

PATENTS ACT 1977

APPLICANT

IGT

ISSUE

Whether patent application number GB
0307663.5 complies with section 1(2)

HEARING OFFICER

P M Marchant

DECISION

- 1 Patent application number GB 0307663.5 entitled “Real Time Monitoring of Game Play”, was filed on 3 April 2003 in the name of IGT.
- 2 The application concerns a computer based system for monitoring gaming machines and tables in a casino. The machines and tables are networked together with a host computer. The system identifies individual players, for example by the player swiping an ID card on his gaming machine, monitors the activity of the player on the machine, and generates records of the activity, which are stored on the host computer. Awards of free games, goods or services are made to players in the light of their activity and are designed to reward the amount of money spent or the length of play, or otherwise to encourage further play. Casino staff carry portable computers linked to the system to monitor play and make awards.
- 3 The examiner indicated that the subject matter of the invention was excluded from patentability, initially in the search report of 14 August 2003 and in the examination reports of 28 February 2005, 11 August 2005, 8 February 2006, 26 July 2006 and 14 December 2006. The applicant responded, making amendments in order to address the objections and maintaining the invention to be patentable, in letters of 23 June 2005, 12 December 2005, 3 May 2006, 27 September 2006 and 5 February 2007. The Rule 34 period as extended ended on 4 February 2007. Any subsequent hearing could establish only whether the application complied with the requirements for the grant of a patent in the form in which it stood on that date. The examiner was unable to accept the applicant's submissions on patentability, and the matter consequently came before me at a hearing on 14 March 2007 at which Mr David Slattery and Mr Barry Quest of Messrs Wilson Gunn M'Caw, represented the applicant.

The invention

4 The claims were amended during prosecution, and the independent claims now read as follows:

1. *A method for remote monitoring and local reward of game play on a gaming device by a portable handheld monitoring device in communication with the gaming device over a communications link of a data network, the method comprising:*

providing the gaming device, the gaming device configured to present a game of chance, the gaming device adapted to receive a wager from a player located at the gaming device and, responsive to play of the game of chance, output a game play award,

providing game play information associated with the player at the gaming device, the game play information pertaining to play of the game of chance on the gaming device by the player;

receiving the game play information at the portable handheld monitoring device from the gaming device over the communications link of the data network;

generating a graphical representation of the received game play information;

displaying the graphical representation of the received game play information on a display of the portable handheld monitoring device;

determining, responsive to receiving the game play information at the portable handheld monitoring device from the gaming device over the communications link of the data network, an award amount for the player;

determining the location of the gaming device at which the player is located; and

outputting the award amount from an output of the portable handheld monitoring device for delivery to the player at the gaming device.

26. *A method for remote monitoring and local reward of game play on a gaming device by a portable handheld monitoring device in communication with a remote host over a second communications channel, the remote host in communication with the gaming device over a first communications channel, the method comprising:*

providing the gaming device, the gaming device configured to

present a game of chance, the gaming device adapted to receive a wager from a player located at the gaming device and, responsive to play of the game of chance, output a game play award,

providing game play information associated with the player at the gaming device, the game play information pertaining to play of the game of chance on the gaming device by the player;

receiving the game play information at the remote host from the gaming device over the first communications channel;

sending the received game play information from the remote host to the portable handheld monitoring device over the second communications channel;

generating a graphical representation of the received game play information at the portable device;

displaying the graphical representation of the received game play information on a display of the portable handheld monitoring device;

determining, responsive to receiving the game play information at the portable handheld monitoring device from the remote host over the second communications channel, an award amount for the player;

determining the location of the gaming device at which the player is located; and

outputting the award amount from an output of the portable handheld monitoring device for delivery to the player at the gaming device.

29. A system for remote monitoring and local reward of game play comprising:

a gaming device configured to present a game of chance, the gaming device adapted to receive a wager from a player located at the gaming device and, responsive to play of the game of chance, output a game play award, the gaming device capable of providing game play information associated with the player at the gaming device, the game play information pertaining to play of the game of chance on the gaming device by the player;

a remote host in communication with the gaming device over a first communications channel, the remote host configured to:

i) receive the game play information from the gaming device over the first communications channel, and

ii) send the received game play information; and

a portable handheld monitoring device in communication with the remote host over a second communications channel the portable handheld monitoring device configured to:

i) receive the game play information from the remote host over the second communications channel,

ii) generate a graphical representation of the received game play information.

iii) display the graphical representation of the received game play information on a display of the portable handheld monitoring device,

iv) determine, responsive to receiving the game play information from the remote host over the second communications channel, an award amount for the player,

v) determine the location of the gaming device at which the player is located, and

vi) output the award amount from an output of the portable handheld monitoring device for delivery to the player at the gaming device.

5 Appendant claims 2 to 25, 27, 28 and 30 to 42 cover further limitations to the methods of claims 1 and 26.

The Law

6 The hearing was convened to assess whether the invention relates to matter excluded by section 1(2) of the Act and is therefore unpatentable. The provisions in the Act relating to excluded matter are well known and are set out in section 1(2). The approved approach to determine whether matter is excluded is the four part test recently handed down by the Court of Appeal, in the *Aerotel and Macrossan*¹ case. The steps are as follows:

- a) Properly construe the claim
- b) Identify the actual contribution (or, per paragraph 44 of the judgment, the alleged contribution will do at the application stage)
- c) Ask whether it falls solely within the excluded subject matter

¹ *Aerotel Ltd v Telco Holdings Ltd and Macrossan's Application* [2006] EWCA Civ 1371, [2007] RPC 7

d) Check whether the actual or alleged contribution is actually technical in nature.

- 7 Paragraph 46 of the judgment adds that the fourth step may not be necessary because the third step may already have covered the point. This part of the test is in effect a longstop, to be invoked where the invention passes the first three steps.
- 8 Mr Slattery contended that the examiner had been wrong to apply this test. He said it was inappropriate since the invention was concerned essentially with an arrangement of hardware. I do not think that can be right. It would be an odd kind of test that would not provide the right result if applied to unequivocally patentable subject matter. I think it can be applied in the present case and will proceed to do so.
- 9 Section 130(7) of the Patents Act states that section 1(2) is so framed as to have, as nearly as practicable, the same effect as the corresponding provisions of the European Patent Convention. As a result, relevant decisions of the Boards of Appeal of the European Patent Office should generally be given due consideration, though they are not binding. Mr Slattery referred to two EPO Board of Appeal cases to support his contention that structured displays are technical in nature. However, since recent Board of Appeal decisions were fully considered by the Court of Appeal in *Aerotel and Macrossan*, it is currently appropriate to rely solely on that judgment. In the event, the nature of the display in the present case does not appear to be determinative in assessing patentability.

The present case

- 10 The first *Aerotel and Macrossan* step is to construe the claims. I do not think there is any uncertainty about their scope. In each case they define a gaming device connected to a portable hand held device by a data network over which game play information generated at the gaming device is sent to the portable device. The portable device represents the game play information graphically, and outputs an award amount based on the game play information for delivery to the player at the gaming device. I understand the “award amount being output from the portable device” to refer primarily to the electronic output of the amount by the device. This may be translated into a physical output in the form of a ticket or voucher either separately from the portable device or by means of a printer integral with it. The arrangements defined in claims 26 and 29 also involve a remote host (ie a computer) which receives the game play information from the gaming device and sends it to the portable device.
- 11 The second step is to identify the contribution which the invention makes to the art. The examiner cited a number of prior art patents which establish, in some part at least, what was known. US 5761647 appears the most relevant disclosure in the area of gaming. It relates to a system for tracking customer activity at casinos. Concentrating on the most relevant aspects of the disclosure;

a player's gaming activity at a slot machine or table is monitored. This information is accumulated in a central database and is communicated to other terminals and other casinos over data networks. Customer data summaries, for example, accumulated points earned through game play, can be sent to casino employees at gaming tables where customers are currently playing so that the employee can determine whether the customer should qualify for an award.

- 12 This does not disclose the use of a portable handheld device by casino staff as is required by the present claims. In the prior specification, a member of casino staff receives similar information but it is not disclosed on what type of device the information is received.
- 13 I do not think that the use of portable devices per se, or in connection with a network, was new at the priority date and I did not understand the applicant to suggest that it was. Indeed the specification provides an example of an off-the-shelf portable device for use with the system. The examiner in his report of 26 July 2006 cited an article which discusses the wireless connection and data transfer capabilities of "Pocket PCs" produced by a number of manufacturers before the priority date. Examples of the different applications in which pocket PCs are used include their use by waiters in restaurants for ordering food, by healthcare professionals for drug delivery to patients, for provision of real-time stock quotes to financial businesses, and general applications such as order entry, inventory management, procurement, materials management, and provision of customer management information. It is clear that wireless network connected portable PCs were known at the priority date and used in a wide range of different applications.
- 14 The prior specification also does not disclose that the information is displayed "graphically". However, it is not clear what "graphically" means in the present specification. The text gives as examples of graphical display; "graph, table, text" and "coloured icon or symbol", of which one example is a symbol of a chilli pepper, and also a "pie or bar graph". The figures, in the main, show tables of data. This all looks conventional. I do not think "graphically" can mean any more than that the data must be in some form that the user can read and understand. Consequently I do not think there is any distinction over the prior art arrangement which must also have data displayed in some accessible form.
- 15 The award in the prior art must be generated in some way from the staff member's consideration of the game play data. I am not certain whether the requirement in the present claims that the award is output from the device involves anything new or different, but will allow that it may do in assessing the contribution.
- 16 There was discussion at the hearing that the portable device according to the invention was distinguished by identifying the location of the player. In fact it does not identify location at all; it sends information to the staff member (such as the identity of the gaming machine that the player is using) so that the staff member can identify the location of the player. The prior art also does this: information about the player is sent to the terminal of the staff member, and the staff member locates the player as playing on his table. The invention does not involve identification of location as such, but it may differ from the prior art in that

the staff member is able to identify players at different machines, not just the table at which the staff member is working.

- 17 What contribution does the invention make to the art? It amounts to the use of a known hardware configuration to perform certain functions (providing information for staff to locate players and output award amounts) in the field of casinos and gaming devices. The third step of the Aerotel/Macrossan test requires the question to be asked whether this falls solely within excluded matter and I believe it does. The use of known hardware to enable staff to locate players and to output award amounts, relates to the business operations of the casino and consequently falls within the excluded subject matter as being for a method of doing business. The fact that this particular hardware configuration gives advantages when used for this purpose does not affect that determination. If hardware is known, its use in a particular business operation, however advantageous, does not render the whole arrangement patentable.
- 18 It is not necessary to apply the fourth step since I have already found the invention to be excluded under the third step.
- 19 In conclusion, I have found that the invention is excluded from patentability because it relates to a method of doing business contrary to section 1(2), and I therefore refuse the application.

Appeal

- 20 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

P M Marchant

Deputy Director acting for the Comptroller