

2015 WL 2172149 (Patent Tr. & App. Bd.)

Patent Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

EX PARTE DEITRA A. KUESTER AND ERIC J. KUESTER

Appeal 2013-001127

[Application 12/033,611](#)

Technology Center 3700

May 6, 2015

*1 Before [STEFAN STAICOVICI](#), LYNNE H. BROWNE, and TIMOTHY J. GOODSON
Administrative Patent Judges
GOODSON
Administrative Patent Judge

DECISION ON APPEAL

STATEMENT OF THE CASE

Deitra A. Kuester and Eric J. Kuester (Appellants) appeal under [35 U.S.C. § 134\(a\)](#) from the rejection of claims 12-17, 24, and 25. We have jurisdiction under [35 U.S.C. § 6\(b\)](#).

We AFFIRM.

CLAIMED SUBJECT MATTER

Claim 12, reproduced below, illustrates the subject matter on appeal:

12. A method of teaching comprising:

arranging a plurality of cards on a base to indicate a path of movement, wherein said base comprises a plurality of compartments, sized and shaped to receive and retain each card in place for the duration of a game after said cards have been arranged in one of a plurality of different configurations;

playing a game on said base in accordance with predetermined rules; and

retaining each card in place for the duration of a game;

wherein a game piece is advanced along said path of movement from one of said plurality of cards arranged on said base to another of said plurality of cards arranged on said base.

Reply Br. 8, Claims App.¹

PRIOR ART

The Examiner relies on the following evidence in rejecting the claims that are the subject of this appeal:

Eaton	US 4,854,594	Aug. 8, 1989
Bellizzi	US 5,657,992	Aug. 19, 1997
LaCivita	US 5,836,585	Nov. 17, 1998
Cuss	US 6,349,941 B1	Feb. 26, 2002

GROUND OF REJECTION

Claims 12-17, 24, and 25 stand rejected under [35 U.S.C. § 101](#) as being directed to non-statutory subject matter. Final Act. 2.

Claims 12-15, 17, and 24 stand rejected under [35 U.S.C. § 103\(a\)](#) as being unpatentable over Eaton and LaCivita. *Id.* at 3.

Claim 16 stands rejected under [35 U.S.C. § 103\(a\)](#) as being unpatentable over Eaton, LaCivita, and Bellizzi. *Id.* at 5.

Claim 25 stands rejected under [35 U.S.C. § 103\(a\)](#) as being unpatentable over Eaton, LaCivita, and Cuss. *Id.*

OPINION

Non-Statutory Subject Matter Rejection

***2** The Examiner determines that the subject matter of claims 12-17, 24, and 25 is directed to a patent-ineligible abstract idea. *See* Final Act. 2. In particular, the Examiner states that claim 12 “is a clear attempt to claim an abstract idea in the form of a new set of rules for playing a game.” *Id.* at 7. In support of this determination, the Examiner explains that “no particular machine is required to perform the claimed method steps, nor do the steps result in any transformation of a particular article.” *Id.* at 6.

In reaching the determination of patent-ineligibility, the Examiner applied the Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of *Bilski v. Kappos* (Fed. Reg. Vol. 75, No. 143/Tuesday, July 27, 2010/Notices) (hereinafter “2010 Interim Guidance”). *See* Final Act. 8. The 2010 Interim Guidance applied by the Examiner was developed before the Supreme Court issued decisions further explaining patent-eligibility under [§ 101](#) in *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289 (2012) and *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, [134 S. Ct. 2347](#) (2014). We apply the framework set forth by the Supreme Court “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice*, 134 S. Ct. at 2355 (2014) (citing *Mayo*, 132 S. Ct. at 1294 (2012)).

According to that framework, we must first determine whether the claims at issue are directed to a patent-ineligible concept. *Id.* If so, we must secondly “consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Id.* The second step of the analysis is “a search for an ‘inventive concept’ -- *i.e.*, an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Id.*

With respect to the first step of the *Alice* framework, we agree with the Examiner that claim 12 is directed to an abstract idea. *See* Final Act. 7. Claim 12, which recites “[a] method of teaching,” includes steps for arranging cards on a base to indicate a path of movement, playing a game on the base, and retaining each card in place for the duration of the game. Reply Br. 8, Claims App. We agree with the Examiner that this claim is directed to the rules for playing a type of game, and that rules for playing a game constitute an abstract idea. *See* Final Act. 7. We view a method of playing a game as being akin to the “method

of organizing human activity” that was at issue in *Alice*. 134 S. Ct. at 2356. We also note that the Manual of Patent Examining Procedure identifies “a game defined as a set of rules” as an example of a claim not directed to one of the statutory categories of patent-eligible subject matter. See MPEP § 2106 (9th ed., Mar. 2014).

***3** Having determined that claim 12 is directed to a patent-ineligible concept, we must secondly consider the elements of claim 12 individually and as an ordered combination to determine whether the additional elements of the claim transform the nature of the claim into a patent-eligible application. The Examiner's analysis under the machine-or-transformation test is germane to this second step of the *Alice* framework. See *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 716 (Fed. Cir. Nov. 14, 2014) (holding that although the machine-or-transformation test is not the sole test governing § 101 analyses, it “can provide a ‘useful clue’ in the second step of the *Alice* framework”).

The Examiner notes that claim 12 recites cards and a base, but determines that because the cards and base do not actually perform the step of arranging a plurality of cards, or of playing the game, and since the method could be performed with common game playing items (e.g. a deck of cards and a table) this is not considered the use of a particular machine to perform any step of the claimed method, nor is it a meaningful tie to a machine or apparatus.

Ans. 10. Appellants argue that the claimed method is tied to a particular apparatus insofar as it recites a base having compartments sized and shaped to receive and retain cards. See App. Br. 12-13. Appellants assert that the base cannot be any ordinary table, as the Examiner contends, because playing a game on a table would not satisfy these express limitations in claim 12. See *id.* at 13; see also Reply Br. 5 (“The method claims literally cannot occur without the physical articles described in the claims.”).

We agree with Appellants that the Examiner's analysis, in effect, inappropriately reads limitations out of claim 12. We note that the claim recites that the base includes compartments “sized and shaped to receive and *retain* each card in place for the duration of a game after said cards have been arranged in one of a plurality of different configurations.” Reply Br. 8, Claims App (emphasis added). The claim further recites “*retaining* each card in place for the duration of a game.” *Id.* Thus, contrary to the Examiner's position, the method could not be performed with a generic deck of cards and a table because playing a game on an ordinary table would not satisfy these limitations. These limitations tie the method to a base having specific structural characteristics that allow it to perform a specified function in the claimed method. Accordingly, these limitations add a degree of particularity so as to “‘transform’ the claimed abstract idea into [] patent-eligible [subject matter].” *Alice* at 2357 (quoting *Mayo* at 1298).

***4** For these reasons, we do not sustain the Examiner's decision rejecting claims 12-17, 24, and 25 under 35 U.S.C. § 101 as being directed to patent ineligible subject matter.

Obviousness Rejections

Appellants argue claims 12-15, 17, and 24 as a group. App. Br. 16. We select claim 12 as representative. See 37 C.F.R. § 41.37(c)(1)(iv) (2012). Claims 13-15, 17, and 24 stand or fall with claim 12.

The Examiner finds that Eaton teaches a method as recited in claim 12, except that Eaton does not teach “retaining each card in its place for the duration of the game.” Final Act. 3-4. The Examiner finds that LaCivita teaches a board game in which cards are placed and retained in place for the duration of a game. *Id.* at 4 (citing LaCivita, col. 2, ll. 46-49). The Examiner determines that it would be obvious to add to Eaton's board game the feature of retaining the cards in place for the duration of the game as taught by LaCivita “for the purpose of adding the feature of being able to win the cards on the board, adding a ‘trading card’ feature to the game as taught by LaCivita (background), making the game more entertaining, and more attractive to the users.” *Id.* Additionally, the Examiner determines that it would have been an obvious matter of design choice to have retained the cards in place because it is known in the art of board games to associate a space with a question card. *Id.* (referencing “Trivial

Pursuit” prior art game discussed in Background section of Eaton). The Examiner reasons that retaining board cards in place and associating them with a separate question card is not functionally different than the prior art approach. *Id.*; *see also* Ans. 12.

Appellants argue that the Examiner's stated reasons for the proposed combination are contradictory. *See* App. Br. 17. Specifically, Appellants argue that the Examiner has set forth specific purposes for adding LaCivita's card retention feature into Eaton, which contradicts the Examiner's position that the card retention feature is merely a design choice that does not serve any special purpose. *See id.* We do not find a contradiction between the Examiner's determination that it would be obvious to add LaCivita's card retention feature into Eaton for certain, specified purposes and the Examiner's separate, alternative determination that the card retention feature is an obvious matter of design choice. Appellants' argument does not apprise us of error in either of the Examiner's articulated reasons for combining the references.

Appellants also argue that the proposed combination would render Eaton unfit for its intended purpose. *See id.* at 17-18. Appellants assert that Eaton's intended purpose is to eliminate luck from gameplay, and modifying it to include LaCivita's fixed path feature would reinject luck-based play. *See id.*; Reply Br. 6. This argument is not responsive to the rejection the Examiner presented. The proposed combination incorporates from LaCivita the feature of retaining each card in its place for the duration of a game. Final Act. 3-4. The rejection says nothing about incorporating from LaCivita a fixed path feature. *See id.* Appellants do not explain why incorporating LaCivita's card retention feature, as the Examiner proposes, would be contrary to the skill-based play that Eaton seeks to achieve. Thus, this argument is also unpersuasive.

*5 For the foregoing reasons, we sustain the Examiner's obviousness rejection of claims 12-15, 17, and 24. Appellants do not present any argument against the obviousness rejections of claims 16 and 25 separate from their arguments regarding claim 12, from which claims 16 and 25 depend. App. Br. 16. Thus, we also sustain the obviousness rejections of claims 16 and 25.²

DECISION

We reverse the rejection of claims 12-17, 24, and 25 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

We affirm the rejection of claims 12-15, 17, and 24 under 35 U.S.C. § 103(a) as being unpatentable over Eaton and LaCivita.

We affirm the rejection of claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Eaton, LaCivita, and Bellizi.

We affirm the rejection of claim 25 under 35 U.S.C. § 103(a) as being unpatentable over Eaton, LaCivita, and Cuss.

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

Footnotes

- 1 The Claims Appendix in the Appeal Brief reflects amendments to Claim 12 that Appellants sought to introduce at the time of the Appeal Brief. *See* Appeal Br. 20, Claims App. The Examiner declined to enter these amendments. *See* Ans. 3. Appellants contend that the proposed amendments put the rejected claims in a better form for consideration on appeal. *See* Reply Br. 2. But the Examiner's refusal to enter the amendment after final is a petitionable matter and not within the Board's jurisdiction. 37 C.F.R. § 1.127; *In re Berger*, 279 F.3d 975, 984 (Fed. Cir. 2002). In any event, Appellants have agreed to proceed with this appeal based on the claims filed on September 22, 2011, which are the claims that were rejected in the Final Office Action mailed October 6, 2011 (hereinafter, the “Final Action”). *See* Reply Br. 2.

- 2 Appellants also argue that the Final Action was made final prematurely. *See* Appeal Br. 18-19. But as the Examiner correctly notes, a premature final rejection is a petitionable matter, and is not properly raised in an appeal to the Board. *See* Ans. 12; 37 C.F.R. 1.181; MPEP § 1002.02(c). Accordingly, we do not address Appellants' arguments regarding improper finality.
- 2015 WL 2172149 (Patent Tr. & App. Bd.)

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