11, 27, 29–39	101	Eligibility	1, 2, 4–8, 11, 27, 29–39	
1, 2, 5–8, 11, 27, 29–38	103(a)	Madden03, Madden00, MaddenSuperBowl, MaddenPlayoff, MaddenDownloads, Swanberg	1, 2, 5–8, 11, 27, 29–38	
4	103(a)	Madden03, Madden00, MaddenSuperBowl, MaddenPlayoff, MaddenDownloads, Swanberg, FIFA	4	
39	103(a)	Madden03, Swanberg	39	
<b>Overall Outcome</b>			<b>1, 2, 4–8, 11, 27, 29–39</b>	

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

AFFIRMED