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EXAMINER

COLLINS, DOLORES R

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DANIEL DONN MILDER

Appeal 2018-004222
Application 14/207,507
Technology Center 3700

Before WILLIAM A. CAPP, JILL D. HILL, and
BRANDON J. WARNER, *Administrative Patent Judges*.

CAPP, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ seeks our review under 35 U.S.C. § 134 of the final rejection of claims 2–7 under 35 U.S.C. § 101 as directed to patent-ineligible subject matter, and claims 1–22 under 35 U.S.C. § 103 over Brodrick (US 8,613,449 B2, iss. Dec. 24, 2013). We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ Rainbow Dice Partnership is the Applicant and real party in interest.
Appeal Br. 1.

THE INVENTION

Appellant's invention is a wagering dice game. Spec. ¶ 1. Claim 2, reproduced below, is illustrative of the subject matter on appeal.

2. A method of playing a dice game comprising:
 - presenting a gaming table comprising a first side and a second side, said first side of said gaming table comprises:
 - a first section containing a plurality of color combinations,
 - a second section containing a plurality of color combinations wherein each combination contains one color and one blank,
 - a third section containing two blanks for colors that are the same,
 - a fourth section containing a plurality of color combinations that are less than the number of color combinations in said first section;said second side of said gaming table comprises:
 - a first section containing the same color combinations as in said first side's fourth section;
 - a second section containing a plurality of color combinations each of which comprises a combination with identical colors;
 - a third section containing a plurality of color combinations other than those in said second side's first section;
 - receiving a plurality of wagers on said first side or said second side of said gaming table;
 - presenting a set of regular, non-standard, polyhedron dice comprising a plurality of identical die, each said die having an even number of faces and each said die having different color on each of its said faces;
 - wherein said first side and said second side contain pre-determined color combinations associated with rolling said pre-determined color combinations using said set of dice and wherein said pre-determined color combinations are assigned odds for wagering on the outcome of a roll of said set of dice;
 - rolling said set of dice to expose a top face of each said die;
 - identifying colors exposed on the top face of each said die after said rolling of said set of dice; and
 - resolving wagers placed in sections of said gaming table solely based on combinations of said colors exposed on said top surface of each said die.

OPINION

35 U.S.C. § 101 – Ineligible Subject Matter

The Examiner determines that claims 2–7 are directed to the abstract idea of playing a game. Final Action 2. The Examiner further determines that any additional elements in the claims other than the abstract idea, when considered separately and in combination, are not sufficient to amount to significantly more than the abstract idea. *Id.*

Appellant argues that using a non-standard set of dice with colored indicia is sufficient to set forth an inventive concept under *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S.Ct. 2347 (2014). Appeal Br. 8–9. Appellant directs our attention to *dicta* expressed by the Federal Circuit in the case of *In re Smith*, 815 F.3d 816, 819 (Fed. Cir. 2016) that entertains the possibility that claims directed to conducting a card game using a new or original deck of cards, as opposed to a standard deck of cards, could potentially survive step two of the *Alice* analysis.² *Id.* at 9.

Appellant’s dice game is played on a game table that is similar to, but somewhat distinct from, a Craps table. Spec. ¶ 8. The “Rainbow Dice” that are used in the game have an even number of sides with a different colored symbol or geometric form on each side. *Id.* ¶ 12.

Craps and other well-known dice games are typically played with six-sided dice where each side is marked with a numbered indicia, from one to six, usually in the form of a number of dots. Unless and until we receive additional and further guidance from the Federal Circuit on Section 101 as it

² “We could envisage, for example, claims directed to conducting a game using a new or original deck of cards potentially surviving step two of *Alice*.” *Smith*, *supra* at 819.

applies to game method claims, Appellant's non-standard use of color and geometric forms in lieu of conventional number/dot indicia is sufficient to set forth an inventive concept under step two of the *Alice* analysis.³ See *Smith*, 815 F.3d at 819.

Consequently, we do not sustain the Examiner's Section 101 rejection of claims 2–7.

35 U.S.C. § 103 - Unpatentability of Claims 1–22

Claim 1

The Examiner finds that Brodrick discloses the invention substantially as claimed, except for the specific contents of printed matter on the gaming table, which the Examiner regards as non-functional printed matter that is not entitled to patentable weight. Final Action 4–7. Furthermore, the Examiner considers that differences between Brodrick and the claimed invention in terms of betting outcomes amount to nothing more than mere design choice, which would be obvious to include in the game to add excitement to game play. *Id.* 6.

Appellant argues, among other things, that Brodrick fails to disclose the color combinations and arrangements that the claimed invention employs on the face of the dice. Appeal Br. 24. Appellant differentiates between Brodrick's use of colored dots on otherwise standard numeric/dot indicia dice and the non-standard coloring scheme used on Appellant's dice. *Id.* at 25.

³ Given the diversity of subject matter that arises in Section 101 cases, particularly gaming cases, and pending further guidance from the Federal Circuit, our holding here should be limited to the specific facts of this case.

In response, the Examiner states that both Brodrick and the claimed game coordinate wagering outcomes based on indicia on the faces of the dice. Ans. 5. The Examiner treats the specific content of information displayed on the faces of the dice as non-functional descriptive matter and concludes that “there is no novel and unobvious functional relationship between the printed matter and that which is required for patentability.” *Id.* at 6.

Contrary to the Examiner’s position, there is a functional relationship between the colored indicia, the respective faces of the dice, and the outcome of playing the game. *cf In re Miller*, 418 F.2d 1392, 1396 (CCPA 1969) (finding a functional relationship between a measuring receptacle and volumetric indicia thereon). Here, the game proceeds as a function of how and when the various colored indicia appear face up after a roll of the dice.

The Examiner’s rejection is based on an erroneous finding of fact and, accordingly, we do not sustain the Section 103 rejection of claim 1.

Claims 2–22

Claims 2–22, whether independent or by virtue of dependency, each contain limitations directed to dice that have colored indicia thereon that are related to the outcome of a dice game. Claims App. Thus, the Examiner’s rejection of these claims suffers from the same infirmity that was identified above with respect to claim 1. Thus, for essentially the same reason expressed above in connection with claim 1, we do not sustain the rejection of claims 2–22.

DECISION

The decision of the Examiner to reject claims 1-22 is reversed.

REVERSED