

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RAY SMITH and AMANDA TEARS SMITH

Appeal 2012-009025
Application 12/912,410
Technology Center 3700

Before: CHARLES N. GREENHUT, JILL D. HILL, and
BRANDON J. WARNER, *Administrative Patent Judges*.

GREENHUT, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF CASE

This is a response to a Request for Rehearing (“Request”) of the Board’s Decision of December 5, 2014 (“Decision”). Requests for Rehearing are limited to matters overlooked or misapprehended by the Panel in rendering the original decision. *See* 37 C.F.R. § 41.52.

OPINION

Initially, we note that our rules do not provide for Appellants to request an additional oral hearing or an *en banc* rehearing. *See* Request 2.

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Appellants first contend that the claimed subject matter, which the Examiner determined to be directed to rules of a game (Decision 4), is not directed to an abstract idea. Request 6–7. However, Appellants’ arguments in this regard are nothing more than conclusory statements. Appellants do not dispute that game rules are the subject of the claims before us. Nor do Appellants provide any analysis as to why rules for game play and wager resolving differ from an algorithm, formula, or organization of human activity or behavior. The recited rules, like algorithms, dictate conditions precedent and subsequent, and like formulas, associate values with those conditions. Claims directed to an abstract idea in the form of game rules themselves preempt any future device that could be used to play the game, and thereby tend to impede innovation rather than promote it. *Contra* Request 6; *See Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S.Ct. 2347, 2354-5 (2014).

Similarly, Appellants fail to support the assertions made in consideration of the second step of the *Alice* framework. Request 8–9. Appellants do not provide any analysis as to why providing a conventional deck, or shuffling it in a conventional manner, amounts to “significantly more” under a requisite application of the *Alice* framework. Appellants are correct in that the claims do not recite a “computer.” However, Appellants do not explain why their generic recitations should not be treated similarly to that generic recitation. Appellants quote language from a recent Federal Circuit decision, *DDR Holdings, LLC v. Hotels.com*, 773 F.3d 1245, 2014 WL 6845152 (Fed. Cir. 2014), but provide no explanation as to why providing and shuffling a deck of cards should be construed, not as a “drafting effort . . .,” but as “significantly more,” similar to a recitation directed to “a specific way to automate the creation of a composite web page

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by an ‘outsource provider’ that incorporates elements from multiple sources in order to solve a problem faced by websites on the Internet.” *Id.* at ____,*12. We see no basis for similar treatment of these limitations to those involved in *DDR Holdings*. We also see no basis for analogizing the steps recited by Appellants to those of the exemplary claim in the Patent Office training materials.¹ *See* Request 16.

Whether a claim is drawn to patent-eligible subject matter under § 101 is an issue of law. In our original Decision, we provided a comprehensive legal analysis under the relevant precedents. In doing so, we did not deviate from any of the examination guidelines previously discussed. We additionally designated our affirmance of the Examiner’s rejection as a “new ground” of rejection because we shifted the focus on one particular point, from whether shuffling itself satisfies the machine-or-transformation test, to whether the recitation of shuffling constituted no more than generic extra-solution activity. As the reasons for the Office’s conclusion have been fully made of record, and Appellants have been afforded a fair opportunity to respond, we have in no way precluded Appellants from seeking review on the merits under 35 U.S.C. § 141. *Contra* Request 11.

Appellants’ request for rehearing has been granted to the extent that we have reconsidered our original decision, but has been denied to the extent that we do not modify our original decision.

DECISION

The Examiner’s rejection remains affirmed.

¹ http://www.uspto.gov/patents/law/exam/101_training_aug2012.pdf

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

DENIED

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