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Commissioner's Decision #1616

Décision du commissaire n°1616

Date: 2022-03-24

TOPIC: J00 Meaning of Art  
J10 Computer Programs  
J30 Games

SUJET: J00 Signification de la technique  
J10 Programmes d'ordinateur  
J30 Jeux

Application No. : 2,701,658

Demande n° 2 701 658

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2,701,658 having been rejected under subsection 30(3) of the *Patent Rules* (SOR/96-423) as they read immediately before October 30, 2019, has consequently been reviewed in accordance with paragraph 199(3)(c) of the *Patent Rules* (SOR/2019-251). The recommendation of the Patent Appeal Board and the decision of the Commissioner are to refuse the application.

Applicant:

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## **INTRODUCTION**

- [1] This recommendation concerns the review of rejected Canadian patent application number 2,701,658 which is entitled “Quiz-Nested Quiz Game and System Therefore” and is owned by Robert Andrew Wasmund. The Patent Appeal Board reviewed the application pursuant to paragraph 199(3)(c) of the *Patent Rules* (SOR/2019-251). The Board’s recommendation is that the Commissioner of Patents refuse the application for the reasons given below.

## **BACKGROUND**

### The Application

- [2] The application was filed on October 3, 2008 and relates generally to a new type of nested quiz game and system for one or multiple players, with claims directed to computer-implementations. There are 58 claims on file, received in the Patent Office on August 14, 2018.

### Prosecution History

- [3] On September 5, 2018, the Examiner issued a Final Action pursuant to subsection 30(4) of the *Patent Rules*, as they read immediately before October 30, 2019. The Final Action found the application to be directed to rules for playing a quiz game and rejected the application as being directed to subject-matter that is not patentable because it does not meet the definition of invention found at section 2 of the *Patent Act*.
- [4] Mr. Wasmund submitted a Response to the Final Action, received on April 4, 2019, including a set of proposed claims. These claims are identical to those on file at the time of the Final Action, except the pages are renumbered to address a page numbering defect identified in the Final Action.
- [5] The application was forwarded to the Board for review on October 15, 2019, along with an explanation outlined in a Summary of Reasons. The Summary of Reasons stated that the claims on file were still defective, and that the proposed claims would not cure the subject-matter defect.
- [6] I reviewed the application on behalf of the Board under paragraph 199(3)(c) of

the *Patent Rules*. In a Preliminary Review letter dated January 20, 2022, I analyzed the issues with respect to the claims on file and the proposed claims. I also invited Mr. Wasmund to make oral and/or written submissions.

- [7] Mr. Wasmund submitted a written Response to the Preliminary Review letter on March 1, 2022, and a hearing was held on March 8, 2022.

## ISSUES

- [8] The Final Action's rejection was guided by a previous Patent Office practice, now superseded by "Patentable Subject-Matter under the *Patent Act*" (CIPO, November 2020) [PN2020-04]. This latest practice focuses on which elements of the claim form the "actual invention". In this analysis, I consider the issue of patentable subject-matter according to this latest practice.

- [9] There is only one major issue:

- Is the actual invention directed to patentable subject-matter according to section 2 of the *Patent Act* as analyzed according to PN2020-04?

- [10] The Final Action also noted a minor page numbering issue:

- Are the pages of the specification numbered in accordance with the *Patent Rules* subsection 50(1)?

## ANALYSIS OF THE SUBJECT-MATTER ISSUE

### Purposive Construction According to the Latest Practice

- [11] PN2020-04 discusses the application of purposive construction, pointing out that all elements set out in a claim are presumed essential unless it is established otherwise, or such presumption is contrary to the claim language.

- [12] A subject-matter analysis begins by purposively construing the claims, and purposive construction begins by defining the skilled person and the skilled person's common general knowledge. The Final Action defined these as follows:

As suggested by the applicant on page 8 of the correspondence received on 1 February 2018, the person skilled in the art is "someone skilled in electronic game design and particularly in electronic quiz or puzzle games".

The common general knowledge is demonstrated by the background of the present description and document D1, as detailed below:

- various rules exist for playing a quiz game (Description: pgs. 1 and 2; D1: abstract);
- including various clues to a word to solve the puzzle (Description: pgs. 1 and 2; D1: abstract).

Presenting a game on a gaming system comprising a processor, input device and display is also considered to represent common general knowledge in the art.

[13] The Final Action cited the following for common general knowledge:

D1: US 6,318,722 B1 Shafer November 20, 2001

[14] Mr. Wasmund did not dispute these definitions in the Response to the Final Action, the Response to the Preliminary Review letter or at the hearing, and I adopt them for this analysis, as I did in the Preliminary Review letter. In the Response to the Final Action, Mr. Wasmund questioned whether D1 constituted disqualifying prior art.

[15] D1 does not disqualify the claims on file as anticipated or obvious. The Final Action only cited D1 to demonstrate the level of common general knowledge of the skilled person in the art. The common general knowledge has a bearing on the question of what the actual invention is. In this case, it has no bearing on anticipation or obviousness, and these are not in question.

[16] Claim 1 is representative and reads:

A gaming system for playing a solve-the-phrase game that includes a plurality of trivia quiz questions, comprising: a display device generating a graphical user interface; a player input device; at least one processor; and a memory device which stores a plurality of instructions, which when executed by the at least one processor, cause the at least one processor to

operate with the display device, the memory device, and the player input device to:

a) display on the graphical user interface via the display device a solve-the-phrase puzzle including a plurality of unsolved words that form a phrase to be solved by a player, wherein the solve-the-phrase puzzle includes a correct phrase answer stored in the memory device;

b) associate via the at least one processor each of at least two unsolved words from the plurality of unsolved words of the solve-the-phrase puzzle with at least two trivia quiz questions, wherein each of the at least two trivia quiz questions associated via the at least one processor with an unsolved word has a correct trivia quiz answer;

c) receive via the player input device a trivia quiz answer input from the player for each of the at least two trivia quiz questions associated via the at least one processor with an unsolved word, for each of the at least two unsolved words from the plurality of unsolved words of the solve-the-phrase puzzle;

d) determine via the at least one processor if the player's trivia quiz answer input for each of the at least two trivia quiz questions associated via the at least one processor with an unsolved word matches the correct trivia quiz answer, for each of the at least two unsolved words from the plurality of unsolved words of the solve-the-phrase puzzle;

e) display on the graphical user interface via the display device the correct trivia quiz answer for each of the at least two trivia quiz questions associated via the at least one processor with an unsolved word when it is determined via the at least one processor if the player's trivia quiz answer input matches the correct trivia quiz answer at a location on the graphical user interface proximate to the unsolved word that is associated with the at least two trivia quiz questions; and also improve a game score for a correct trivia quiz answer input and/or worsen the game score for an incorrect trivia quiz answer input, for each of the at least two unsolved words from the plurality of unsolved words of the solve-the-phrase puzzle, wherein each correct trivia quiz answer provides a word clue to one of the at least two unsolved words from the plurality of unsolved words of the solve-the-phrase puzzle;

f) receive via the player input device a solve-the-phrase answer input that includes unsolved word answer inputs for the

at least two unsolved words from the plurality of unsolved words of the solve-the-phrase puzzle from the player to complete the solve-the-phrase puzzle;

g) determine via the at least one processor if the player's solve-the-phrase answer input matches the correct phrase answer, and when the player's solve-the-phrase answer input matches the correct phrase answer, display on the graphical user interface via the display device that the player's solve-the-phrase answer input is correct and display on the graphical user interface via the display device the game score.

- [17] As I wrote in the Preliminary Review letter, in my view, all elements recited in the claim are essential, including the computer system components. The skilled person would understand that there is no use of language indicating that any of the elements are optional or one of a list of alternatives. Similarly, all elements recited in the other claims are considered to be essential. However, under *PN2020-04*, physical computer components being considered essential elements does not necessarily mean that they are part of a single “actual invention”. This aspect is discussed below.

#### Is the Actual Invention Directed to Patentable Subject Matter?

- [18] The definition of invention is set out in section 2 of the *Patent Act*:

***invention*** means any new and useful art, process, machine, manufacture or composition of matter, or any new and useful improvement in any art, process, machine, manufacture or composition of matter.

- [19] *Canada (Attorney General) v Amazon.com Inc*, 2011 FCA 328 [*Amazon.com*] at para 66 notes the requirement for patentable subject-matter to possess physicality: “...it is implicit in the definition of “invention” that patentable subject matter must be something with physical existence, or something that manifests a discernible effect or change”.
- [20] *PN2020-04* describes the Patent Office’s approach to determining if a claim is patentable subject-matter:

To be both patentable subject-matter and not be prohibited under subsection 27(8) of the *Patent Act*, the subject-matter



defined by a claim must be limited to or narrower than an actual invention that either has physical existence or manifests a discernible physical effect or change and that relates to the manual or productive arts, meaning those arts involving or concerned with applied and industrial sciences as distinguished in particular from the fine arts or works of art that are inventive only in an artistic or aesthetic sense.

- [21] *PN2020-04* further describes the Patent Office's approach to determining if a computer-related invention is patentable subject-matter. For example, the mere fact that a computer is among the essential elements of the claimed invention does not necessarily mean that the claimed invention is patentable subject-matter. An algorithm itself is abstract and unpatentable subject-matter. A computer programmed to merely process the algorithm in a well-known manner without solving any problem in the functioning of the computer will not make it patentable subject-matter because the computer and the algorithm do not form part of a single actual invention that solves a problem related to the manual or productive arts. On the other hand, if processing the algorithm improves the functionality of the computer, then the computer and the algorithm would together form a single actual invention that solves a problem related to the manual or productive arts and the subject-matter defined by the claim would be patentable.
- [22] In *Schlumberger Canada Ltd v Commissioner of Patents*, [1982] 1 FC 845 (CA) [*Schlumberger*], the court concluded that, although computers were necessary for the invention to be put into practice, the computer did not form part of "what has been discovered" and thus was not relevant in determining whether the claimed invention was patentable subject-matter; the computer was merely being used to make the kind of calculations it was invented to make.
- [23] This leads to the heart of the issue. As I wrote in the Preliminary Review letter, in my view, the actual invention of representative claim 1 is a set of abstract rules and an algorithm for a nested quiz game, because, while computer components are essential elements of the claim, the computer components are not part of the actual invention. The situation is similar to that of *Schlumberger* in that the computer is merely processing certain input according to certain rules as computers are designed to normally do, and displaying an output. There is no improvement to the functionality of the computer; that is, no discernible

physical effect on the computer. Absent the computer components, there is no physical component or discernible physical effect produced. The output is of intellectual significance only and has no physicality.

- [24] Similarly, the actual invention of all the other claims on file is a set of abstract rules for nested quiz games.
- [25] In the Response to the Final Action, Mr. Wasmund argued with respect to the previous Patent Office practice. These aspects of the argument are now moot, as the practice has changed, and the Patent Appeal Board must follow the new practice.
- [26] In the Response to the Preliminary Review and at the hearing, Mr. Wasmund asserted that the computer cooperates with the algorithm for implementing the new game and that the novelty of the game shows that the computer is not used in a well-known manner. Mr. Wasmund submitted that the new game constituted an improvement to the computer, and that the game could not be implemented without a computer as it would otherwise proceed too slowly.
- [27] In my view, the new game is an improvement to the art of games, but not an improvement to the art of computing. This distinction is important. Mr. Wasmund stated at the hearing that he could not see why *PN2020-04* would be interpreted as excluding his invention, as the computer system programmed to implement the new game was, in his view, an improvement and would seem to be patentable subject matter. I note that the computer in this case processes certain input (quiz answers) according to certain rules and stored data, and produces a displayed output, such as a score. The skilled person would view these operations as normal for a computer, even though the specific rules and stored data (the game) are new. The description on file describes the computer implementation in generality, with some discussion of an implementation using Java and an SQL database (pages 24-25). I see no evidence that the algorithm for implementing the game, at the level of technical specificity claimed, improves the physical computer in discernible aspects such as speed or required memory.
- [28] With respect to the argument that the game would proceed too slowly without a computer implementation, *PN2020-04* notes “the fact that a computer is

necessary to put a disembodied idea, scientific principle or abstract theorem into practice does not necessarily mean that there is patentable subject-matter even if the computer cooperates together with other elements of the claimed invention.”

- [29] A manner of playing a game is considered non-statutory (see Manual of Patent Office Practice (CIPO) at §17.03.09, revised November 2017 [*MOPOP*]). This is so because games are not considered to belong to the manual and productive arts, and *PN2020-04* requires patentable subject matter to be directed to a single actual invention that solves a problem related to the manual or productive arts.
- [30] In the Response to the Final Action, Mr. Wasmund argued that with respect to *MOPOP* §12.03.09 (now §17.03.09) the invention “would be more appropriately classified as a tool made use of in the playing of a game”.
- [31] As I wrote in the Preliminary Review letter, I respectfully disagree. According to the above analysis, the computer (the tool) is not part of the actual invention. The actual invention is rules for games, and therefore the prohibition of *MOPOP* §17.03.09 applies.
- [32] In the Response to the Final Action, Mr. Wasmund cited a number of Commissioner’s Decisions. While each case is decided based on its own circumstances, in general, I note that all of the cited cases precede *PN2020-04*, and in all the cited cases, the conclusions were that the subject-matter was non-patentable.
- [33] Mr. Wasmund also cited *Progressive Games, Inc v Canada* (Commissioner of Patents), 2000 CanLII 16577 (FCA). I note that the Court found the subject-matter of that patent application non-patentable.
- [34] Mr. Wasmund further cited *Amazon.com*. *PN2020-04* factors in the Court’s guidance in *Amazon.com*, and my analysis has followed *PN2020-04*.
- [35] Therefore, in my view, the claims on file are not directed to patentable subject-matter according to section 2 of the *Patent Act*.

## **THE PROPOSED CLAIMS ADDRESS ONLY THE PAGE NUMBERING ISSUE**

[36] Subsection 50(1) of the *Patent Rules* states:

The pages of the specification must be numbered consecutively.

[37] As I wrote in the Preliminary Review letter, the claim pages on file do not follow this rule, because the term “specification” refers to the description and claims as a whole. The claim pages on file are numbered 2 (of 48) to 47 (of 48), whereas the last page of the description on file is numbered page 78.

[38] This issue is not in dispute. With the Response to the Final Action, Mr. Wasmund submitted a set of proposed claim pages numbered beginning from page 79. The proposed claim pages would successfully address the page numbering issue.

[39] The claims themselves were not changed. I do not consider these proposed claim pages to constitute necessary amendments to put the application in condition for allowance according to subsection 86(11) of the *Patent Rules*. While the proposed claim pages would successfully remedy the page numbering issue, they would not remedy the subject-matter issue.

## RECOMMENDATION OF THE BOARD

[40] I recommend that the Commissioner of Patents refuse to issue a patent for this application on the grounds that:

- the claims on file are directed to non-patentable subject-matter and are therefore non-compliant with section 2 of the *Patent Act*; and
- the claim pages on file are not numbered in accordance with subsection 50(1) of the *Patent Rules*.

[41] The proposed claims do not cure the primary subject-matter defect and therefore do not constitute “necessary amendments” according to subsection 86(11) of the *Patent Act*.

Howard Sandler  
Member

## DECISION OF THE COMMISSIONER

[42] I concur with the recommendation of the Board that the application be refused on the grounds that:

- the claims on file are directed to non-patentable subject-matter and are therefore non-compliant with section 2 of the *Patent Act*; and
- the claim pages on file are not numbered in accordance with subsection 50(1) of the *Patent Rules*.

[43] Therefore, in accordance with section 40 of the *Patent Act*, I refuse to grant a patent on this application. Under section 41 of the *Patent Act*, the Applicant has six months within which to appeal my decision to the Federal Court of Canada.

Virginie Ethier  
Assistant Commissioner of Patents

Dated at Gatineau, Quebec

this 24<sup>th</sup> day of March, 2022