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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KAZUO OKADA

Appeal 2011-004252
Application 11/734,829
Technology Center 3700

Before LINDA E. HORNER, SCOTT A. DANIELS, and
BART A. GERSTENBLITH, *Administrative Patent Judges*.

GERSTENBLITH, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Kazuo Okada (“Appellant”) appeals under 35 U.S.C. § 134 from the Examiner’s decision rejecting claims 1-7. We have jurisdiction under 35 U.S.C. § 6(b).

The Claimed Subject Matter

Claims 1 is illustrative of the claimed subject matter and is reproduced below.

1. A slot machine comprising:

a symbol display device capable of variably displaying a plurality of symbols;

an image display device; and

a controller,

said controller programmed to execute,

(A) executing a game in which said plurality of symbols are variably displayed and then stop-displayed to said symbol display device after game media are BET in number equal to or less than a previously set maximum number of BETs, and game media are paid out in number according to said plurality of symbols stop-displayed or a combination thereof;

(B) displaying to said image display device a normal payment image showing that game media paid out in said processing (A) are paid out in number according to said plurality of symbols or a combination thereof during a period when game media are paid out in said processing (A);

(C) shifting a mode from a non-insurance mode to an insurance mode on condition that a predetermined number of game media is inserted;

(D) counting the number of games played after shifting to said insurance mode, in said insurance mode;

(E) paying out a predetermined number of game media when the number of games counted in said processing (D) reaches a specific number; and

(F) displaying to the image display device a specific payment image showing that a payment paid out in said processing (E) is a payment based on the number of games reaching the specific number during a period when game media are paid out in said processing (E).

References

The Examiner relies upon the following prior art references:

Okada	US 5,178,390	Jan. 12, 1993
McGinnis	US 6,120,377	Sept. 19, 2000
Walker	US 2003/0228901 A1	Dec. 11, 2003

Rejections

The Examiner makes the following rejections:

- I. Claims 1-3 and 5-7 are rejected under 35 U.S.C. § 103(a) as unpatentable over Okada and Walker; and
- II. Claim 4 is rejected under 35 U.S.C. § 103(a) as unpatentable over Okada, Walker, and McGinnis.

SUMMARY OF DECISION

We AFFIRM.

OPINION

Rejection I – Okada and Walker

The Examiner determined that Okada and Walker render obvious the subject matter of claims 1-3 and 5-7. Ans. 3-6. The Examiner found that Okada discloses most of the limitations of the claims, but “does not explicitly disclose an image display device that can show normal and specific images.” Ans. 4. The Examiner thus relied upon Walker as teach[ing] an image display device that displays a normal payment image showing that game media are paid out in

number according to said plurality of symbols or a combination thereof during a period when game media are paid out (fig. 5); and displaying to said image display device a specific payment image showing that a payment based on a specific event is being processed (fig. 4; [0161], [0214]-[0215[]]).

Id. The Examiner concluded that it would have been obvious to one of ordinary skill in the art at the time of invention “to combine the insurance game of Okada with the image display of Walker in order to provide greater entertainment for the player, thus encouraging the player to remain at the gaming machine for a longer period of time.” *Id.* at 6.

Appellant raises several contentions.¹ First, Appellant asserts that “[n]o explanation is provided of why it would have been obvious to combine Walker with Okada or how the combined teachings of the references meet all of the limitations of Claim 1.” App. Br. 7.

Second, Appellant contends that there is no teaching or suggestion in Walker of “a specific payment image showing that a payment paid out . . . is a payment based on the number of games reaching the specific number” *Id.* at 8. Rather, Walker’s display “is based on time, not number of games played.” Reply Br. 3. Thus, Appellant asserts that “providing an image based on a payment as taught by Walker in the slot machine of Okada does not produce the claimed invention,” App. Br. 8, and there is “no suggestion in Walker for the proposed modification,” Reply Br. 3. According to Appellant:

¹ Appellant has not separately argued claims 2, 3, and 5-7. *See* App. Br. 6 (“Claim 1 is discussed as representative of the claims in this ground of rejection.”) Thus, claims 2, 3, and 5-7 stand or fall with claim 1 from which they depend. 37 C.F.R. § 41.37(c)(1)(vii) (2011); *e.g.*, *In re Lovin*, 652 F.3d 1349, 1351 (Fed. Cir. 2011).

[w]hat is missing is some reasoning, based on evidence in the prior art or knowledge within the level of ordinary skill in the art, why one of ordinary skill in the art would have been motivated to modify Okada to provide a specific payment image when a payment is based on the count of the number of games reaching a specific number in the insurance mode in view of the teaching of providing a display based on a payment in Walker.

App. Br. 8.

Third, Appellant contends that a general teaching “of providing a display upon occurrence of a payment in Walker, does not provide motivation for the specific modification of Okada necessary to arrive at the claimed invention.” *Id.* at 8-9. In particular, Appellant asserts that he

recognized the problem in the prior art that players often were not aware that a payment was a return for reaching a certain number of games in an insurance mode, as opposed to a payment based on a winning combination of symbols, and therefore erroneously believed ‘that more than a proper number of game media have been paid’ . . . to reach the insurance payout.

Id. at 9 (quoting Spec. at 50). Appellant contends that because there is “no indication in Okada or Walker that this problem about payouts was a known problem in the gaming art . . . [i]t is improper to assume that the problem was known in determining whether Appellant’s providing of a specific payment image was an obvious solution to the problem.” *Id.* (citing *In re Spinnoble*, 405 F.2d 578, 585 (CCPA 1969)).

Finally, Appellant asserts that the Examiner’s stated rationale for why it would have been obvious to one of ordinary skill in the art to combine the references—“to provide greater entertainment for the player”—does not provide “clear and particular” evidence for the combination. *See Reply Br.*

2-3 (citing *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999)). Thus, Appellant asserts that the rejection fails to establish a prima facie case of obviousness.

We address each of Appellant's arguments. First, as noted above, the Examiner determined that it would have been obvious to one of ordinary skill in the art at the time of invention to combine the insurance game of Okada with the image display of Walker "to provide greater entertainment for the player, thus encouraging the payer to remain at the gaming machine for a longer period of time." Ans. 6. Thus, contrary to Appellant's first contention, the Examiner provided an explanation of why it would have been obvious to combine the teachings of Walker with those of Okada.

Second, the Examiner relied on Okada, not Walker, as disclosing counting the number of games played after shifting to an insurance mode. *See* Ans. 4. The Examiner's reliance on Walker was specific to Walker's disclosure of an image display device that can show "normal and specific images." *Id.* As such the failure of one reference to disclose each and every element of the claims is inapposite where a second reference discloses the missing element(s). *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981) ("one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references"); *see also In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (same); *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991) ("The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art."). The Examiner noted that the combination of the specific payment image of Walker with the insurance game of Okada "would yield . . . the predictable results of a specific payment image

showing up when the insurance payment is paid. Much the same as the specific payment image showing up when a guaranteed payment is paid.” *Id.* at 8 (citing Walker, para. [0215]). Further, as explained above, the Examiner provided a specific reason as to why one of ordinary skill in the art at the time of invention would have been motivated to combine these disclosures.

Third, we recognize that the Specification supports Appellant’s argument that Appellant recognized a problem in the prior art—namely, confusion with respect to when game media were paid based on a winning combination of symbols as compared to reaching a certain number of games played in an insurance mode, App. Br. 9—and proposed a solution that seeks to accomplish an object of the invention to “allow[] a player to have sufficient trust on [sic] the slot.” Spec. at 2, ll. 34-35. Appellant, however, has not presented evidence that one of ordinary skill in the art would not have recognized the true cause of the alleged problem or that there was any confusion or doubt at the time of invention as to the cause of player confusion, even assuming such confusion in fact existed. *See In re Spinnoble*, 405 F.2d 578, 586 (CCPA 1969) (indicating that appellant “discovered the cause of the moisture transmission to be the passage of moisture through, rather than around, the center plug” and that the “crux of the matter in this case is the discovery by appellant that passage through the center plug was a major cause of moisture transmission”); *see also Cross Medical Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1323 (Fed. Cir. 2005) (noting that in *Spinnoble*, “those of ordinary skill in the art . . . recognized a moisture-transfer problem . . . [but] believed that moisture was transmitted *around* the plug . . . [whereas] *Spinnoble*

discovered that moisture traveled *through* the plug”). Thus, Appellant has not presented sufficient evidence to persuade us that the facts of this case are analogous to those of *In re Spinnoble*.

Furthermore, we agree with the Examiner that the inquiry into whether an alleged invention would have been obvious to one of ordinary skill in the art at the time of invention is not limited “only to the problem the patentee was trying to solve.” Ans. 8 (quoting *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 420 (2007)). Rather, “[u]nder the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *KSR*, 550 U.S. at 420. As explained above, the Examiner found that “providing a specific image as mentioned by Walker provides further entertainment value to the game, which not only makes the game more enticing [to] the player, but also . . . encourage[s] potential players to play the game as they see others winning a prize that is not based on the symbols that are currently being displayed.” Ans. 8. Thus, the Examiner recognized the need to entice and encourage individuals to pay the game.

Importantly, the Examiner also found that Walker supports the stated rationale for the proposed combination because Walker specifically discloses that “the gaming device may do anything to attract attention, to bring recognition upon the player receiving the payment, to generate good feeling, etc.” *Id.* at 9 (quoting Walker, para. [0215]). We agree that Walker supports the Examiner’s rationale as to why one of ordinary skill in the art at the time of invention would have been prompted to combine the specific payment image of Walker with the insurance game of Okada.

Finally, in the context of the gaming industry, where the industry has a substantial interest in encouraging more people to play, play longer, and bet the maximum bet, *see, e.g.*, Ans. 9, the Examiner's stated rationale for why it would have been obvious to one of ordinary skill in the art to combine the references provides sufficiently clear and particular evidence for the combination.

Accordingly, since Appellant has not persuaded us of error with respect to the Examiner's findings and determination of obviousness, we sustain Rejection I.

Rejection II – Okada, Walker, and McGinnis

The Examiner concluded that Okada, Walker, and McGinnis render obvious the subject matter of claim 4. Ans. 6. The Examiner found that while Okada discloses counting the number of games played, *id.* (citing Okada, col. 6, ll. 4-9), it “does not explicitly disclose recognition of a maximum bet,” *id.* The Examiner, however, found that McGinnis “discloses the machine recognition of a maximum number of bet.” *Id.* (citing McGinnis, col. 5, ll. 16-23). The Examiner determined that it would have been obvious to one of ordinary skill in the art at the time of invention to “combine the game counting in insurance mode as disclosed by Okada with the recognition of maximum bets as taught by McGinnis in order to encourage game players to always bet the maximum number and thus increase the profitability of the gaming machine.” *Id.* Thus, to “maximize each bet and . . . increase the profitability of the gaming machine,” the Examiner determined that it would have been obvious to one of ordinary skill in the art to “combine the insurance game as disclosed by Okada with the maximum bet feature as taught by McGinnis.” *Id.*

Appellant acknowledges that Okada teaches that the number of games can be counted and that McGinnis describes placing a bet from one to a maximum of five credits. App. Br. 10. Appellant contends, however, that Okada does not “teach or suggest that the insurance premium is a BET, nor does it suggest counting the number of games only when the maximum number of game media are BET,” and McGinnis “says nothing about counting the number of games when a maximum bet is placed.” *Id.* Appellant thus asserts that “[t]he error is that there is no teaching or suggestion in McGinnis or Okada or Walker of counting only the number of games in which the maximum number of game media are BET” and that “it is not sufficient that some rationale can be invented for making a modification without some factual evidence to back up that rationale.” *Id.* at 11.

Appellant’s argument suffers from the same deficiency previous noted by arguing the references individually. The Examiner does not contend that any one reference discloses counting only the number of games in which the maximum bet is placed. Rather, the Examiner found that Okada discloses counting the number of games and McGinnis discloses recognition of a maximum bet. Ans. 6; *see In re Keller*, 642 F.2d at 426. Thus, the Examiner determined that it would have been obvious to one of ordinary skill in the art to count the number of games in which a maximum bet is placed. *Id.* Contrary to Appellant’s contention, the Examiner’s determination of obviousness is factually supported by the prior art and a reasoned rationale as to why one of ordinary skill in the art would have been prompted, by seeking to encourage a player to bet the maximum bet on a

Appeal 2011-004252
Application 11/734,829

gaming machine, to combine these specific features of the references.² *See, e.g.,* Ans. 9.

Accordingly, because Appellant has not persuaded us of error with respect to the Examiner's findings and determination of obviousness, we sustain Rejection II.

DECISION

We affirm the Examiner's decision rejecting claims 1-7.

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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² Further, while claim 4 requires counting the number of games in which a maximum bet is placed after shifting to insurance mode, there is no restriction precluding the processing (D) from separately counting the total number of games played or the number of other games played.