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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TIMOTHY C. LOOSE and WAYNE H. ROTHSCHILD

Appeal 2014-001869
Application 12/357,078
Technology Center 3700

Before EDWARD A. BROWN, BRANDON J. WARNER, and
LEE L. STEPINA, *Administrative Patent Judges*.

WARNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Timothy C. Loose and Wayne H. Rothschild (“Appellants”) appeal under 35 U.S.C. § 134(a) from the Examiner’s decision rejecting claims 94–98, 100–105, 107–110, 112, 113, and 124–130, which are all the pending claims.¹ *See* Appeal Br. 1, 2. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We REVERSE.

¹ According to Appellants, the real party in interest is WMS Gaming, Inc. Appeal Br. 1.

CLAIMED SUBJECT MATTER

Appellants' disclosed invention "relates generally to gaming machines and, more particularly, to a gaming machine with a video image superimposed over a primary display of the machine." Spec., p. 1, ll. 4–5. Claims 94, 100, 108, and 126 are independent. Claim 100, reproduced below with emphasis added, is illustrative of the subject matter on appeal.

100. A gaming machine for playing one or more wagering games comprising:

a plurality of mechanical reels operable to display a plurality of symbols for indicating an outcome of a wagering game; and

a transmissive display operable to display images spaced away from and overlaying the plurality of mechanical reels, the transmissive display being operable to be transparent during a first play of the wagering game so as to permit clear viewing of the plurality of mechanical reels by the player, the transmissive display further being operable to increase its opacity on a portion of the transmissive display to cause at least one, but not all, of the plurality of mechanical reels to be obscured from view by the player during a second play while the unobscured ones of the plurality of mechanical reels can be clearly viewed by the player.

EVIDENCE

The Examiner relied on the following evidence in rejecting the claims on appeal:

Ozaki	US 2001/0031658 A1	Oct. 18, 2001
Nonaka	US 2004/0214637 A1	Oct. 28, 2004 ²

² We note that Nonaka has a filing date, which the Examiner relies upon for 35 U.S.C. § 102(e) purposes, of Oct. 31, 2003.

REJECTIONS

The following rejections are before us for review:

- I. Claims 94–96, 98, 100–103, 105, 107–109, 112, 124–128, and 130 stand rejected under 35 U.S.C. § 102(e) as anticipated by Nonaka. Non-Final Act. 4–8.
- II. Claims 97, 104, 105, 110, 113, and 129 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nonaka and Ozaki. *Id.* at 8.

ANALYSIS

Rejections I and II both rely on Nonaka for disclosing a gaming machine with a plurality of reels and a transmissive display overlaying the reels, where a portion of the transmissive display changes opacity to obscure from view at least one reel to thereby effectively reduce the number of viewable reels.³ *See* Non-Final Act. 4–8.

Appellants’ principal argument against these rejections is that Nonaka does not qualify as prior art under 35 U.S.C. § 102(e) based on declarations that were submitted to the Examiner for consideration in an attempt to “swear behind” the filing date of Nonaka. *See* Appeal Br. 6–9; Reply Br. 1–8.⁴ In particular, Appellants submitted a Declaration under 37 C.F.R. § 1.131 of the named inventors, dated March 23, 2011 (“Rule 131

³ This feature, or a similar feature of using the transmissive display to effectively reduce a number of viewable reels or columns of symbols, is recited in each of the independent claims.

⁴ We note that the Reply Brief does not include page numbers. For reference convenience, we designate the cover page of the brief as page 1 and number the pages consecutively therefrom.

Declaration” or “Inventors’ Declaration”) and a Declaration under 37 C.F.R. § 1.132 of attorney Michael J. Blankstein, dated March 24, 2011 (“Rule 132 Declaration” or “Attorney’s Declaration”) for consideration by the Examiner.⁵ The Inventors’ Declaration and the Attorney’s Declaration were submitted in an effort to show earlier conception of the claimed subject matter—namely, the feature of a portion of the transmissive display changing opacity to obscure from view at least one reel to thereby effectively reduce the number of viewable reels—coupled with due diligence from a critical period prior to the filing date of Nonaka to the filing date of the subject application (i.e., constructive reduction to practice).

The Examiner determined, after consideration of the declarations, that Appellants did not provide sufficient evidence to demonstrate prior conception of the feature of a portion of the transmissive display changing opacity to obscure from view at least one reel to thereby effectively reduce the number of viewable reels. *See* Non-Final Act. 3; Ans. 2–6. In particular, the Examiner’s position is that the disclosure contained in the draft patent application (submitted to the Board with the Appeal Brief as Exhibit H)⁶ provides evidence of a video image that may change in opacity, but only with respect to a single video image that overlies all of the reels, rather than each reel individually, so that the video image disclosed would not be able to obscure from view at least one reel, but not all of the reels. *See* Ans. 4. In

⁵ These declarations were also submitted to the Board with the Appeal Brief and are referenced herein (as Exhibits F and G, respectively) as they are identified in such submission. *See* Appeal Br., Evidence App.

⁶ This document was submitted to the Examiner as “Exhibit A” of the Inventors’ Declaration; it is referenced herein as Exhibit H as it is identified in the submission to the Board. *See* Appeal Br., Evidence App.

other words, the Examiner's position is that the disclosure of Exhibit H supports only changing the opacity of the *entire* transmissive display, but not changing the opacity of "*a portion of*" the transmissive display to effectively reduce the number of viewable reels. *See id.*

Upon review of the disclosure of Exhibit H, we agree with Appellants that sections of the draft patent application provide sufficient descriptive evidence of the disputed feature. In particular, we agree with Appellants that Exhibit H's disclosure of using the transmissive display (which the Examiner acknowledges may change in opacity) to "change the number of reels," coupled with the express disclosure in draft claim 56 of "wherein the supplemental video image [of the transmissive display] masks at least one of the primary columns to be removed from the wagering game," is sufficient to evidence earlier conception of the disputed feature.⁷ Reply Br. 5; *see also* Exhibit H, p. 13, ll. 2–3, p. 22, ll. 2, 7–8.

The Examiner's position that removal of a reel from the game (as described in draft claim 56) "can be done" by other methods, and is "not necessarily" accomplished by changing the opacity of the overlying video image, is too restrictive. Ans. 4. It is not necessary that obscuring a reel by changing the opacity of the overlying video image be *the only way* to effectively remove a reel from the game; rather, so long as one of ordinary skill in the art, upon review of the disclosure, would appreciate that doing so is *a suitable way* to effectively remove a reel from the game, this is

⁷ We note that, on the requirement of establishing due diligence, the record before us does not raise any issue as to the sufficiency of Appellants' asserted diligence. *See* Exhibit F ¶¶ 8, 9; Exhibit G ¶¶ 8–10; *see also* Appeal Br. 7; Ans. 2–6.

sufficient disclosure to evidence possession of the disputed feature. Thus, the identified express disclosures of Exhibit H, taken in light of the entirety of the draft patent application, are sufficient to describe to one of ordinary skill in the art—albeit not in the same words—the claimed feature of a portion of the transmissive display changing opacity to obscure from view at least one reel to thereby effectively reduce the number of viewable reels.

In view of the foregoing, we agree with Appellants that the Examiner erred in determining that Appellants did not provide sufficient evidence to demonstrate prior conception of the feature of a portion of the transmissive display changing opacity to obscure from view at least one reel to thereby effectively reduce the number of viewable reels in swearing behind the filing date of Nonaka. Accordingly, disqualification of Nonaka as prior art under 35 U.S.C. § 102(e) is fatal to both Rejections I and II; thus, we do not sustain them.

DECISION

We REVERSE the Examiner's rejections of claims 94–98, 100–105, 107–110, 112, 113, and 124–130.

REVERSED