



BL O/211/06

27<sup>th</sup> July 2006

## PATENTS ACT 1977

APPLICANT	IGT
ISSUE	Whether patent applications numbers GB0411821.2, GB0413162.9, GB0411822.0, GB0229511.1 comply with section 1
HEARING OFFICER	A C Howard

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## DECISION

### Introduction

- 1 This relates to whether to allow grant of the following four patent applications:-
  - GB0411821.2 entitled "System, apparatus and method employing controller for play of shared bonus games" filed on 27 November 2002, and claiming a priority date of 29 November 2001;
  - GB0413162.9 entitled "Method and system for weighting odds to specific gaming entities in a shared bonus event," filed on 3 December 2002, and claiming a priority date of 4 December 2001;
  - GB0229511.1 entitled "Method and apparatus for gaming machines with a quasi-competition play-bonus feature filed on 19 December 2002 and claiming a priority date of 19 December 2001; and
  - GB0411822.0 entitled "Method apparatus and system for perpetual bonus game" filed on 27 November 2002 and claiming a priority date of 30 November 2001.
- 2 All were filed in the name of IGT save for GB0229511.1. This was originally filed in the name of Anchor Gaming and was subsequently assigned to IGT on 18 February 2004.
- 3 The applications are not related in the strict sense of the word, but a common thread running through them is that all relate to systems for playing gambling games of the type in which there is a "main game" and a "bonus game". As claimed, these are defined in general terms only, but typically the main game may be an electronic representation of a "fruit machine" style of gambling

machine while the bonus game is a distinct and different type of activity to which a player may become eligible by earning credits in the course of playing the main game.

- 4 The three examiners responsible for processing these four applications have all made objections under the heading of patentable subject-matter which they were unable to resolve. In addition an objection of lack of inventive step is also outstanding on GB0411822.0. In the circumstances it was convenient to hear the agent's submissions on all four applications together, and to this end a hearing took place on 12 July 2006 at which the applicants were represented by Mr. Barry Quest, Ms. Helen Brooke, and Mr. David Slattery, all of Wilson Gunn. Mr. Slattery and Mr. Quest each intervened freely, so in what follows I shall not attempt to attribute comments to them individually.
- 5 The agents addressed me separately on each application, and the order in which they are treated in this decision follows the order in which they were taken at the hearing. However, in the interests of economy of space I have discussed issues common to all the applications together.

### **The applications**

#### **GB0411821.2**

- 6 The invention relates to a system comprising a plurality of gaming devices. Each such gaming device could be a gaming machine as may be found in arcades, or it could be a computer playing connected the internet. To enhance their enjoyment players participating in a basic game can under certain circumstances participate in a bonus game. The system tests players' eligibility for the bonus game by examining current and past entries stored in the system. If the player is eligible the entries are allocated to various entry pools and if the player is not eligible the entries are designated as past entries.
- 7 At the hearing I was asked to consider claim 1 as notionally amended by the incorporation of claim 10. Claim 1 (as thus amended) would be the only independent claim and read as follows:-

1. A system comprising:

A plurality of gaming devices; and

a controller including a microprocessor and memory means for storing one or more entries and for storing one or more entry pools, the controller being in communication with the plurality of gaming devices,

the controller programmed to detect a player at one of said plurality of gaming devices, said player using said one of said plurality of gaming devices;

the controller programmed to store in the memory means current entries generated by a player and past entries registered to a player;

The controller programmed to detect a current bonus round;

the controller programmed to detect current entries generated by said player using said one of said plurality of gaming devices during said current bonus round stored in the memory means;

The controller programmed to detect past entries registered to say player stored in the memory means;

The controller programmed to detect a triggering event indicating a start of a current bonus game of a plurality of bonus games;

The controller programmed to query if said player is eligible to participate in said current bonus game;

the controller programmed, if said player is eligible to participate in said current bonus game, to include said current entries in a current entry pool stored in the memory means and distributing said past entries among said current entry pool, a next entry pool and a predefined number of subsequent entry pools stored in the memory means according to a first par sheet;

the controller programmed, if said player fails to be eligible to participate in said current bonus game, to query if said player has relinquished control of said gaming device and, if no, to designate said current entries as said past entries; the controller programmed to detect completion of said current bonus game; and the controller programmed to clear said current entry pool stored in the memory means,

[former claim 10] wherein the controller is programmed to: query whether said player is said winning player for said current bonus game; and if yes, electronically record an award transferred to said player.

- 8 There are a number of claims appended to claim 1. In the examination report dated 3 April 2006 the examiner objected that the advance made by the invention related to a scheme for playing games, a mental act, a business method and a computer program.

### **GB0413162.9**

- 9 There is a linked bonus game for a set of machines. When a player becomes eligible for a bonus game s/he selects which of two shared bonus events to enter and can also control the timing of the selection of the winning entry. If no action to initiate selection is taken after a set time the selection is made automatically. This makes the game more interactive and therefore improves player satisfaction.
- 10 Claim 1 is the only independent claim and reads as follows:-
1. A system comprising:

a plurality of gaming machines, each programmed to be operated by a wager received from a player to play a primary game, to display an image associated with the primary game, and to determine an outcome of the primary game;

a controller coupled to the plurality of gaming machines and programmed to be operated by entries from gaming entities to effect first and second shared bonus events,

the controller programmed to determine if one qualifying activity associated with the primary game has occurred,

the controller programmed to automatically associate at least one said entry for a said shared bonus event with said gaming entity if the one qualifying activity associated with the primary game has occurred;

means for receiving a first input from the player to place the at least one said entry with one of a set of said entries for a said first shared bonus event or a set of said entries for a said second shared bonus event, the means being coupled to the controller;

means for receiving a second input from the player to initiate a selection of one of the entries from the set of entries for the first shared bonus event if the at least one entry was placed with the set of entries for the first shared bonus event or to initiate a selection of one of the set of entries for the second shared bonus event if the at least one entry was placed with the set of entries for the second shared bonus event the means being coupled to the controller;

wherein the controller is programmed to associate the at least one entry with one of a set of entries for a first shared bonus event or a set of entries for a second shared bonus event in response to the first input;

wherein the controller is programmed to select one of the entries from the set of entries for the first shared bonus event when the second input is received if the second input is received before a first time interval expires;

wherein the controller is programmed to select one of the entries from the set of entries for the first shared bonus event automatically if the second input is not received before the first time interval expires;

wherein the controller is programmed to determine a winner of the first shared bonus event according to the one of the entries selected;

wherein the controller is programmed, if the second input is received before the first time interval expires, to automatically award a payout to the player if the player is the winner or to automatically cancel the at least one entry associated with the player from the set of entries for the first shared bonus event if the player is not the winner;

wherein the controller is programmed to select one of the entries from the set of entries for the second shared bonus event when the second input is

received if the second input is received before a second time interval expires;

wherein the controller is programmed to select one of the entries from the set of entries for the first shared bonus event automatically if the second input is not received before the second time interval expires;

wherein the controller is programmed to determine a winner of the second shared bonus event according to the one of the entries selected; and

wherein the controller is programmed, if the second input is received before a second time interval expires, to automatically award a payout to the player if the player is the winner or to automatically cancel the at least one entry associated with the player from the set of entries for the second shared bonus event if the player is not the winner.

- 11 There are a number of claims appended to claim 1. The questions to be resolved are summarised in the examination report dated 14 June 2006 in which the examiner objected that the invention related to method, scheme or rule for playing a game.

#### **GB0229511.1**

- 12 In this application the bonus game involves the possibility of players adopting respective characters and challenging each other to some kind of contest.
- 13 Claim 1 is the only independent claim and reads as follows:

A system for playing a game of chance, comprising:

a plurality of networked gaming machines, said network further comprising a central server and a bonus event computer,

each gaming machine of the plurality of gaming machines being adapted for playing a primary game and a bonus game and being adapted to randomly determine an outcome in play of the primary game, the bonus game initiated upon the occurrence of a challenge from another player already qualified to participate in the bonus game and comprising a simulated contest against at least one opponent,

each gaming machine of the plurality of gaming machines including at least one bonus game initiation input engageable by a challenged player to perform one of accepting the challenge, whereupon the bonus game is initiated, and rejecting the challenge, whereupon a quantity of credits are debited from the challenged player and credited to the another player; and

each gaming machine of the plurality of gaming machines including at least one bonus game input engageable by a player to select a bonus game character to represent the player in the simulated contest against the at least one opponent, and to modify one or more aspects of the

bonus game character by selecting bonus game character elements from a library of available bonus game character elements,

wherein the bonus game computer in combination with the central server is operable to determine the occurrence of a challenge and relay said challenge to the challenged player; determine whether the challenge is accepted or rejected; and if the challenge is accepted the bonus game computer is operable to display and determine the outcome of the bonus game.

- 14 There are a number of claims appended to claim 1. The issue to be determined is summarised in the examination report dated 8 March 2006 in which the examiner expressed the view that the advance of the invention lies in the excluded field invention of schemes, rules or methods for playing games, although it could also be thought of as a computer program.

### **GB0411822.0**

- 15 In this application the bonus game is continuous and the player(s) enter and leave it while it is going on. An image associated with the bonus game is displayed to the player, parts of which alter either dependently or independently of player input, in accordance with whether or not the player is actually in the bonus game. In this way players remain aware of what is going on in the bonus game and are encouraged to keep playing the main game in order to earn eligibility to enter the bonus game.
- 16 At the hearing I was handed a set of amended claims comprising a new claim 1 based on the previous version of claim 4 on file when appended to previous claim 1. I was asked to consider this and the unamended claim 1 as possible alternatives.
- 17 In both versions of the claims under consideration claim 1 would be the only independent claim and there would be in addition further dependent claims. I reproduce below both versions of claim 1 for completeness:

Claim 1 (version filed 3 July 2006 and as on file before the hearing)

1. A gaming system comprising:

a gaming machine programmed to be operated by a wager from a player to play a primary game, to display an image associated with the primary game, and to determine a game outcome associated with the primary game; and

at least one computer programmed to play a bonus game and to display an associated image, and to determine if a qualifying activity has occurred during the primary game, to alter parts of the image associated with the bonus game independent of an input from the player until the qualifying activity is determined to have occurred, to be operated by player input to alter parts of the image associated with the bonus game independent of the game outcome of the primary game if the qualifying activity is determined to have occurred, to be operated by a termination input, and to alter parts of

the image associated with the bonus game independent of an input from the player after the termination input is received until a qualifying activity is determined to have occurred again,

whereby the player can enter and exit an ongoing said bonus game whilst the bonus game is in progress, the computer being programmed to provide a bonus prize award determined by player participation in the bonus game.

Claim 1 (version handed over at the hearing)

1. A gaming system comprising:

a gaming machine programmed to be operated by a wager from a player to play a primary game, to display an image associated with the primary game, and to determine a game outcome associated with the primary game; and

at least one computer being operable to:

play a bonus game and to display an associated image;

determine if a qualifying activity has occurred during the primary game;

alter parts of the image associated with the bonus game independent of an input from the player until the qualifying activity is determined to have occurred;

to be operated by player input to alter parts of the image associated with the bonus game independent of the game outcome of the primary game if the qualifying activity is determined to have occurred;

receive inputs from a plurality of players other than the player;

alter parts of the image associated with the bonus game according to the inputs from the plurality of players other than the player and independent of an input from the player until the qualifying activity is determined to have occurred;

alter parts of the image associated with the bonus game according to the inputs from the plurality of players other than the player and the input from the player independent of the game outcome of the primary game if the qualifying activity is determined to have occurred;

be operated by a termination input and

to alter parts of the image associated with the bonus game independent of an input from the player after the termination input is received until a qualifying activity is determined to have occurred again; and

alter parts of the image associated with the bonus game according to the inputs from the plurality of players other than the player and independent of an input from the player after the termination input is received until a qualifying activity is determined to have occurred again,

whereby the player and the plurality of players can enter and exit an ongoing said bonus game whilst the bonus game is in progress, the computer being programmed to provide a bonus prize award determined by player participation in the bonus game.

- 18 There have been several rounds of correspondence and quite substantial amendments already in the course of this application. The situation as it stood immediately prior to the hearing was that there were outstanding objections on grounds of non-patentable subject-matter and obviousness. My task is therefore to decide whether these objections are valid and also to consider whether the new claims offered would overcome them.

## The law

### (a) Patentability

- 19 In each of the cases under consideration, the examiners have argued that the claimed inventions relate to subject matter excluded from patentability under section 1(2) of the Act, in particular to a scheme, rule or method for playing a game, a method for performing a mental act, a business method and a program for a computer under section 1(2)(c). The relevant parts of this section read:

*1(2) It is hereby declared that the following (among other things) are not inventions for the purposes of this Act, that is to say, anything which consists of -*

- (a) a discovery, scientific theory or mathematical method;*
- (b) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever;*
- (c) a scheme, rule or method for performing a mental act, playing a game or doing business, or a program for a computer;***
- (d) the presentation of information;*

*but the foregoing provision shall prevent anything from being treated as an invention for the purpose of this Act only to the extent that a patent or application for a patent relates to that thing as such.*

- 20 These provisions are designated in section 130(7) as being so framed as to have, as nearly as practicable, the same effect as the corresponding provisions of the European Patent Convention (EPC), i.e. Article 52. Decisions of the EPO are therefore relevant to their interpretation.

## Interpretation

- 21 In July 2005 Peter Prescott QC, sitting as a Deputy Judge of the High Court, handed down judgment in *CFPH*<sup>1</sup> which raised questions regarding the UK

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<sup>1</sup> *CFPH's Application* [2005] EWHC 1589 Pat



Patent Office's practice in dealing with applications considered to relate to matter excluded by section 1(2) and in which an approach to determination of patentability was set out. This involved the following steps:-

(1) Identify what is the advance in the art that is said to be new and not obvious (and susceptible of industrial application).

(2) Determine whether it is both new and not obvious (and susceptible of industrial application) under the description "an invention" in the sense of Article 52 of the European Patent Convention (EPC) - broadly corresponding to section 1 of the Patents Act 1977.

22 Once the new and non-obvious advance has been identified, Mr Prescott suggested that it would often be possible to determine whether this was an advance under the description of an invention by asking "Is this a new and non-obvious advance in technology". Subsequent judgments issued by the High Court (*Halliburton*<sup>2</sup>, *Shoppalotto*<sup>3</sup>, *Crawford*<sup>4</sup>, *RIM v Inpro*<sup>5</sup> and *Macrossan*<sup>6</sup>) all point to a similar requirement for a technical advance in order to pass the test for patentability.

23 The agent pointed out to me paragraph 38 of Mr. Prescott's judgement in CFPH in which he appears to approve the granting of patents for gaming machines. I quote:-

*"As another example, take a game. You cannot patent the rules of a game, as such; but I believe (though I do not have to decide it) that the scope of the exclusion stops there. It has always been Patent Office practice to grant patents for novel board games supplied together with a printed set of rules. It does no harm and encourages the industry to devise new games that may give pleasure to millions. For example the board game Monopoly was patented. It is a superficial answer to say, "Yes, but that is because it is a set of concrete objects". To which I reply: "You could patent the set even if the objects themselves were not new", as in a novel game played with stones on a chessboard. In those cases it is the new rules that afford the unifying novelty and the inventive step. I can think of no reason why it should be the policy of the law to deny adequate patent protection to those who come up with new and entertaining games. The practical effect of the exclusion is merely to confine the monopoly to what which will be made and supplied commercially."*

24 This quotation is evidently obiter, but should in any case be seen in the light of the then practice of the Office to grant patents for board games in accordance with a notice issued in 1926. This practice was explicitly disapproved of by Pumfrey J in *Shoppalotto*.

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<sup>2</sup> *Halliburton Energy Services Inc v Smith International (North Sea) Ltd and others* [2006] RPC 25

<sup>3</sup> *Shoppalotto.com's Application* [2005] EWHC 2416 (Pat)

<sup>4</sup> *Cecil Lloyd Crawford's Application* [2005] EWHC 2417 (Pat)

<sup>5</sup> *Research In Motion UK Ltd v Inpro Licensing* [2006] EWHC 70 (Pat)

<sup>6</sup> *Neil William Macrossan's Application* [2006] EWHC 705 (Pat)

- 25 The agent suggested to me that Mr Prescott's remarks were of general applicability and that the present inventions would not have benefited under the 1926 notice in any case.
- 26 It is indeed true that the facts in the present cases are different from those in Shoppalotto, but what I understand from Shoppalotto is that games are not to be treated as a special case where the principles set out in CFPH do not apply. This is the approach I shall therefore take.

### **(b) Inventive Step**

- 27 As remarked above, an objection under this heading has been raised in respect of GB0411822.0 only. The relevant provisions are to be found in Sections 1(1) and 3 of the Act and read as follows:

#### **Section 1(1)**

*A patent may be granted only for an invention in respect of which the following conditions*

*are satisfied, that is to say -*

*(a) the invention is new;*

***(b) it involves an inventive step;***

*(c) it is capable of industrial application;*

*(d) the grant of a patent for it is not excluded by subsections (2) and (3) below;*

*and references in this Act to a patentable invention shall be construed accordingly.*

#### **Section 3 additionally says:-**

#### **Section 3**

*An invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the state of the art by virtue only of section 2(2) above (and disregarding section 2(3) above).*

### **Interpretation**

- 28 It is well settled that the correct approach to be taken is that set out by Oliver LJ in *Windsurfer*<sup>7</sup>, which involves the following 4-point test to determine whether an invention involves an inventive step:

(1) Identify the inventive concept embodied in the patent in suit

(2) assume the mantle of the normally skilled but unimaginative addressee in the art (the person to whom the patent is addressed) at the relevant date and impute to him what was at that date common general knowledge in the art in question

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<sup>7</sup> *Windsurfing International Inc. v Tabur Marine Great Britain Ltd.* [1985] RPC 59, 73

- (3) Identify what, if any, differences exist between matter cited as known or used and the alleged invention, and
- (4) decide whether, viewed without any knowledge of the invention, those differences constitute steps which would have been obvious to the skilled man or whether they required any degree of invention.

### **Discussion – general principles**

- 29 The determination of excluded subject-matter has to be made on a case-by-case basis, and I was addressed by the agents on each application separately. However the four inventions do share certain aspects in common and certain of the arguments put to me are of general relevance. It is therefore convenient for me to discuss these points together. I shall then proceed to consider the particular features of each application in turn.
- 30 A common theme running through the applications is that they deal with what I might term the “player experience”, something which the agent characterized as the “interface” between the player and gaming system.
- 31 In his submissions, the agent attempted to draw a distinction between the “rules” of a game, which he characterized as being what the player has to do to play the game (in practice in the present situations this often amounts to little more than inserting money or credit and pressing buttons), and the way the system responds to player input, together with the associated controls enabling the machine to do that, which he submitted have a technical nature and could not be regarded as the “rules” of a game. Another way he explained it was to say that the rules are in the player’s head, while what is in the system is technical.
- 32 In support of this argument, the agent used the example of a punchball. To play with a punchball requires the presence of a player but nobody would deny that the punchball itself is patentable. Of course, the ball’s responses to blows are governed by its constructional features and the laws of nature, and there can be no question of such parameters constituting the “rules” of the notional game of playing with a punchball. However I am not convinced that such a physical analogy is gets us very far in this case. A punchball has no gaming sophistication and its interface is simplistic. It cannot be compared with a computer game in which any aspect of the player environment and experience can be programmed as desired.
- 33 I have difficulty with the contention, as a general principle, that constraints placed on a computer game which are programmed into the machine are not rules for playing a game. To illustrate this, consider for example a computerized version of snakes and ladders where the “rules” of the game about going up ladders and down snakes are programmed into the game and are not under player control. These are constraints on the way the computer responds to player input but in my opinion they are still “rules” in the sense that they dictate how the game is played. Another example might be the (real) game of football where there are “rules” defining the game environment e.g. the layout of the pitch, size of goals etc., while other “rules” govern how teams

win and what players can and cannot do e.g. a foul or hand-ball offence results in the award of a free kick or penalty. Moreover I note that the precise wording of the exception is not limited to just “rules”, but extends to “schemes or methods” for playing games (I am aware that the wording of this provision is not exactly the same as the corresponding Article in the European Patent Convention, but it has been settled that the difference is of no significance). I was not addressed specifically on how I should interpret “schemes or methods” as opposed to “rules”, but there is no doubt in my mind that taken as a whole, the concept is broader than simply what a human being (in the shape of the player) has to do to play a game.

- 34 At one point, the agent stressed the enhanced playability afforded by the invention in making the point that patentability can be bestowed upon a device which provides pleasure to people. He argued that it is not the rules of the game which enhance playability, but rather how a machine or apparatus responds to the way in which the game is played, that is, how the player interacts with the machine. Although enhanced player satisfaction is undoubtedly desirable, it seems to me that it could be provided by the gameplay just as much as the apparatus. The game is what the player experiences and that game is largely governed by the rules within the gaming device or machine.
- 35 It was also put to me that an invention concerned with the way in which a machine responds automatically must be technical. But this begs the question of what the invention is, in fact, concerned with. In applying the test in CFPH it is first necessary to determine what the advance is. I do not believe I have to conclude that just because the invention is implemented on a computer which responds to a user, the advance must necessarily be in a technical domain. This would be to exalt form over substance.
- 36 A further argument put to me was that the inventions do not involve algorithms, since they could be carried out in a mechanical way (although there is no suggestion of this in the respective descriptions). I think this is perhaps a somewhat narrow view of an algorithm as in the full sense of the word an algorithm is merely a complex set of instructions. But in any case I do not think it is of much help here, as to perform the claimed inventions the responses of the system would have to be defined in some way irrespective of how the system is put into practice. Such considerations do not advance the determination of whether the behaviour of the system amounts to a “rule, scheme or method or playing a game”.
- 37 In the light of my conclusions regarding these generally applicable arguments, I shall now proceed to look at each case and come to a view on whether the advance lies in an excluded area.

## **Discussion of the individual applications**

### **GB0411821.2**

- 38 This is the application that is concerned with making unused bonus entries available to a player for use in future bonus games. In the agent’s submission,

the problem the invention seeks to solve is that

“ ... when you are trying to get a machine to pay out, it is normally set to pay out a certain amount of what comes in. And there are various schemes for doing that. What actually occurs is, in these linked ones the bonus is also set to be fairly random, and will come out at certain times. However, if it comes out merely randomly as to whether someone is playing or not at the time, then the payout rate is not proportional to the amount of money put in at each machine. So the problem is that the payout from the bonus game doesn't match the payout rate of the machines as a whole. This invention sets out to address that problem: to try and make the machines pay out in a more balanced manner when they are linked together.”

39 By allocating bonus entries to each player and storing them, payout can be balanced over a set of gaming devices or machines. It was put to me that these balancing features are automatically carried out by the machine and are therefore clearly technical. A cat could play the game simply by pressing the buttons.

40 I imagine a cat could indeed operate the gaming device and it would function, but surely that is because the machine has been programmed with the rules of the game. I do not see that argument as advancing the issue very much. A cat would presumably not derive the same pleasure as a human from the experience, but the game will still be governed by the machine.

41 The agent emphasised that the advance relates to the response of a machine, that is how it reacts to inputs be it either from a player or from a machine generated event such as triggering event for example the start of a bonus game. This is not however the same as saying what the advance actually is. In the Official letter dated 3 April 2006 the examiner suggested the advance to be a

“system of gaming devices and a controller which tracks and stores entries of the users of the gaming devices in which when a triggering event occurs a bonus game is initiated and for each eligible player any entries generated by the player during a current bonus round, some entries generated prior to the bonus round (past entries) and some future entries are placed into an entry pool. While, for non-eligible players the entries generated during the current bonus round are designated past entries, the controller determining the eligibility of the players.”

42 This was not contradicted by the agent and seems very reasonable to me. Of course this assessment was made on the basis of the claims as they stood at that time but I consider that the incorporation of the subject-matter of former claim 10 into claim 1 merely introduces the step of transferring credit at the end of the game and has no bearing on the advance as set out above. I shall therefore take this as the advance for the purposes of the CFPH test.

- 43 Clearly this advance is effected within the system and is not under the control of the player. It does however concern the way the game is played and is not in my opinion a technical advance in the user interface. The objective of achieving a more balanced payout is achieved through the way the game is played. This may make it a better game, but it does not alter the fact that it is still a game which happens to be implemented on a computer system.
- 44 It was conceded by the agent that the basic apparatus of networked gaming machines is well known. It appears to me then that the tangible integers of claim 1, that is, the various controllers detecting events and initiating the gameplays, are also essentially conventional and their function in claim 1 is governed by the progress of the game in which the player or players are involved.
- 45 I therefore consider that the advance of the invention of claim 1 lies in the excluded field of a scheme, rule, or method for playing a game.
- 46 The examiner also objected that the advance related to a business method, computer program or mental act.
- 47 Although there are business aspects involved, the *raison d'être* partially being to regulate payouts across a network of machines, I do not consider that the advance as expressed above can be said to relate to a business method.
- 48 As regards the computer program objection, there is no dispute that a computer program is involved in making the machine react as it does, but again I do not think the essence of the advance as expressed above can be said to relate to a computer program as such.
- 49 Although the rules of any game are processed in the mind of the player, the advance in this case is all about what happens at certain points in the gameplay and I do not think that it can be considered to amount to a mental act.
- 50 The description includes substantial technical details, but these appear to relate to conventional components configured to play games. I cannot see any possible amendment which could overcome the basic flaw in the application set out above.

#### **GB0413162.9**

- 51 This is the application in which the player can select between first and second bonus events shared between several gaming machines.
- 52 The agent began by making the general point that the applicants do not seek to patent the rules of the game, or even the player interactions with the game, but rather how the machine reacts to events in the game. He went on to say that the invention has physical features deciding which draw takes place and at what time. The advance, in the agent's view, is the provision of controls which influence a game according to game events and inputs from a player or players. This addresses the need to make the bonus game more interactive.

- 53 Although claim 1 undoubtedly defines various features which are physical and tangible, such as the various controllers, these are merely standard items of hardware which are programmed to carry out the game functions. I therefore conclude that those controls are part of the gameplay.
- 54 In my view the advance lies in the way the machine sets constraints on whether and when the user is allowed to join the bonus game and on what happens in the bonus game. Given that these constraints affect the progress of the game then this points to the conclusion that they are the rules of the game. The physical features which make these decisions are the various controllers (as defined in claim 1 and the subordinate claims) which are programmed to carry out the game functions. If they are in substance defined from the game functions then they would also relate to the scheme, rules or method of playing the game.
- 55 Is the reaction or response of the machine to a gameplay event a rule? The reaction of the machine and its capacity to do certain things in response to the choice of the player may be physical but they are dictated by the gameplay. In my view if the machine stores constraints that dictate its response those can be considered as within the ambit of a scheme, rule or method.
- 56 As with the other applications, the agent contended that the application relates to the interface between player and machine. Although claim 1 sets out a number of features relating to how the machine reacts to various inputs from the player and the game, those features are really defining how the machine responds to game features. I think that it is not quite accurate to refer to that as the interface between the player and the game.
- 57 I therefore conclude that the invention claimed in claim 1 relates to a scheme, rule or method for playing a game.
- 58 Much of the description is concerned with the details of how games are played. There is a number of subordinate claims which include many references to the functions of various controllers and how they are programmed to react to different events. However all are subject to the same basic flaw as set out above and I cannot see any possible amendment which could save the application.

#### **GB0229511.1**

- 59 This is the application in which the bonus game entails the issue, and acceptance or rejection, of challenges between players.
- 60 The agent submitted to me that the invention involves how the machine reacts to these various steps of the game. There are two different modes of response of the machine according to whether the challenge is accepted, or rejected: if the challenge is accepted its result is determined, or alternatively if the challenge is rejected the player suffers by way of loss of credits. He went on to say that the essential features are firstly to determine whether a player can

enter a bonus game, then there is the initial challenge issued from one player to another, supervised by the machine, the machine then tracks acceptance or rejection of the challenge, and finally the machine determines the outcome of the challenge and pays out (although I note that the payout does not form part of claim 1).

- 61 I was referred to the EPO decision in IBM T0115/85 in which it was held that giving visual indications about conditions in an apparatus is a technical problem. Although the present claim 1 only has visual indication in the sense of display of the outcome of a challenge, the agent considered this decision to be relevant particularly because the controls provided by the invention are physical. The agent also proposed IBM as a good example of the difference between the rules of the game and the challenge. The rules of the game are the challenge process and what the applicant seeks to protect is the response of the machine to the challenge. That is the dividing line according to him.
- 62 I think this is reading far more significance into IBM than is warranted. Firstly this is now a relatively old decision. Secondly it is concerned with the exclusion of computer programs rather than games and the technical subject-matter is far removed from the present application. I do not find this decision very helpful in determining the essential question in this case which is whether the advance comprises a method scheme or rule for playing a game.
- 63 When I asked the agent to explain what he thought the advance was he responded that it was the tracking of the challenge, providing the functionality for a payout, and having two modes to dictate the response of the machine, that is, challenge and acceptance or challenge and rejection.
- 64 There does not seem to me be anything technical about these two modes, the feature being essentially defined by the gameplay, as there would have to be provision for rejection of the challenge. I agree that the invention relates to how the machine reacts, but to me that reaction is entirely dependent on the challenge and acceptance/rejection rules of the game.
- 65 I accept the agent's assessment of the advance, which is concerned with the responses of the machine to the various gameplay events, particularly setting the bonus game off on the issue of a challenge, tracking the challenge and then noting the result. However, it appears to me that the progress of the game could be managed manually. The start of the game by issue of the challenge, tracking acceptance/ rejection and displaying the result could all be achieved by a set of players or by referees. This points me to the conclusion that the advance is in aspects of the gameplay.
- 66 Claim 1 specifies a system including a network of gaming machines, but such a network is acknowledged to be well known, so it is not clear what sets this network apart except for the nature of the game.
- 67 As regards whether the advance is a computer program, there was little discussion of this other than to say that there is a program inside the machine controlling its responses. I think in this case that the "advance" could largely be



carried out by a human operator in the manner of a game referee. Applying the "little man" test set out in CFPH therefore leads me to the conclusion that the advance is not a computer program as such.

- 68 I therefore conclude that the invention claimed in claim 1 relates to a scheme, rule or method for playing a game.
- 69 The description contains technical details as well as details of how games are played. There are claims subordinate to claim 1 which include many additional features. However all are subject to the same basic flaw as set out above and I cannot see any possible amendment which could save the application.

### **GB0411822.0**

- 70 This is the application in which the bonus game is ongoing and a player can enter and leave while the game continues. I shall include a rather fuller history of the proceedings here as I think it will be helpful as background.
- 71 The claims as originally filed, corresponding to those filed in the WO application on which this application is based, related to conducting an ongoing bonus game. The examiner's first examination report dated 19 November 2004 on the basis of the claims as originally filed included objections relating to inventive step and also noted that if claims were filed agreeing with new claims filed in the proceedings of the corresponding US application, then a further search fee might be required and patentability objection may also occur.
- 72 In the event claims the same as those extant in the US application were filed with agent's letter dated 17 May 2005. Not surprisingly given his earlier warning, the examiner issued a further examination report dated 7 June 2005 saying that the claims were not patentable as they related to excluded matter. He also objected that the claims added matter as they were not supported by the originally filed description.
- 73 The agent responded with letter dated 8 August 2005 which reintroduced certain features of the original claim 1 to attempt to address the examiner's objections. A further examination report issued on 5 September 2005 reiterating the added matter and patentability objections. This report reflected the change in Office practice following the CFPH decision. An inventive step objection was also added as the claims had moved back towards those originally filed.
- 74 The agents responded with comments but offered no amendments at that time. Following further correspondence (in the course of which a new citation was introduced in support of the inventive step objection), the added matter objection was resolved but the other objections remained and this hearing was appointed.
- 75 As remarked above, at the hearing a further set of claims was offered involving the incorporation of the subject-matter of claim 4 into claim 1. The effect of this amendment would be to introduce further features concerned with the

participation of other players in the bonus game. I was asked to consider these as an alternative to the claims on file in the event that I found claim 1 to be unacceptable.

76 I shall consider first the objection of lack of inventive step. The citations relied upon by the examiner are as follows:

CA2270062 (ACRES);

WO98/51384 (ARISTOCRAT); and the internet citation

[http://en.wikipedia.org/wiki/Teenage\\_Mutant\\_Ninja\\_Turtles\\_\(arcade\\_game\)](http://en.wikipedia.org/wiki/Teenage_Mutant_Ninja_Turtles_(arcade_game)), which I shall refer to simply as TMNT.

77 In the view of the agent, ACRES is a bonus game played in sequence, that is, each game is shut down when finished so there is no continuous nature of the game. In the game disclosed in ARISTOCRAT, the agent pointed out to me that at least two players are needed, and once started the players cannot enter or leave the game. It was put to me that there is nothing in them that would lead the skilled worker to combine them. They are two different types of game so their combination would be speculative, in other words, this is a “could” situation rather than a “would”.

78 When considering TMNT the agent queried the reliability of Wikipedia as it is an open encyclopedia that can essentially be added to or amended by anyone. I think however that the consensus was that the information in TMNT was so well known that it was common general knowledge at the priority date of the application, so we need not consider the accuracy of Wikipedia here.

79 The agent continued by saying that the action in TMNT is not implemented as a bonus game, and relies on there always being someone participating so it is not possible to just “dip in and out”; there is therefore no reason to combine TMNT with either ACRES or ARISTOCRAT.

80 The examiner pointed out that to me that the present application does envisage that the game could be carried out on a single machine (paragraph 0036) and also that the bonus game can be carried out for a limited time (paragraphs 0012 and 0042), which suggests that the bonus game is not totally continuous. However, I do not think this makes much difference to my deliberations. It is clear that the bonus game must eventually end. The important thing is that it continues after entry or exit of a player as opposed to a new game starting every time.

81 The Windsurfer test requires me first to identify the inventive concept. That is set out in claim 1, but I shall summarise it as a gaming system running a continuous bonus game which the players can enter and exit when they like, the system comprising a gaming machine which displays an associated image, parts of the image being altered when a player or players qualify for the bonus game and when a player or player exits a bonus game.

- 82 Next I must assume the mantle of the skilled addressee, which I take to be a designer of gaming systems. I consider that the designer will have knowledge of both current gameplay and of the associated hardware, be that individual gaming machines or computers, or networks thereof.
- 83 Now what difference exists between the matter which is known or cited and the invention? Acres has a bonus round for which players qualify when they are at the head of a queue, so then, according to the examiner, the player could be said to have “qualified”. An image is altered when the user pushes a button to enter the bonus game. Aristocrat illustrates that continuous bonus games are known and this is reinforced by TMNT.
- 84 Taking Acres as my starting point, the difference lies in two aspects. Firstly the bonus game of the invention is continuous whereas the bonus game in Acres (even if regarded as the combination of the queuing system and the actual entry of the player when the head of the queue is reached) is not clearly continuous in the sense of the invention, that is that the game lasts longer than the player’s involvement. Secondly the gaming machine of the invention displays an image of which parts change when qualifying activity occurs automatically and on input from a player or players, and when a bonus game termination input is received and until qualifying occurs again. This is a more complex arrangement than disclosed in Akers.
- 85 The question is would those differences have been obvious to the skilled addressee, i.e. the game designer? Continuous bonus games were clearly known but I think there is more involved here, that is the ability to enter and exit the bonus game at will or when invited to do so by the system. It may be implicit that if a game is continuous then you have to enter or exit it, but the invention specifies how that is done, which is not disclosed in the cited prior art.
- 86 Image alteration on a change in game status is essentially trivial and I can understand the examiner’s difficulty when this was introduced. The invention however goes further in specifying several occasions on which the image changes according to the occurrence of qualification and also termination. I do not see a teaching to that level of complexity in either Aristocrat or TMNT.
- 87 If either of these differences were in isolation I would have more doubt over the existence of an inventive step but in combination they leave me to conclude on balance that inventive step is present.
- 88 I shall turn now to the objection that the claims relate to unpatentable subject-matter. Having just considered the differences between the claimed invention and the prior art for the purposes of applying the Windsurfer test, I have a good springboard for applying the CFPH test which refers to determining whether the “advance” is new and not obvious under the description of “an invention” in the sense of the EPC and Patents Act.
- 89 Accordingly, I take the “advance” to lie in the aspect of switching between a main game and a continuous bonus game, the controls to allow the selection

between modes, and the associated degrees of player involvement and alteration of parts of the image when a player is deemed to have qualified for the bonus game or when a player's involvement is terminated.

- 90 Consistent with the conclusions of the section on general discussion above, I consider that the switching over to a bonus game and the fact that the bonus game is continuous are all part of the gameplay. These aspects therefore fall within the bounds of a scheme, rule, or method for playing a game.
- 91 The alteration of parts of the image, however, is less clear cut. The mechanics of image alteration could have a technical character, but is the mere fact that the image is altered technical? I cannot find any technical disclosure in the specification regarding how parts of the image are altered, beyond the mere fact that they are altered, this being in relation to a specific exemplary game involving leprechauns and bags of gold.
- 92 To determine this question I must therefore look more deeply at what the image alteration is doing and why. It is in essence signaling to the user that a bonus game is beginning or ending. It is therefore inextricably linked with the progress of the game and its function only has meaning in the context of the game. This is in my view part of the gameplay and non-technical.
- 93 Although claim 1 includes several elements of hardware, notably a display parts of which are altered when a change of mode or gameplay occurs, I consider that to be the form of the invention and the substance to be the continuous bonus game and indication of the initiation and conclusion of the bonus game for a player or set of players.
- 94 I therefore conclude that the advance as a whole falls under the category of a scheme, rule or method for playing a game.
- 95 I turn now to the alternative claim based on the earlier claim 4 when appended to claim 1. Setting aside the fact that this includes a single player configuration within its scope, I consider that the introduction of the possibility of more than one player in a system has no bearing on my assessment above and does not therefore affect my conclusion. Moreover having read the specification I can find no technical features which I believe could support a patentable claim.

### **Conclusions**

- 96 I have found that applications GB0411821.2, GB0413162.9, GB0229511.1 and GB0411822.0 all relate to schemes, rules or methods for playing games and are therefore not patentable under the terms of section 1(1)(c) of the Patents Act 1977. I have also been unable to find anything in any of the applications which could form the basis of patentable inventions. I therefore refuse the said applications under section 18.

### **Appeal**

- 97 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any

appeal must be lodged within 28 days.

**A C Howard**

Deputy Director acting for the Comptroller