UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT TOTH

Appeal 2009-009323
Application 11/448,394
Technology Center 3700

Decided:[1] June 15, 2009

Before MICHAEL R. FLEMING, *Chief Administrative Patent Judge,* ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judge,* and LINDA E. HORNER, ANTON W. FETTING, and JOHN A. JEFFERY, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*

DECISION ON APPEAL

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[1] The two month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Robert Toth (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-6. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

The Appellant's claimed invention is a method for a one game scratch match play, single elimination tournament. Spec. 1:5-7. Claim 1, reproduced below, is the sole independent claim and is representative of the subject matter on appeal.

> 1. A method for providing a one game scratch match play single elimination tournament for league players, comprising the steps of:
>
> a. providing a pool of eligible league players;
>
> b. setting a minimum number of games bowled in league play in order to establish an average for tournament participation;
>
> c. establishing multiple average divisions based on 10-pin or 15-pin average divisions as follows:
>
> i. 10-pin average divisions (220 or more, 219 to 210, 209 to 200, 199 to 190, 189 to 180, 179 to 170, 169 to 160, 159 to 150, 149 to 140, 139 to 130, 129 to 120, and 119 or less);

ii. 15-pin average divisions (215 or more, 214 to 200, 199 to 185, 184 to 170, 169 to 155, 154 to 140, 139 to 125, and 124 or less);

d. placing each eligible league player into one of the multiple average divisions based on their highest average from current and/or past league participation;

e. conducting a local first round of competition in which each of the eligible league players in each of the multiple divisions engages in one game scratch match play, single elimination, and/or eight player brackets in order to assure uniformity within the first round for all players, and until one player prevails in each division and continues on to a regional second round or championship round;

f. if necessary, conducting a regional second round in 512 locations that are geographically distributed in which each of the multiple divisions engages in one game scratch match play, single elimination, until one player prevails in each division and continues on to a championship round;

g. conducting a championship round in a single location in which each of the 512 league players who prevail in the regional second round in each of the multiple divisions, or the players who prevail from each city in the television tournament, engages in one game scratch match play, single elimination, until one champion prevails in each of the multiple divisions; and

h. engaging each division champion in a one game scratch match against a guest star with the winner receiving twice as much cash prize as the loser, each division champion bowling in separate

> television telecasts, wherein the number of these telecasts depends on the number of the average divisions.

THE REJECTION

The Appellant seeks review of the Examiner's rejection of claims 1-6 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.

ISSUE

The issue before us is whether the Appellant has shown the Examiner erred in concluding that the claimed method for conducting a tournament for league players is drawn to patent-ineligible subject matter under 35 U.S.C. § 101.

PRINCIPLES OF LAW

The law in the area of patent-eligible subject matter for process claims has recently been clarified by the Federal Circuit in *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008) (en banc), *cert. granted*, 77 USLW 3442 (U.S. Jun. 1, 2009) (No. 08-964).

The en banc court in *Bilski* held that "the machine-or-transformation test, properly applied, is the governing test for determining patent eligibility of a process under § 101." *Id.* at 956. The court in *Bilski* further held that "the 'useful, concrete and tangible result' inquiry is inadequate [to determine whether a claim is patent-eligible under § 101.]" *Id.* at 959-60.

The court explained the machine-or-transformation test as follows: "A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing." *Id.* at 954 (citations omitted). The court explained that "the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility" and "the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity." *Id.* at 961-62 (citations omitted). As to the transformation branch of the inquiry, the court explained that transformation of a particular article into a different state or thing "must be central to the purpose of the claimed process." *Id.*

ANALYSIS

The Appellant argues claims 1-6 as a single group. App. Br. 5-8. We select claim 1 as the representative claims, and claims 2-6 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2008).

The Examiner found that the claimed method results in no physical transformation of any materials or subject matter to a different state or thing, and there is no machine being claimed. Ans. 3-4. The Appellant argues that the claim is drawn to patent-eligible subject matter because the final result achieved, *viz*, eight tournament champions prevailing after a one game scratch match play single elimination tournament for league players, is a useful, tangible and concrete result. App. Br. 8. The Appellant's argument is unavailing because it relies on insufficient considerations and it does not

address the failure of the claim to meet the requirements of the machine-or-transformation test. *See Bilski,* 545 F.3d at 959-60 ("the 'useful, concrete and tangible result' inquiry is inadequate [to determine whether a claim is patent-eligible under § 101.]").

Method claim 1 fails to meet requirements of the machine-or-transformation test for patent-eligible subject matter, because the claimed method is neither tied to a particular machine or apparatus, nor does it transform a particular article into a different state or thing.

Method claim 1 recites a series of steps for "providing a one game scratch match play single elimination tournament for league players." The claim does not invoke any particular machine or apparatus in the method steps and thus is not tied to any particular machine or apparatus. The wording of claim 1 is broad in that it refers generally to a tournament for "league players." The claim refers tangentially in step (b) to setting a minimum number of games "bowled" in league play; however, the claim does not recite any particular machine or apparatus for conducting the rounds of competition in steps (e), (f), (g), and (h). For example, the competition could be conducted via a computer in a virtual bowling tournament or in person with an actual bowling ball and pins. The claim also refers to a "television tournament" in step (g) and "television telecasts" in step (h). The fact that the claim inferentially refers to television telecasts is not sufficient to tie the method to a particular machine or apparatus. The references in the claim to television telecasts do not impose any meaningful limits on the claimed method because the method is directed to tournament

play to determine a champion and thus the display of the actual championship play on the television is merely "insignificant extra-solution activity." *Bilski*, 545 F.3d at 961-62. The claim does not limit the method to implementation using any particular machine or apparatus. As such, the claims fail the first prong of the machine-or-transformation test.

The steps of method claim 1 also fail the second prong of the machine-or-transformation test because the method does not transform any article to a different state or thing. The method steps entail providing a pool of players, organizing the players into divisions, and then conducting various rounds of competition. The claims are similar to the claims that were before the court in *Bilski* in that the pending claims call for performing method steps that involve transformations or manipulations of relationships.[2]

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[2] The method claim in *Bilski* called for:

> A method for managing the consumption risk costs of a commodity sold by a commodity provider at a fixed price comprising the steps of:
>
> (a) initiating a series of transactions between said commodity provider and consumers of said commodity wherein said consumers purchase said commodity at a fixed rate based upon historical averages, said fixed rate corresponding to a risk position of said consumer;
>
> (b) identifying market participants for said commodity having a counter-risk position to said consumers; and
>
> (c) initiating a series of transactions between said commodity provider and said market participants at a second fixed rate such that said series of market participant transactions balances the risk position of said series of consumer transactions initiating a series of transactions

This type of manipulation of relationships between league players is the very type of abstraction that the court in *Bilski* found cannot meet the second prong of the machine-or-transformation test. 545 F.3d at 963 ("Purported transformations or manipulations simply of public or private legal obligations or relationships, business risks, or other such abstractions cannot meet the test because they are not physical objects or substances, and they are not representative of physical objects or substances.").

The method as claimed does not involve the transformation of any physical object or substance, and given that the claim also is not tied to a particular machine or apparatus, the claim entirely fails the machine-or-transformation test and is not drawn to patent-eligible subject matter under 35 U.S.C. § 101.

CONCLUSION

The Appellant has failed to show the Examiner erred in concluding that the claimed method for conducting a tournament for league players is drawn to patent-ineligible subject matter under 35 U.S.C. § 101.

DECISION

The decision of the Examiner to reject claims 1-6 is AFFIRMED.

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between said commodity provider and consumers of said commodity. 545 F.3d at 949.

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) (2007).

AFFIRMED

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CLIFFORD W. BROWNING
KRIEG DEVAULT LLP
ONE INDIANA SQUARE
SUITE 2800
INDIANAPOLIS IN 46204