



that this is more entertaining for the player.

- 5 The application currently has 21 claims, of which claims 1, 10, 13, 15 and 21 are independent. Claim 1 is as follows:

A method of conducting a wagering game, comprising:  
receiving a wager to play the wagering game;  
displaying an array of symbols on a plurality of mechanical reels; and  
if the array includes a symbol combination that yields an award, identifying the symbol combination with an animation that varies with a level of the award by superimposing a video image in front of the symbols forming the symbol combination.

- 6 Claims 2-20 fall within the scope of claim 1 and generally detail the nature of the awards or conditions for further animations

- 7 Claim 21 was added to the application shortly before the hearing, and is a corresponding apparatus claim:

A gaming machine arranged to provide a wagering game, comprising:  
a plurality of mechanical reels each bearing a plurality of symbols; and  
a display device arranged to superimpose a video image in front of the mechanical reels;  
wherein the gaming machine is arranged to  
receive a wager to play the wagering game;  
display an array of symbols using the plurality of mechanical reels; and  
if the array includes a symbol combination that yields an award, identifying the symbol combination with an animation that varies with a level of the award by superimposing a video image in front of the symbols forming the symbol combination using said display device.

## The Law

- 8 The examiner has reported that the invention is excluded from patentability under section 1(2)(c) of the Act as relating to a program for a computer. 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) ...  
(b) ...  
(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.”

- 9 My approach to interpreting section 1(2) will be governed by the judgment of the Court of Appeal in *Aerotel Ltd v Telco Holdings Ltd (and others) and Macrossan's Application* [2006] EWCA Civ 1371 (“*Aerotel*”). In that judgment, a four step test was set out which can be summarised as:

- (1) properly construe the claim
- (2) identify the actual contribution
- (3) ask whether it falls solely within the excluded subject matter
- (4) check whether the actual or alleged contribution is actually technical in nature.

10 As noted by Mr Kenrick at the hearing, and confirmed in *Symbian's Application* [2008] EWCA 1066 the Court of Appeal in *Aerotel* was not putting forward a new test, but rather reformulating the “technical contribution” test established in its judgment in *Merrill Lynch* [1989] RPC 561 (“*Merrill Lynch*”):

“Ask whether the invention as defined in the claim makes a technical contribution to the known art – if no, Article 52(2) applies. A possible clarification (at least by way of exclusion) of this approach is to add the rider that novel or inventive purely excluded matter does not count as a ‘technical contribution’.”

11 Thus, an invention which makes a technical contribution lies outside the exclusions in Section 1(2) – and conversely, inventions which make a contribution lying solely within the exclusions (as considered in *Aerotel* step 3) do not make a technical contribution. Step 4 of *Aerotel* ensures that an invention making no technical contribution is still excluded even if it does not fall within the (non-exhaustive) list of exclusions explicitly listed in section 1(2). (At the hearing, Mr Kenrick referred to *Lux Traffic Controls* [1993] RPC 107 as an example of such a case).

## **Arguments and Analysis**

### Construction of Claims

12 At the hearing, Mr Kenrick primarily argued on the basis of claim 21. However, he explicitly indicated that the applicant considered all the claims to make the same contribution as the methods claimed in the other claims could only be carried out by an apparatus falling within claim 21. I accept this argument. He explicitly disclaimed any argument that claim 21 might be patentable while the others were not – the claims would stand or fall together.

13 Mr Kenrick focused on the claim as defining the scope of the monopoly. He considered the applicant to be asking for a patent for an improved gaming machine having a plurality of mechanical reels, and the gaming machine being arranged to use a particular sort of display device to operate the gaming machine in a particular way. This was claimed directly in claim 21 and its method of operation in the other claims.

14 I accept this construction.

### Contribution made by the invention

15 Mr Kenrick emphasized the need to look at the invention as a whole in

determining the contribution, contrasting this with the reasoning of Falconer J below overturned by the Court of Appeal in *Merrill Lynch*. In particular, he argued that it was very important to look at the contribution as a whole, rather than simply looking at the individual changes made to the prior art.

16 Specifically, Mr Kenrick argued that the contribution was “an improved gaming machine in which a user’s interest is maintained by displaying an animation in connection with a symbol combination, the animation varying with the level of the award.”

17 During the hearing, I summarized part of the applicant’s argument as

“you make a better gaming machine: you have a gaming machine that is more interesting to play and therefore does its job as being a gaming machine better than previously.”

Mr Kenrick agreed with this, and the later correspondence from the applicant quotes it approvingly.

18 I think this argument goes too far. It does not seem to me to truly capture what the court in *Aerotel* (paragraph 43) referred to as “what has been added to human knowledge”. As Mr Kenrick argued, this goes beyond simply what has been added to the prior art. In the present case what is added to human knowledge is that the use of certain animations makes the game player more interested. But the invention tells us nothing new about the physical nature of gaming machines – the applicant acknowledges that all the physical features (in the preamble to claim 21) are known

19 I therefore find the contribution to be “an improved game in which a user’s interest is maintained by displaying an animation in connection with a symbol combination, the animation varying with the level of the award.”

#### Whether the contribution falls wholly within excluded matter

##### *Presentation of Information*

20 Mr Kenrick argued that although the presentation of information is excluded, a method for presenting information is not. Specifically, he argued that the nature of the information presented falls within the exclusion (from *Crawford’s Application* [2006] RPC 11), and the idea of providing additional information is excluded (from *Townsend’s Application* [2004] EWHC 482). Similarly, in the later submissions the applicant argued that *Autonomy Corporation’s Application* [2008] EWHC 146 taught that where and how to display information on a computer screen was a presentation of information.

21 By contrast, the present application provided a method for presenting information – display a different animation depending on the level of the award. This is not about the content of the information (the animation is not specified), nor is it the idea of displaying information.

22 Mr Kenrick drew an analogy with a modified pinball machine. A prior art machine might have one arm which came up to present a message – e.g. a prize has been won. A new machine might have two arms which came up in different

circumstances. The idea of two arms, if new, would, he argued, be patentable.

#### *Scheme rule or method for playing a game*

- 23 The applicant argues that the wagering game itself is unchanged. That is, the rules of the wagering game and the way in which the wagering game is played in terms of actions on the part of the player is unchanged. Therefore, the applicant argues, the way the game is played is not part of the contribution, which instead relates solely to the apparatus used to play the game. The way in which animations are displayed in the claimed invention does not relate to a scheme rule or method for playing a game but rather to an improved tool for playing a known game.
- 24 The applicant buttresses this argument by noting that the rules of the game are not claimed in claim 21 – the wagering game is purely general. The applicant again refers to the modified pinball machine mentioned above. In such a machine, the applicant argues, the game of pinball is unmodified – it is only the apparatus used which changes.
- 25 A further analogy is drawn with *IGT's Applications* [2007] EWHC 1341 in which a hypothetical “bendy bat” was discussed (paragraphs 24 to 28). The point is that a variant of cricket using a bendy bat would be excluded, but a bendy bat might not be. The applicant argues that the present improved machine is a “bendy bat” rather than a way of using it.

#### *Technical contribution*

- 26 The applicant made a number of arguments based on a decision of the Technical Board of Appeal of the European Patent Office, T0717/05 *Labtronix*. This case related to a gaming machine that had a main game and a bonus game and related to the way in which a user could be informed of the way in which the two games interacted by displaying information on the status of the bonus game while the user was playing the main game.
- 27 From this, the applicant argued that improved ways of operating a gaming machine are patentable, and that in particular maintaining a player’s interest through his participation in a primary game was a “technical problem”. The applicant argues that this is on all fours with the present application.

#### *Analysis and findings*

- 28 Ultimately, what I need to determine is whether the contribution I have found above falls solely within the exclusions, or whether it is by contrast a technical contribution.
- 29 Regarding presentation of information, I am persuaded that the contribution is not wholly presentation of information. Mr Kenrick appears correct that the key point is not that information is displayed, but that *something different is done depending on what level of award is won*. The something different is, of course, that an animation is provided on a screen and this, at least indirectly, presents the information that a certain amount has been won, but that is not the entirety of

the contribution.

- 30 Regarding the exclusion for a “scheme, rule, or method for playing a game”, I find the applicant’s construction of the exclusion to be too narrow. In particular, I do not accept that providing the different animations do not affect the way the game is played. They affect the player’s experience, and thus make the game, to a certain extent, a different game. The fact that the player may have precisely the same options for actions is neither here nor there. Likewise, the fact that irrelevant (to the invention) rules of the wagering game are not specified is simply a matter of (legitimately) broad claim drafting: that rules unaffected by the invention are unchanged does not mean the game as a whole is unchanged.
- 31 I am equally unconvinced of the helpfulness of hypothetical analogies such as the pinball machine and the bendy bat. It seems to me clear that the contribution is an improved game – the fact that the game must be physically embodied does not of itself overcome the exclusion.
- 32 It therefore seems to me that the contribution lies fully within the exclusion relating to a scheme rule or method for playing a game, although some aspects of it could be alternatively characterized as the presentation of information. In any event, I find that there is nothing in the contribution which does not fall within either of these two categories.
- 33 Putting this another way, I do not consider the contribution made to be a technical one.
- 34 As noted above, I agree with the applicant that the benefit conveyed by the invention is heightened interest for the player. I can conceive of situations in which this heightened interest comes from some technical improvement in the gaming machine as such – for example, an improvement in the gearing of the spinning reels which made them rotate more smoothly. Such an invention would seem to provide a technical contribution. But this is not such a case. The applicant acknowledges that the technology of the machine is well-known – in particular, it is known to use gaming machines which use video screens to display animation. Here, the gaming machine has not been improved in any technical sense – it is just that a more interesting game is being delivered through standard gaming machine technology.
- 35 The *Labtronix* case does not dissuade me from this view. It is far from clear to me precisely what relevant principles can safely be drawn from this single case and how these necessarily apply to the present one. In any event, despite the persuasive authority of EPO decisions, I am bound to follow UK law and in my view UK law permits only the answer I have given.
- 36 I therefore find the contribution relates solely to a scheme rule or method of playing a game and/or the presentation of information. Hence claim 21 is excluded from patentability.

Check that the contribution is actually technical

- 37 As I note above, I do not consider the contribution to be technical.

## **Conclusion**

- 38 I find that the invention as claimed in claim 21 of this application is excluded from patentability under section 1(2) as a scheme rule or method for playing a game and/or the presentation of information. As conceded by the applicant, this means the other claims are likewise excluded. Having read the whole specification, I can see no way in which the application could be amended to avoid the exclusions. I therefore refuse the application in accordance with section 18(3).

## **Appeal**

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

**J ELBRO**

Divisional Director acting for the Comptroller