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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/840,965	08/31/2015	Craig Lipka	12-2354-C1	4196
63710	7590	12/18/2018	EXAMINER	
INNOVATION DIVISION			RADA, ALEX P	
CANTOR FITZGERALD, L.P.				
110 EAST 59TH STREET (6TH FLOOR)			ART UNIT	
NEW YORK, NY 10022			PAPER NUMBER	
			3716	
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			12/18/2018	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary**Application No.**

14/840,965

Applicant(s)

Lipka et al.

Examiner

ALEX P RADA

Art Unit

3716

AIA Status

No

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2018.
☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims*

- 5) ☒ Claim(s) 24-45 is/are pending in the application.
5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 24-45 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement

* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

Certified copies:

- a) ☐ All b) ☐ Some** c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

** See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b)
Paper No(s)/Mail Date ____.
- 3) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 4) ☐ Other: ____.

DETAILED ACTION

Response to Amendment

In response to the amendment filed 23 October 2018 wherein applicant submits arguments and claims 24-45 are pending in this application.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 24-45 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a judicial exception (i.e., a law of nature, a natural phenomenon, or an abstract idea) without significantly more. Each of Claims 24-45 recites judicial exceptions. Each of Claims 24-45 recites a set of instructions or steps (i.e., rules) for managing a game and collecting, analyzing and transmitting game data including, for example, (receiving information about a first set of games that are based on one or more events, in which the one or more events are held at a venue, in which the first set of games are played by first players that are not located at the venue, allocating a portion of first money used to play the first set of games to a bonus pool to which players located at the venue may gain access, receiving information about a second set of games that are based on the one or more events, in which the second set of games are played by second players that are located at the venue, in which no portion of second money used to play has been analyzed to determine whether it is directed to any the second set of games is allocated to the bonus pool, based on the second players being located at the venue, allocating bonus currency to the second players, in

which the bonus currency may be used by the second players to play a bonus games that may win at least part of the bonus pool; receiving, a request to play a bonus game using the bonus currency from one of the second players, in which the request identifies a winning condition of a second event held at the venue, determining, an outcome of the bonus game, in which the one of the second players wins money from the bonus pool if the winning condition occurs in the second event, in which a respective amount of bonus currency allocated to each second player is proportional to an amount risked by each respective second game that is a winning game played by the second player, in which the bonus currency is not exchangeable for a monetary value, in which each of the first games and second games includes an wager entry into a same pari-mutuel pool) . Conducting the game as recited in Claims 24-45 are similar to the kind of “fundamental economic practices” and “idea of itself” at issue in *Alice Corp.* Although these claims are not drawn to the same subject matter, the abstract idea of managing a game is similar to the abstract ideas of rules for conducting a game (*In re Smith*), and collecting information, analyzing it and displaying certain results of the collection and analysis (*Electric Power Group*). The present claims are not limited by rules or steps that establish how the focus of the system and method is achieved. Instead, these claims embrace the abstract idea of conducting a game by collecting, displaying and transmitting game data and therefore directed to an abstract idea (Step 2A: YES).

Next, each of Claims 24-45 is analyzed to determine whether there are additional limitations recited that amount to significantly more than the abstract idea. These claims require the additional limitations of (computing device, a non-transitory medium, a network, GPS coordinates of devices). Adding these generic computer elements to perform generic functions that are well-understood, routine and conventional, such as gathering data, performing calculations, and outputting a result as evidence by *Alice Corp.*, 134 S. Ct. at 2355–56 (mere instruction to implement an abstract idea (game rules) on a computer "cannot impart patent eligibility), and *Versata Dev. Group, Inc. v. SAP Am.*

(Storing and retrieving information in memory) see MPEP (2106.05(d)(II)), does not transform the claims into eligible subject matter. Furthermore determining geographic location of an electronic mobile type device using GPS location is conventional in the art as evidenced by Aaland (US Pub. No. 2003/0036428) in paragraph 17 and Aaron (US Pub. No. 2008/0167129 in paragraph 49. Nothing in the claims, understood in light of the specification, requires anything other than off-the-shelf, conventional computer, network, and display technology for gathering, sending, and presenting the desired information. These computer components are generically claimed to enable the game to be conducted by performing the basic functions of: (i) performing repetitive calculations, (ii) receiving, processing, and storing data, (iii) electronic recordkeeping, and (iv) receiving or transmitting data over a network, e.g., using the Internet to gather data. The courts have recognized these function(s) to be well understood, routine, and conventional functions when claimed in a merely generic manner. Adding hardware that performs “well understood, routine, conventional activit[ies]’ previously known to the industry” will not make claims patent-eligible (US Pat No: 7,510,474 to Carter, col 6, lines 10-20, col 5, lines 21-35). Thus, taken alone, the additional elements do not amount to significantly more than the above-identified judicial exception (the abstract idea). Looking at the limitations as an ordered combination adds nothing that is not already present when looking at the elements taken individually. There is no indication that the combination of elements improves the functioning of a computer itself or improves any other technology. Their collective functions merely provide conventional computer implementation. Therefore the claims do not have an “inventive concept” sufficient to “transform” the claimed subject matter into a patent-eligible application of the abstract idea, especially since *Genetic Technologies Limited v. Merial LLC* (Fed Cir., 2016) held that the inventive concept cannot be supplied by the abstract idea ([t]he inventive concept necessary at step two of the *Mayo/Alice* analysis cannot be furnished by the unpatentable law of nature (or natural phenomenon or abstract idea) itself. That is, under the

Mayo/Alice framework, a claim directed to a newly discovered law of nature (or natural phenomenon or abstract idea) cannot rely on the novelty of that discovery for the inventive concept necessary for patent eligibility; instead, the application must provide something inventive, beyond mere “well-understood, routine, conventional activity.” Mayo, 132 S. Ct. at 1294; see also Myriad, 133 S. Ct. at 2117; Ariosa, 788 F.3d at 1379.).

As such, the recitation of the computer limitations in Claims 24-45 amounts to mere instructions to implement the abstract idea on a computer. Taking the additional elements individually and in combination, the computer components at each step of the game perform purely generic computer functions. More specifically, when viewed individually, the additional limitations of Claims 24-45 do not add significantly more because they are simply an attempt to limit the abstract idea to a particular technological environment. That is, the general computer elements do not add meaningful limitations to the abstract idea because these additional elements represent insignificant extra-solution activity and would be routine in any computer implementation. When viewed as a combination, the additional limitations of Claims 24-45 simply instruct the practitioner to implement the concept of managing a game with routine, conventional activity specified at a high level of generality in a particular technological environment. As such, there is no inventive concept sufficient to transform the claimed subject matter into a patent-eligible application. Because the claims simply instruct the practitioner to implement the abstract idea with routine, conventional activity, these additional claim elements, when viewed as whole, do not provide meaningful limitations to transform the abstract idea into a patent eligible application of the abstract idea such that the claims amount to significantly more than the abstract idea itself. In other words, these claims merely apply an abstract idea to a computer and do not (i) improve the performance of the computer itself (as in *McRO*, *Bascom* and *Enfish*), or (ii) provide

a technical solution to a problem in a technical field (as in DDR). Thus, none of the Claims 24-45 amounts to significantly more than the abstract idea itself (Step 2B: NO). Accordingly, Claims 24-45 are not patent eligible and rejected under 35 U.S.C. 101 as being directed to abstract ideas implemented on a generic computer in view of the Supreme Court Decision in *Alice Corporation Pty. Ltd. v. CLS Bank International, et al.*

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on nonstatutory double patenting provided the reference application or patent either is shown to be commonly owned with the examined application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. See MPEP § 717.02 for applications subject to examination

under the first inventor to file provisions of the AIA as explained in MPEP § 2159. See MPEP §§ 706.02(l)(1) - 706.02(l)(3) for applications not subject to examination under the first inventor to file provisions of the AIA. A terminal disclaimer must be signed in compliance with 37 CFR 1.321(b).

The USPTO Internet website contains terminal disclaimer forms which may be used. Please visit www.uspto.gov/patent/patents-forms. The filing date of the application in which the form is filed determines what form (e.g., PTO/SB/25, PTO/SB/26, PTO/AIA/25, or PTO/AIA/26) should be used. A web-based eTerminal Disclaimer may be filled out completely online using web-screens. An eTerminal Disclaimer that meets all requirements is auto-processed and approved immediately upon submission. For more information about eTerminal Disclaimers, refer to www.uspto.gov/patents/process/file/efs/guidance/eTD-info-I.jsp.

4. Claims 24-45 are rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 9,123,202. Although the claims at issue are not identical, they are not patentably distinct from each other because claims 1-225 of the U.S. Patent No. 9,123,202 "anticipates" claims 24-45 of application serial number 14/840965. Accordingly, claims 24-45 of Application No. 14/840965 are not patentably distinct from claims 1-22 of U.S. Patent No. 9,123,202. Here, claims 1-12 of U.S. Patent No. 9,123,202 requires elements of claim 1, a A method comprising: receiving, by a computing device, information about a first set of games that are based on one or more events, in which the one or more events are held at a venue, in which the first set of games are played by first players that are not located at the venue; based on the first players not being located at the venue, allocating, by the computing device, a portion of first money used to play the first set of games to a bonus pool to which players located at the venue may gain access; receiving, by the computing device, information about a second set of games that are based on the one or more events, in which the second set of games are played by second players that are located at the venue, in which no portion of second money used to play the second set of games is

allocated to the bonus pool; based on the second players being located at the venue, allocating, by the computing device, bonus currency to the second players, in which the bonus currency may be used by the second players to play a bonus games that may win at least part of the bonus pool; receiving, by the computing device, a request to play a bonus game using the bonus currency from one of the second players, in which the request identifies a winning condition of a second event held at the venue; and determining, by the computing device, an outcome of the bonus game, in which the one of the second players wins money from the bonus pool if the winning condition occurs in the second event; in which a respective amount of bonus currency allocated to each second player is proportional to an amount risked by each respective second game that is a winning game played by the second player, in which the bonus currency is not exchangeable for a monetary value, and in which the bonus game may not be played without using bonus currency; and claim 22, an apparatus comprising: a computing device; and a non-transitory medium having stored thereon a plurality of instructions that when executed by the computing device cause the apparatus to: receive information about a first set of games that are based on one or more events, in which the one or more events are held at a venue, in which the first set of games are played by first players that are not located at the venue; based on the first players not being located at the venue, allocate portion of first money used to play the first set of games to a bonus pool to which players located at the venue may gain access; receive information about a second set of games that are based on the one or more events, in which the second set of games are played by second players that are located at the venue, in which no portion of second money used to play the second set of games is allocated to the bonus pool; based on the second players being located at the venue, allocate bonus currency to the second players, in which the bonus currency may be used by the second players to play a bonus games that may win at least part of the bonus pool; receive a request to play a bonus game using the bonus currency from one of the second players, in which the request identifies a winning condition of a second event held

at the venue; and determine an outcome of the bonus game, in which the one of the second players wins money from the bonus pool if the winning condition occurs in the second event; in which a respective amount of bonus currency allocated to each second player is proportional to an amount risked by each respective second game that is a winning game played by the second player, in which the bonus currency is not exchangeable for a monetary value, and in which the bonus game may not be played without using bonus currency while claims 24-45 of Application No. 14/840965 only requires elements of claim 1, a method comprising: receiving, by a computing device, information about a first set of games that are based on one or more events, in which the one or more events are held at a venue, in which the first set of games are played by first players that are not located at the venue; based on the first players not being located at the venue, allocating, by the computing device, a portion of first money used to play the first set of games to a bonus pool to which players located at the venue may gain access; receiving, by the computing device, information about a second set of games that are based on the one or more events, in which the second set of games are played by second players that are located at the venue, in which no portion of second money used to play the second set of games is allocated to the bonus pool; based on the second players being located at the venue, allocating, by the computing device, bonus currency to the second players, in which the bonus currency may be used by the second players to play a bonus games that may win at least part of the bonus pool; receiving, by the computing device, a request to play a bonus game using the bonus currency from one of the second players, in which the request identifies a winning condition of a second event held at the venue; and determining, by the computing device, an outcome of the bonus game, in which the one of the second players wins money from the bonus pool if the winning condition occurs in the second event; in which a respective amount of bonus currency allocated to each second player is proportional to an amount risked by each respective second game that is a winning game played by the second player, in which the bonus currency is not exchangeable for a

monetary value, in which each of the first games and second games includes an wager entry into a same pari-mutuel pool; and claim 45, an apparatus comprising: a computing device; and a non-transitory medium having stored thereon a plurality of instructions that when executed by the computing device cause the apparatus to: receive information about a first set of games that are based on one or more events, in which the one or more events are held at a venue, in which the first set of games are played by first players that are not located at the venue; based on the first players not being located at the venue, allocate portion of first money used to play the first set of games to a bonus pool to which players located at the venue may gain access; receive information about a second set of games that are based on the one or more events, in which the second set of games are played by second players that are located at the venue, in which no portion of second money used to play the second set of games is allocated to the bonus pool; based on the second players being located at the venue, allocate bonus currency to the second players, in which the bonus currency may be used by the second players to play a bonus games that may win at least part of the bonus pool; receive a request to play a bonus game using the bonus currency from one of the second players, in which the request identifies a winning condition of a second event held at the venue; and determine an outcome of the bonus game, in which the one of the second players wins money from the bonus pool if the winning condition occurs in the second event; in which a respective amount of bonus currency allocated to each second player is proportional to an amount risked by each respective second game that is a winning game played by the second player, in which the bonus currency is not exchangeable for a monetary value, in which each of the first games and second games includes an wager entry into a same pari-mutuel pool. Thus it is apparent that the more specific claims 1-11 of U.S. Patent No. 9,123,202 encompasses claims 24-45 of Application No. 14/840965. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention,

applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Response to Arguments

5. Applicant's arguments with respect to claims 24-45 have been considered but are moot because the arguments do not apply to any of the references being used in the current rejection.
6. Applicant arguments are drawn to 35 U.S.C. 101 are answered in the rejection above.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEX P RADA whose telephone number is (571)272-4452. The examiner can normally be reached on M-F 8-5.

Examiner interviews are available via telephone, in-person, and video conferencing using a USPTO supplied web-based collaboration tool. To schedule an interview, applicant is encouraged to use the USPTO Automated Interview Request (AIR) at <http://www.uspto.gov/interviewpractice>.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on 571-272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like

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assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A.P.R./

Examiner, Art Unit 3716

/Jay Trent Liddle/

Primary Examiner, Art Unit 3716