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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* JOHN A. CHEWOIAN

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Appeal 2017-009682  
Application 13/309,339  
Technology Center 3700

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Before JENNIFER D. BAHR, MICHAEL L. HOELTER, and  
ANNETTE R. REIMERS, *Administrative Patent Judges*.

REIMERS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant<sup>1</sup> appeals under 35 U.S.C. § 134(a) from the Examiner's decision to reject under 35 U.S.C. § 102(b) claim 1 as anticipated by Knight (US 2005/0146092 A1, published July 7, 2005) and to reject under 35 U.S.C. § 103(a) claims 6 and 19–22 as unpatentable over Knight. Claim 2–5 and 7–18 has been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as John A. Chewoian. Appeal Br. (“Appeal Br.”) 2, filed Feb. 7, 2017.

### CLAIMED SUBJECT MATTER

The claimed subject matter “relates to a dice game, in particular a game where players can place a variety of bets having various payouts depending on the outcome of the roll of three dice, and which is suitable for use in a casino.” Spec. ¶ 1, Fig. 1. Claims 1 and 22 are independent.

Claim 1 is illustrative of the claimed subject matter and recites:

1. A device for use in a game of chance, comprising:  
a casino table having a game surface residing in a casino where multiple players are accommodated, the game surface comprising four discrete delineated sections, and four preselected numbers marked within each section, each preselected number being in a configuration to facilitate the placement of a wager thereon, wherein the preselected numbers have the advantage of being able to govern the payouts for various wagers made by placing a wager onto a number in a particular section, each number representing the sum of a single roll of three dice, the totality of the preselected numbers representing all the various possible three dice roll sums, each number having a preselected payout associated with the roll of a three dice sum corresponding to the number, and each delineated section having a preselected payout associated with that section for the roll of a three dice sum corresponding to any one of the numbers in that section, the numbers in the sections being arranged such that the preselected payout for each of a group of three of said discrete delineated sections is the same while the preselected payout for the remaining discrete delineated section is higher, the arrangement of the numbers also being such that there is a preselected payoff for each three-dice total rolled, and that if the number wagered on is not rolled but the rolled number falls into the same section as the wagered number then there will be a payout based on the odds for that section.

## ANALYSIS

### *Anticipation by Knight*

#### *Claim 1*

The Examiner finds that “Knight shows a game surface with four delineated sections in four rows as shown in fig. 10 with preselected numbers 3-18 representing all possible three dice roll sums with payout odds in an adjacent section.” Final Act. 2.<sup>2</sup>

Appellant contends that the Examiner dismisses “the claimed structural and functional limitations provided by the provision of discrete delineated sections together with the marking on the table surface of preselected numbers that are specifically selected to enable payouts for three of the sections that are the same even though individual number payouts are quite different.” Appeal Br. 6. According to Appellant, “unlike any other dice game, if the number on which the wager is placed is not the same as the rolled three dice sum but is in the same section as the winning number, then, the player will still get a payout, albeit less,” which is made possible by the arrangement of the numbers in the sections, such that “[t]he arrangement of the numbers results in each of three of the sections having the same payout regardless of which of three sections the sum of the rolled numbers falls in,” and that “[i]t is the structure of the table surface indicia that has the important function of enabling the payout for each of three discrete delineated sections to be the same while enabling individual number wagers.” See Appeal Br. 6–8; see also Reply Br. 3<sup>3</sup> (“[N]umbers in three of

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<sup>2</sup> Final Office Action (“Final Act.”), dated Sept. 13, 2016.

<sup>3</sup> Reply Brief (“Reply Br.”), filed July 5, 2017.

the sections have been chosen so that the consolation payoff is virtually identical regardless of which of the three sections a wager is placed on.”).

Appellant further contends that claim 1 “set[s] out specific structure provided by [A]ppellant’s unique the arrangement of sections and numbers” and that “[t]here is nothing in Knight that can be considered to suggest [A]ppellant’s unique arrangement of sections and numbers.” Reply Br. 4; *see also* Appeal Br. 6–8.

In this case, the Examiner correctly points out that structurally claim 1 “call[s] for an arrangement of indicia to be in ‘four discrete delineated section[s]’ with ‘four preselected numbers [marked] within each section’” (*see* Final Act. 2), that “[t]he functional interpretation of the numbers in accordance with the play of the game and intended payout of preselected odds is not considered to be a structural limitation upon which one can rely . . . to impart patentability” and that “[s]uch is merely the rules or intended play of the game.” Final Act. 2–3; *see also* Ans. 2<sup>4</sup> (“[T]he function [of Appellant’s arrangement of indicia] is treated as not amounting to any structure that can be relied upon to distinguish over the applied art.”); *id.* at 2–3 (“This intended play of the game does not amount to any structure that can be relied upon to distinguish over the applied art.”).

Here, the Examiner takes the position that “both the prior art and the instant invention have the same capabilities of indicating and recording wagers in a game” and that “[i]n accordance with the rules for playing a game, the function of paying a player for wagering in the same section can also be afforded to the prior art device.” Final Act. 3. In particular, the

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<sup>4</sup> Examiner’s Answer (“Ans.”), dated June 8, 2017.

Examiner finds that “[i]n Knight one can use his layout in accordance with the same rule that if one number in the section appears the[n] a payout is made.” *Id.* at 5. Appellant does not provide persuasive evidence or argument apprising us of Examiner error.

Additionally, the Examiner takes the position that payouts in games “are selected as a matter of design choice by a gaming operator as a balancing effort to attract players by favorable odds vs. obtaining a favorable house profit.” Ans. 3. Appellant does not apprise us of Examiner error.

Appellant contends that the claimed “indicia does not simply provide information, about the game, it provides a specific space on which one can place his or her wager.” Reply Br. 5; *see also* Appeal Br. 9 (“The claims are drafted to assure that the functional relationship pertains to physical structure, namely, the nature of the numbers and how they are arranged.”). Specifically, according to Appellant,

the indicia convey a message that is not independent of the casino table surface but is directly dependent on the purpose and function of such a surface, namely, to guide a player as to where physically to place his or her bet so that he or she can gamble on which set of numbers in which section will provide not only a payoff if a specific number comes in but also a payoff if any number in that section comes in.

Reply Br. 5; *see also id.* at 2, 6; Appeal Br. 10.

The critical question regarding the applicability of the so-called “printed matter doctrine” is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. *In re Gulack*, 703 F.2d 1381, 1386 (Fed. Cir. 1983). “Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability.” *Id.* at

1385(citing *In re Miller*, 418 F.2d 1392 (CCPA 1969)); *see also In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004).

Our reviewing court and its predecessor have frequently cautioned the Patent and Trademark Office (PTO) that all claim limitations must be considered when determining patentability over the prior art. *In re Lowry*, 32 F.3d 1579, 1582–83 (Fed. Cir. 1994) (quoting *Gulack*, 703 F.2d at 1384). Furthermore, the Federal Circuit has cautioned against a liberal use of a printed matter rejection. *Id.* at 1582–83. Accordingly, although we will not disregard any claim limitations and will assess the claimed invention as a whole, we will follow the Federal Circuit’s guidance as in *Gulack* and will “not give [any] patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate.” *Id.* at 1582.

As an initial matter, Appellant states that “[t]he purpose and function of [A]ppellant’s printed matter is to enable the indicia on the casino table surface to guide a player as to where to place his or her bet.” Reply Br. 6; *see also id.* at 2, 5. However, Appellant also states that “a bettor can *choose* a favorite number to bet on.” *Id.* at 3 (emphasis added). Given that a bettor can “choose” a favorite number to bet on, we fail to see and Appellant fails to adequately explain *how* the indicia on the casino table surface is enabled to “guide” a bettor as to where to place his or her bet. *See* Reply Br. 2–6.

Appellant contends that the facts of the subject application are similar to the facts in *Gulack*. *See* Appeal Br. 9–12; *see also* Reply Br. 2–6. We disagree. The facts in *Gulack*, where the court held that the printed material at issue could be used to distinguish the subject claims over the prior art, can be distinguished from the facts in the present appeal. The claims at issue in

*Gulack* were directed to a band, individual digits imprinted on the band, and an algorithm by which the appropriate digits are developed. *Gulack*, 703 F.2d at 1382. In assessing the functional relationship between the printed matter (the digits) and the substrate (the band), the court concluded that the digits were “related to the band in two ways: (1) the band supports the digits; and (2) there is an endless sequence of digits—each digit residing in a unique position with respect to every other digit in an endless loop.” *Id.* at 1386–87. Significantly, the court concluded that “the digits exploit the endless nature of the band.” *Id.* at 1387 (emphasis added). That is, the characteristics of the substrate itself – its endless nature with no beginning or ending – related to the function of the printed matter. No such relationship exists in the subject application. The characteristics of the claimed casino table surface (the substrate) do not impart any functional relationship to the indicia and, similarly, the indicia do not impart any functional relationship to the casino table surface.

Appellant contends that “[t]he claims are drafted to assure that the functional relationship pertains to physical structure, namely, the nature of the numbers and how they are arranged.” Appeal Br. 9. However, the substrate – the casino table surface – does not have a relationship with the arrangement of indicia. The arrangement of indicia would still function to display and delineate areas upon which a wager may be placed on a different substrate. *See* Final Act. 4–5. The facts in the subject application are different from *Gulack*, where the Federal Circuit found the endless nature of the band, with no fixed beginning and ending, was functionally tied to the sequence of digits on the band. *See Gulack*, 703 F.2d at 1387.

The subject application is more akin to the Federal Circuit’s decision in *In re Xiao*. See *In re Xiao*, 462 Fed. Appx 947 (Fed. Cir. 2011)(nonprecedential). In *Xiao*, the applicant sought a patent on a combination lock with letters rather than numbers, so a user could use a word as the combination. *Id.* at 948. Because the individual tumbler rings of the lock included less than 26 characters, the tumbler rings included a wildcard character to take the place of a missing letter. *Id.* The applicant argued that

the wild-card labels render the claimed lock physically different from and improved relative to preexisting designs [and] the wild-card labels function as more than simple position markers because they can represent any letter and thereby enable users to select any desired password even where each tumbler ring has less than twenty-six positions

*Id.* at 951. The court rejected this argument, concluding that “the presence or identity of a given position label has no bearing on the lock’s ultimate function, and the claimed device can be used in the same way and for the same purposes with or without wild-card position labels.” *Id.* Similarly, in the subject application, the casino table surface, like the lock tumbler ring in *Xiao*, would function as a table surface even if different indicia were present on the table surface. As such, we agree with the Examiner that “[t]he functional interpretation of the numbers in accordance with the play of the game and intended payout of preselected odds is not considered to be a structural limitation upon which one can rely . . . to impart patentability” and that the subject “wagering table functions the same as in the prior art as a surface with indicia upon which a player may place a wager to indicate or record a proposition.” Final Act. 2, Ans. 2; see also *id.* at 3.

In summary, and based on the record presented, we are not persuaded the Examiner erred in rejecting independent claim 1 as anticipated by Knight. Accordingly, we sustain the Examiner's rejection of claim 1.

*Obviousness over Knight*

*Claim 6*

Appellant merely recites claim language from claim 6 and contends that the "limitations are not disclosed or suggested by Knight." Appeal Br. 8. This vague statement is not a substantive argument for patentability. *Cf. In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (holding that the Board had reasonably interpreted 37 C.F.R. § 41.37(c)(1)(vii) (the predecessor to 37 C.F.R. § 41.37(c)(1)(iv)) as requiring "more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art"). As discussed above, we find no deficiencies in the Examiner's rejection of claim 1 as anticipated by Knight, and Appellant fails to apprise us of error in the rejection of claim 6. Therefore, for reasons similar to those discussed above for claim 1, we also sustain the Examiner's rejection of claim 6 as unpatentable over Knight.

*Claims 19–21*

Claims 20 and 21 depend from claim 19. Appeal Br. 14, Claims App. Appellant does not offer arguments in favor of claims 20 and 21 separate from those presented for independent claim 19. *See* Appeal Br. 8, 10; *see also* Reply Br. 3. We select claim 19 as the representative claim, and claims 20 and 21 stand or fall with claim 19. 37 C.F.R. § 41.37(c)(1)(iv).

Appellant contends that “the derivations of the sequences of numbers are not independent. The numbers are arranged on the substrate so that the actual odds for each of the three sections is the same to at least one decimal point, a concept that is totally foreign to Knight” (Appeal Br. 10) and that “numbers in three of the sections have been chosen so that the consolation payoff is virtually identical regardless of which of the three sections a wager is placed on,” which “requires an inventive distribution of the numbers and sections so that the actual odds are virtually the same from section to section” (Reply Br. 3).

As discussed above, we agree with the Examiner that “[t]he functional interpretation of the numbers in accordance with the play of the game and intended payout of preselected odds is not considered to be a structural limitation upon which one can rely . . . to impart patentability.” Final Act. 2. In response to Appellant’s argument, the Examiner states that “Appellant argues that the ‘actual odds’ and exact numbers called for in each section is not disclosed. This is acknowledged in the grounds for rejection as being an obvious rearrangement of printed matter.” Ans. 5. In addition, the Examiner explains:

Wagering tables in general and as applied in the grounds for rejection provide sections marked with indicia that indicate a proposition and its payoff odd upon which a player may place a marker to indicate their intentions. They are nothing more than a “tally” or “record” of a players intentions. Merely rearranging the table with different wagers and payoffs does not change the function of a casino table. It still serves as a tally or record for players wagers regardless of how the indicia is arranged or the rules for the play of a game that would give any meaning to that indicia. As such, a mere rearrangement of printed matter has not been shown to be non-obvious.

Ans. 5. Appellant does not provide persuasive evidence or argument apprising us of Examiner error.

Accordingly, we sustain the Examiner's rejection of claim 19 as unpatentable over Knight. We further sustain the rejection of claims 20 and 21, which fall with claim 19.

*Claim 22*

Similar to claim 6, Appellant merely recites claim language from claim 22 and contends that the "limitations [are not] disclosed or suggested by Knight." Appeal Br. 9. As noted above, such a vague statement does not constitute a substantive argument for patentability. *Cf. In re Lovin*, 652 F.3d at 1357. Here, the Examiner finds that "the selection and rearrangement of indicia has been held obvious," that Knight "shows a wagering surface with a plurality of section upon which player may wager a proposition based upon the occurrence of a random event such as a roll of the dice," and that "[t]he now explicitly claimed numeric indicia does not amount to any new and non-obvious functional relationship in that the function of the layout remains the same as that in the prior art to indicate the placement of a wager." Final Act. 4; *see also* Ans. 5. Appellant does not apprise us of Examiner error.

Accordingly, we sustain the Examiner's rejection of claim 22 as unpatentable over Knight.

DECISION

We AFFIRM the decision of the Examiner to reject claim 1 as anticipated by Knight.

Appeal 2017-009682  
Application 13/309,339

We AFFIRM the decision of the Examiner to reject claims 6 and 19–22 as unpatentable over Knight.

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