

series” bets. It is not disputed that these are merely different names for tier and voisin bets. The voisin bets are not the same as the “voisin plus one” bet in the present invention (in which the number 1 is added to a voisin bet for reasons explained below).

- 5 However, the particular disposition of these betting locations differs from that in the invention, and, as emerged at the hearing, the applicant regards this as a matter of some significance. In *Matosevic*, locations 96, 98 are provided twice, one each in both the top left and bottom left corners of the layout. In *Stargames*, the locations 215, 217 are part of a row of touch buttons below the layout on a screen.
- 6 In his letter of 9 November 2005 proposing the above claim, Mr Egerton explained that the layout of the invention provided regions for players to place their own tier and voisin bets - rather than giving them to the dealer as in known games with the attendant risk of the dealer being distracted if he had to give change as well as place chips and thereby leaving himself open to the risk of players cheating. Further, known tier and voisin bets were six- and nine-chip bets respectively, and, with the usual minimum of £5 per chip, had to be bet in multiples of £30 and £45. However, in the invention, single-chip bets could be placed for the minimum of £5 and thereafter in increments of £1. Then, instead of the dealer placing £5 from the minimum bet and paying at 17 to 1, tier bets would be paid at 2 to 1 and voisin bets would be paid at evens (after the addition of the number 1 – hence “voisin plus one” - to make this mathematically possible).

Patentability

The law

- 7 The examiner nevertheless maintained that the invention was excluded under section 1(2) of the Act, the relevant parts of which read (emphasis added):

“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 –

...

(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 purposes of this Act **only to the extent that a patent or application for a patent relates to that thing as such.**”

- 8 As explained in the Patent Office’s notice of 29 July 2005 “Examining for patentability”, the question whether an invention is excluded under section 1(2) is now to be determined in accordance with the two-part test in *CFPH LLC’s Application* [2005] EWHC 1589 (Pat), [2006] RPC 5, which can be summarized as

- Identify the advance in the art which is said to be new and not obvious (and susceptible of industrial application).
- Determine whether it is both new and not obvious (and susceptible of industrial application) under the description of an “invention” in the sense of Article 52 of the European Patent Convention – which section 1(2) reflects.

Arguments

- 9 In the correspondence before the hearing, the examiner maintained that the advance lay in the addition of a new type of bet, the “voisin plus one”, and was wholly within the exclusion of schemes, rules or methods for playing a game. As he reminded the applicant, the patentability of games was no longer to be determined in accordance with the Official Ruling 1926 (A) following the decision of the court in *Shopalotto.com Ltd’s Application* [2005] EWHC 2416 (Pat), [2006] RPC 7. The change of practice has since been confirmed in the Office’s notice of 25 November 2005 “Patentability of games”.
- 10 At the hearing Mr Egerton referred me briefly to *CFPH* and other recent case law¹ on section 1(2) to show that there was no reason of public policy for games to be excluded from patentability provided there was a “technical” contribution. Thus although the Deputy Judge’s comment at paragraph 38 of *CFPH*

“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. 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 that which will be made and supplied commercially.”

was obiter, it was nevertheless consistent with the rest of his judgment. Mr Egerton also reminded me that in my decision in *Acres Gaming Incorporated* BL O/112/06 I had accepted (paragraph 24) that I ought not to give the exception of section 1(2) an over-broad scope. Thus far I am in general agreement with Mr Egerton, and so I do not think that I need to go through this case law in any detail.

- 11 However, developing the argument outlined in his letter mentioned above, Mr Egerton disagreed with the examiner as to where the advance lay for the purposes of section 1(2). He considered that as matter of substance it lay in a

¹ *Halliburton v Smith International* [2005] EWHC 1623 (Pat), [2006] RPC 2, *Shopalotto.com Ltd’s Appn* [2005] EWHC 2416(Pat), [2006] RPC 7, *Crawford’s Appn* [2005] EWHC 2417 (Pat), [2006] RPC 11, *Inpro Licensing SARL’s Patent* [2006] EWHC 70 (Pat), [2006] RPC 20, *Macrossan’s Appn* [2006] EWHC 705 (Ch)

new layout allied to a specific purpose, which could not be regarded as simply a scheme, rule or method for playing a game. That purpose, as I understood it, was to achieve greater security against cheating by allowing players to place the tier and voisin plus one bets themselves instead of giving them to the dealer. This was possible because of the locations 11, 12 both being on the left hand side of the board on the opposite side from the dealer. This also had the advantage of reducing the number of chips, because the bet could be placed as a single chip rather than as a six- or nine-chip bet in the case of current layouts.

- 12 Mr Egerton saw the combination of layout and purpose as providing a technical contribution and drew an analogy with *Fishburn's Application* 57 RPC 245. In that case, the printing of information on a ticket, so that if divided either transversely or longitudinally each part would contain identical information, was held to serve a "mechanical" purpose and to constitute a "manner of new manufacture" under the legislation then in force. The Office's 'Manual of Patent Practice' at paragraph 1.31 opines that this case would apparently not be excluded under section 1(2)(d) as relating solely to the presentation of information.
- 13 Also, Mr Egerton, as I understood it, took the view that following *CFPH* a combination of a physical layout with a method for playing a game would suffice to stop the invention from being about the rules of a game as such. However, the examiner pointed out that, as was apparent from the 1926 Official Ruling, games layouts in themselves had never been patentable even though they could be used in new ways. He was not convinced that the invention was about anything more than a layout, and that following *Shopalotto* it was not patentable.
- 14 I observe that the proposed claim has some similarities in form with those previously accepted under the Official Ruling. It is I think a moot point whether the Ruling could have had any relevance to the present situation, since it covered only those games where playing pieces were moved on a marked board in accordance with specified rules. However, this is not something that I need to pursue, since Mr Egerton confirmed, in response to my question at the hearing, that he was not seeking to argue his case on the basis of the Ruling.

Conclusion on patentability

- 15 I do not think that I need to decide generally what types of game would now be patentable in the light of *CFPH* and *Shopalotto*. However, in the present case, even if I accept that the advance is something more than the addition of a voisin plus one bet to known roulette games and is something more than just a new layout, I am not convinced by Mr Egerton's argument.
- 16 It is well established that in considering whether an invention is excluded under section 1(2) it is the substance of the invention which is important, and an unpatentable invention does not become patentable merely by claiming it in a different form. Here it seems to me that, although the invention is claimed in apparatus terms as a combination of a new bet layout with a roulette wheel

and ball, in substance the advance made by the invention is still about the way in which a game is played. In my view the alleged improvement in security and convenience of betting does not make a technical contribution or have a technical effect.

- 17 Further, notwithstanding superficial similarities, I do not think that at bottom *Fishburn* supports Mr Egerton's case. Even if the *Fishburn* ticket is not excluded under section 1(2)(d) because the arrangement of the information can be regarded making an advance in a non-excluded area, I do not think the same is true in the present case. It seems to me that anything over and above the content of the information in the layout as such relates to the way in which the game is played and therefore to a method of playing a game as such. I do not think that *Fishburn* enables the applicant to circumvent the section 1(2)(c) exclusion.
- 18 I therefore consider that the invention is excluded from patentability under section 1(2) because it relates to a method for playing a game as such. In reaching this conclusion, I am mindful that I ought to give the benefit of any doubt to the applicant. However, I do not think this is a case where there is any doubt of substance. As Mann J explained in *Macrossa's Application* [2006] EWHC 705 (Ch), this is not intended to import anything like a criminal burden of proof, and I am entitled to find that the exception applies without having to find there is no doubt at all.

Inventive step

- 19 Having found the invention to be excluded under section 1(2), I do not need to decide the secondary issue of whether the invention is obvious. In any case this point was not taken at the hearing. However, I would mention that if my finding is wrong and the invention is patentable, I do not think that it would be obvious having regard to the prior art cited by the examiner.
- 20 As I understand it, the essence of the examiner's argument is that the addition of the number 1 to the voisin bet is not inventive because it is very well known in the art of games to adjust game rules to alter the pay-out rates. Even if that is the essence of the invention, I do not think it necessarily follows that it would be obvious to make this particular modification, even it is only a small one.

Conclusion

- 21 I have found the invention to be excluded from patentability under section 1(2) because it relates to a method for playing a game as such. I have read the specification carefully but I cannot see anything which could constitute a patentable invention. I therefore refuse the application under section 18(3) of the Act.

Appeal

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

appeal must be lodged within 28 days.

R C KENNEL

Deputy Director acting for the Comptroller