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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DANIEL MARKS, ANTHONY SINGER, and
HOWARD MARKS¹

Appeal 2014-003842
Application 11/951,060
Technology Center 3700

Before MICHAEL L. HOELTER, ANNETTE R. REIMERS, and
MARK A. GEIER, *Administrative Patent Judges*.

GEIER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is a decision on appeal, under 35 U.S.C. § 134(a), from the Examiner's rejection of claims 1–20.² Appeal Br. 19, 26; Reply Br. 1. We have jurisdiction under 35 U.S.C. § 6(b).

¹ Appellants indicate that the real party in interest is “IGT.” Appeal Br. 2.

² Should there be further prosecution of this application (including any review for allowance), it is suggested the Examiner evaluate claims 1–20 for compliance under 35 U.S.C. § 101 in light of the recent decision in *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014), and the most recent Office guidance on § 101 found in “2014 Interim Guidance on Patent Subject Matter Eligibility,” 79 Fed. Reg. 74618 (Dec. 16, 2014), “July 2015 Update on Subject Matter Eligibility,” 80 Fed. Reg. 45429 (July 30, 2015),

We REVERSE.

THE CLAIMED SUBJECT MATTER

The claimed subject matter relates to “an electronic novelty and wagering game having an electronic display, a controlling processor presenting a game symbol matrix where matching symbol combinations result in an award and the symbols are removed and replaced.” Spec. ¶ 2.

Claim 1 is illustrative and recites:

1. A gaming system comprising:
 - at least one display device;
 - at least one input device;
 - at least one processor; and
 - at least one 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 said at least one input device and said at least one display device for each play of a wagering game to:
 - (a) enable a player to make a wager on said play of the wagering game, said wagering game associated with a plurality of symbols, a plurality of winning symbol combinations and a plurality of monetary award values associated with said winning symbol combinations;
 - (b) randomly select a plurality of said symbols;
 - (c) display said selected symbols;
 - (d) determine if said displayed symbols form any of said winning symbol combinations; and
 - (e) if said displayed symbols form any of said winning symbol combinations:
 - (i) provide the player the monetary award value associated with the formed winning symbol combination,

and “May 2016 Subject Matter Eligibility Update,” 81 Fed. Reg. 27381 (May 6, 2016), which supplement the “Preliminary Examination Instructions in view of the Supreme Court Decision in *Alice Corporation Pty. Ltd. v. CLS Bank International, et al.*” Memorandum to the Examining Corps, June 25, 2014.

- (ii) remove each of the displayed symbols which form any winning symbol combination,
- (iii) for each removed symbol, randomly select and display one of said symbols, and
- (iv) repeat (d) to (e)(iii) at least once, wherein each removal of each of the displayed symbols for the play of the wagering game is independent of any player input to reposition any of the displayed symbols.

THE REJECTIONS ON APPEAL

The Examiner rejected claims 1–20 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

The Examiner rejected claims 1–20 under 35 U.S.C. § 103(a) as unpatentable over a non-patent literature publication entitled “Bejeweled® Deluxe” (Version 1.87; pub. May 30, 2001 by PopCap Games, Inc.) (hereinafter “Bejeweled”), Safari (US 5,769,716; iss. June 23, 1998), and Webb (US 2002/0034976 A1; pub. Mar. 21, 2002).

ANALYSIS

Rejection of Claims 1–20 as Failing to Comply with the Written Description Requirement

The Examiner finds that the Specification does not support the purported “negative” limitation in claim 1: “wherein each removal of each of the displayed symbols for the play of the wagering game is independent of any player input to reposition any of the displayed symbols.” In particular, the Examiner finds that the Specification “does not include specific mention that player’s input to reposition symbols does not occur before removal of matching symbols.” Final Act. 2, 19. The Examiner elaborates:

Applicants’ specification is silent in regards to whether or not player interaction is required or not required during the process of removing a symbol. Applicants’ cited paragraphs only

disclose that the processor will award a player for each award combination provided by the displayed symbols until no combinations are found at which point the game ends. It does not exclude the player making the combinations via player input. While applicants may recite player input in previous paragraphs this is not a basis for providing support for the specific exclusion of player input since it is not clear that this would be the case.

Id. at 19–20; *see also* Ans. 2–5.

In response, Appellants offer as evidence of processor operations paragraphs 18, 19, 42, 44–50, 55–57 and 64 of the Specification. Appeal Br. 19–23. In summarizing paragraphs 18, 19, 42, 44–50, 55–57 and 64 of the Specification, Appellants assert:

As seen in at least these paragraphs, the specification repeatedly discloses a *processor*: first selecting game symbols, then displaying the selected game symbols, then comparing the displayed symbols to a schedule to determine if any of the displayed symbols define a winning outcome set, and then, for each determined winning outcome set, removing the symbols, *wherein each of these processor executed steps occur sequentially without any player inputs*. Put differently, the specification of the present application repeatedly includes removing the winning combinations from the display without any intervening steps or elements (i.e., without any player inputs). Accordingly, at least these paragraphs clearly provide support for the claimed element that each removal of each of the displayed symbols for the play of the wagering game is independent of any player input to reposition any of the displayed symbols.

Appeal Br. 23 (emphasis added).

Appellants also offer as evidence of player inputs paragraphs 14, 32, and 33 of the Specification. Appeal Br. 24–26. In summarizing paragraphs 14, 32, and 33 of the Specification, Appellants assert:

Appellant submits that by *including player inputs* in at least these paragraphs and *not including player inputs* in other

portions of the present application, Appellant clearly was in possession of the claimed element of each removal of each of the displayed symbols for the play of the wagering game being independent of any player input to reposition any of the displayed symbols.

Appeal. Br. 26 (emphasis added); *see also* Reply Br. 5.

Appellants also reference U.S. Provisional Patent Application No. 60/331,016 (hereinafter “’016 application”) from which the present application claims priority. *See* Reply Br. 5–10. Specifically, Appellants refer to pages 678–685 of the ’016 application which are reproduced in the Reply Brief at pages 6–10. Appellants first describe page 678 of the ’016 application which “clearly show a player input (e.g. the spin button) that is highlighted (i.e., enabled to be engaged by a player) to initiate a play of a wagering game” (Reply Br. 5) and then describe pages 679–685 of the ’016 application which

clearly show that after such an initiation of the play of the wagering game, the player input (e.g., the spin button) is no longer highlighted (i.e., disabled from being engaged by the player) *and is specifically disabled from being engaged by the player in association with the removal of the symbols from the winning symbol combination shown on pages 681 and 682.*

Reply Br. 6 (emphasis added). Appellants conclude:

Accordingly, as seen in at least these examples, by describing the required player input for certain aspects of the play of the wagering game and by excluding any required player input for certain other aspects of the play of the wagering game, the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date, Appellant was in possession of the aspect of each removal of each of the displayed symbols is independent of any player input to reposition any of the displayed symbols.

Reply Br. 10.

Appellants' arguments are persuasive. Our reviewing court has held that "properly describing alternative features – without articulating advantages or disadvantages of each feature – can constitute a 'reason to exclude'" a feature from a claim. *Inphi Corp. v. Netlist, Inc.*, 805 F.3d 1350, 1355 (Fed. Cir. 2015); *see also id.* at 1357 ("[P]roperly described, alternative features are sufficient to satisfy the written description standard of § 112, paragraph 1 for negative claim limitations."); *see also* MPEP § 2173.05(i) ("If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims.").

Appellants provide multiple examples from both the Specification and the '016 application of properly described instances where user input is required, e.g., pressing the spin button to initiate play, and when it is not, e.g., processor operations including determining if any displayed symbols define a winning outcome set, and then, for each determined winning outcome set, removing the symbols. The clear distinction in the Specification between those processes which require user input and those that are performed by the processor without human intervention make apparent that Appellants were in possession of the limitation "wherein each removal of each of the displayed symbols for the play of the wagering game is independent of any player input to reposition any of the displayed symbols" at the time the application was filed.

For the foregoing reasons, we do not sustain the rejection of claims 1–20 under 35 U.S.C. § 112, first paragraph.

Rejection of Claims 1–20 as Unpatentable Over Bejeweled, Saffari, and Webb

The Examiner finds that Bejeweled teaches several of the limitations

of independent claim 1 except that

Bejeweled does not teach a game which enables a player to make a wager on the play of the wagering game, the wagering game associated with a plurality of symbols, a plurality of winning symbol combination and a plurality of monetary award values associated with the winning symbol combinations and awarding a monetary award value nor does it teach a game wherein each removal of each of the displayed symbols for the play of the wagering game is independent of any player input to reposition any of the displayed symbols.

Final Act. 4–5.

For teaching of the act of wagering in a symbol matching game the Examiner relies on Saffari (*Id.* at 5, citing Saffari, Abstract; Figs. 1, 2, and 3F) and for teaching of the act of matching symbols “independent of . . . configuring player input” the Examiner relies on Webb (*Id.*, citing Webb ¶¶ 8, 9, 11, 13, 25 and 45; Abstract; Figs. 1 and 3). As for Webb, in particular, the Examiner states:

Webb shows it is well-known to include in a wagering matching game the feature of the matching occurring independent of player input thereby allowing further control of the odds by the gaming machine and insuring that awards are provided independent of player skill thereby insuring that payout rate is maintained.

Id.

According to Appellants, however, the proposed modification of Bejeweled by Webb effectively changes the principle of operation of the Bejeweled game. More particularly, Appellants state:

When Bejeweled is modified with Webb such that the removal of displayed symbols occurs independent of the player actively swapping adjacent gems, Bejeweled ceases to properly function in its intended manner of enabling a player to click on two gems to swap such gems. That is, the principal operation of Bejeweled is premised on a player interacting with the game to

make two inputs of two adjacent gems to swap such adjacent gems to create sets of identical gems. Without this player interaction, Bejeweled would include no swapping of adjacent gems and thus such a modification substantially changes the principal operation of Bejeweled (i.e., modifying Bejeweled from a player selection skill game to a non-skill game devoid of player selection) and results in Bejeweled being unsatisfactory for its intended purpose.

Appeal Br. 31–32; *see also* Bejeweled 3–4.

The Examiner responds by stating:

While by removing player interaction Bejeweled is changed from a game of skill to a game of chance examiner contends that this motivation is well-known in the art as evidence by such prior art as Webb. Examiner disagrees that the prior art would exclude this modification since Webb provides evidence within the prior art of modifying former games of skill to a pure game of chance with the game functions further controlled by the random number generator and not a player's skill.

Ans. 6.

To which Appellants reply:

[E]ven if, as suggested by the Examiner, “it is well-known in the art” to change a game of skill to a game of chance, modifying Bejeweled from a game of skill (which includes player inputs swap gems to create sets of identical gems) to a game of chance (which is devoid of any player inputs to swap gems to create sets of identical gems) remains contrary to the express disclosure of Bejeweled and thus destroys the principal operation of Bejeweled. That is, even if the Examiner's generic statements of modifying former games of skill to pure games of chance are taken as well known motivations in the art to modify games, the specific operation of Bejeweled (and specifically the degree of player involvement in swapping gems to create sets of identical gems) prevents such a generic modification from being applicable to Bejeweled.

Reply Br. 12–13.

Appellants' arguments are persuasive. Combinations of prior art that change the "basic principles under which the [prior art] was designed to operate" may not support a conclusion of obviousness. *In re Ratti*, 270 F.2d 810, 813 (CCPA 1959). Here, other than to say that it is well known to do so, the Examiner does not adequately explain why one of ordinary skill in the art would have been motivated make a wholesale change to the specific manner of operation of the skill-based Bejeweled game when presented with the non-skill-based game teachings of Webb. In our view, converting the skill-based game of Bejeweled (which requires human interaction to manipulate the gem symbols in order to play the game) to a chance-based game such as Webb (which requires no human interaction with the game symbols in order to play the game) would fundamentally alter the principle of operation of Bejeweled. In other words, removing the element of human interaction would change the very essence of Bejeweled, i.e., the mental challenge of selecting which gems to swap would be eliminated, thereby rendering it unsatisfactory for its intended purpose.

For the foregoing reasons, we do not sustain the Examiner's rejection of claims 1–20 as unpatentable over Bejeweled, Saffari, and Webb.

CONCLUSION

We reverse the Examiner's rejection of claims 1–20 under 35 U.S.C. § 112, first paragraph.

We reverse the Examiner's rejection of claims 1–20 under 35 U.S.C. § 103(a) as unpatentable over Bejeweled, Saffari, and Webb.

REVERSED