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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID B. SCHULTZ

Appeal 2011-000040
Application 11/077,611
Technology Center 3700

Before: WILLIAM V. SAINDON, SCOTT A. DANIELS, and JILL D. HILL, *Administrative Patent Judges*.

DANIELS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from a rejection of claims 1, 2, and 5-24. Claims 1, 14, 23 and 24 are the independent claims, claims 3 and 4 are canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

THE INVENTION

The claims are directed to a gaming machine, for example a slot machine, having a standard pay table defining a payout for certain winning symbol combinations, and also for example in a bonus game, a transposed pay table defining a different, “inverted” payout for the same symbol combinations. Claim 14, reproduced below, is illustrative of the claimed subject matter:

14. A gaming device, comprising:
 - a plurality of reels having symbols thereon; a first pay table designating winning combinations of the symbols and corresponding payout values; and
 - a second pay table designating winning combinations of the symbols and corresponding payout values, wherein the winning combinations of symbols designated in the second pay table are in the same order as the winning combinations of symbols designated in the first pay table, and payout values of winning combinations in the second pay table are inverted as compared to the payout values for the winning combinations in the first pay table, such that the payout values from top to bottom of the second pay table are in reverse numerical order as compared to the payout values from top to bottom of the first pay table.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

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Dickenson	US 5,251,898	Oct. 12, 1993
Lemay	US 6,802,778	Oct. 12, 2004
Hirota	US 6,824,466	Nov. 30, 2004

REJECTIONS

The Examiner made the following rejections:

Claims 1, 2, 5-8, 13-17, 20, 23 and 24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hirota and Lemay.¹ Ans. 4.

Claims 18 and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hirota, Lemay and Admitted Prior Art. Ans. 8.

Claims 21 and 22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hirota, Lemay and Dickenson. Ans. 9.

ANALYSIS

Appellant argues claims 14-17 and 20 as a group, where claim 14 is the independent claim, and presents separate arguments as to independent claim 23 and dependent claims 18-19 and 21-22.² *See* App. Br. 7-8. We initially select claim 14 as representative of the group where claims 15-17 and 20 stand or fall with claim 14, and address the remaining claims in turn. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2011).

¹ Appellant does not contest the Examiner's rejection of claims 1, 2, 5-13 and 24. Accordingly, we summarily sustain the rejection of these claims. Upon return of jurisdiction of this application to the Examiner, the Examiner should consider canceling these claims. *See Ex parte Ghuman*, 88 USPQ2d 1478 (BPAI 2008) (per curiam).

² Appellant indicates that claims 15-22 stand or fall with claim 14, however since the rejections of claims 18-19 and 21-22 are based on Hirota, Lemay and Admitted Prior Art, and Hirota, Lemay and Dickenson respectively, we address these rejections separately.

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Claims 14-17 and 20 as unpatentable over Hirota and Lemay.

Appellant's invention relates to a gaming device such as a slot machine where a number of rotating symbol bearing reels (12, 14, 16) are stopped to reveal to the game player a row, or rows, of randomly (or potentially not randomly) determined symbols in a display window. *See* Spec. 1, ll. 12-18 and fig. 2. Depending upon the mode of the device and the symbols in the displayed row, a pay table (52) determines a standard payout, or, for example in a bonus game mode, a transposed pay table (54) determines a bonus payout. Spec. 3, ll. 8-9.

Appellant's claim 14 recites a gaming device having "a first pay table" and "a second pay table"

wherein the winning combinations of symbols designated in the second pay table are in the same order as the winning combinations of symbols designated in the first pay table, and payout values of winning combinations in the second pay table *are inverted* as compared to the payout values for the winning combinations in the first pay table, *such that the payout values from top to bottom of the second pay table are in reverse numerical order as compared to the payout values from top to bottom of the first pay table.*

App. Br. Clms. Appx. (emphasis added.) The Examiner found that Hirota discloses all the elements of claim 14 except for where the "payout values of winning combinations in the second pay table are inverted as compared to the payout values for the winning combinations in the first pay table" and that "the payout values from top to bottom of the second pay table are in reverse numerical order as compared to the payout values from top to bottom of the first pay table." Ans. 5. The Examiner turned to Lemay for the teaching of a gaming apparatus and method with operator-configurable pay tables and reasoned that "even a person of less than ordinary skill in the

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art at the time of invention could have defined a pay table in any manner he wished, which logically includes modifying a pay table such that the symbol combinations and/or payout values are inverted.” Ans. 6.

Appellant disputes that Lemay teaches the specific order, i.e., “inverting” the payout values between the first and second table that is recited in claim 14. Appellant argues that

[f]irst and second pay tables with the structure and limitations recited in claims 14 (and 23) are part of a set of an infinite number of approaches that can be taken to improving gaming machine paytables. There is *no* reasonable suggestion in Lemay which would lead a person, regardless of their level of skill, to create the claimed ordering, even if it would be possible to do so using the invention of Lemay.

App. Br. 5-6. Appellant further argues that the Examiner’s reasoning is based on hindsight because Lemay does not teach the claimed order of the payout values as recited in claim 14 and the only place such disclosure is found is in Appellant’s Specification. App. Br. 6-7.

Appellant seeks to increase player excitement and engagement by providing a second “bonus” payout table, which has different, i.e., “inverted” payout values in reverse numerical order from the standard pay table. Spec. 3, ll. 8-16. Appellant’s Specification explains this “inverted” payout at page 4, lines 11-15:

when the bonus game is triggered, those symbol combinations that resulted in the lowest payouts on the standard pay table have the highest payouts in the transposed pay table. Correspondingly, those symbol combinations having the highest payouts on the standard pay table have the lowest payouts in the transposed pay table.

We acknowledge that bonus game play and alternative payout values may increase a players engagement and excitement in a game of chance, such as in slot machine play, but what we cannot determine, and Appellant does not

point out, is any indication that the specific claimed “inverted” order of the payout table values defines a new and nonobvious functional relationship. To put it another way, no matter which combinations of arbitrary symbols are mapped to the various arbitrary values of the pay table, the correlation between symbols and specific pay table values does not define a new and unobvious functional relationship between the printed matter and the substrate; the machine still awards payouts according to a defined schedule and represents the results by way of those symbols, as is known in the art. For example, that “7-7-7” can represent both the highest reward and the lowest reward is ample indication that the symbols and pay table value relationship “in no way depends on the [gaming machine], and the [gaming machine] does not depend on the [symbols and pay table value relationship].” *In re Ngai*, 367, F.3d 1336, 1339 (Fed. Cir. 2004); *see also In re Xiao*, 462 Fed. Appx. 947, 949 (Fed. Cir. 2011) (nonprecedential) (“The claimed lock’s function turns solely on the physical alignment among tumbler rings, regardless of what may be printed at each position or how an individual user subjectively perceives any particular position label.”).³ Therefore, we initially sustain the rejection of claims 14-17 and 20 because the printed matter which defines the relationship for the inverted order of the payout as recited in Appellant’s claim 14 and which is relied upon by Appellant for purposes of patentability does not set forth a “new and unobvious functional relationship” with the underlying gaming machine. *In re Gulack*, 703 F.2d 1381, 1386 (Fed. Cir. 1983).

³ Indeed, in one embodiment of Appellant’s invention, the “pay tables” are mere signage displayed on the side of the machine (*see, e.g.*, fig. 2, items 52, 54) rather than lookup tables relied upon by a computer (*see, e.g.*, fig. 1, items 36, 40).

Addressing Appellant's assertion that Lemay would not lead a person of any (either ordinary or otherwise) skill in the art to create the claimed ordering and that the Examiner has used impermissible hindsight using elements and teaching found only in Appellant's disclosure to support this finding, we note that the Examiner is not using Lemay to teach or suggest the specifically claimed "inverted" ordering but only to show that payout tables for slot machines, or other games of chance, may be easily changed to any desired payout value(s) by persons of (less than) ordinary skill in the art of programming or probability theory. Ans. 5-6. We agree that the specific inverted values in the pay tables are obvious for the reasons explained by the Examiner. Hirota shows at Figure 6 that pay tables are known in the art, and Lemay teaches that one of ordinary skill in the art of slot machine payable design, i.e., a casino operator, can logically set any desired payout, including inverted payouts, for any combination of reel symbols that the operator wishes. *See, e.g.*, Ans. 17 ("particular values lack criticality in the invention and are a matter of obvious design choice"). Moreover, that the operator chooses any combination of the essentially infinite number of arbitrary symbols to represent payout values is merely a matter of design choice. *See Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1328 (Fed. Cir. 2009) ("it was proper for a patent examiner to rely on 'common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.'") (citing *In re Bozek*, 416 F.2d 1385, 1390 (CCPA 1969)). We also agree that a casino operator "would know how to design a pay table to maintain a desired level of payouts and profitability." Ans. 6. Thus, absent evidence or technical reasoning to the contrary, we see no reason why a casino operator would not consider it obvious to design paytables with inverted payout values. The

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Examiner has provided an articulated reasoning with rational underpinnings which is applicable here and, thus we sustain the Examiner's rejection of claims 14-17 and 20 in view of Hirota and Lemay.

Claims 18, 19, and 21-23 as unpatentable over Hirota, Lemay and either Admitted Prior Art, or Dickenson.

Appellant has provided no further arguments for the rejection of independent claim 23 in view of Hirota and Lemay, nor the rejections of claims 18, 19, 21 and 22 under 35 U.S.C. § 103(a) as unpatentable over Hirota, Lemay and either the Admitted Prior Art, or Dickenson. App. Br. 7-8. Appellant merely relies on the arguments presented for the Examiner's rejection of claim 14 for these grounds of rejection. Thus, for the same reasons we have sustained the rejection of claim 14, we likewise sustain the rejections of claims 18, 19, and 21-23 under 35 U.S.C. § 103(a) as unpatentable over Hirota, Lemay, and either the Admitted Prior Art, or Dickenson.

DECISION

For the above reasons, the Examiner's rejections of claims 1, 2 and 5-24 are AFFIRMED.

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

AFFIRMED

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