

16th July 2007

PATENTS ACT 1977

APPLICANT

IGT

ISSUE

Whether patent application number GB
0417719.2 complies with section 1(2)

HEARING OFFICER

P M Marchant

DECISION

- 1 Patent application number GB 0417719.2 entitled "Apparatus and Method for Memorization Poker", was filed on 10 August 2004 in the name of IGT.
- 2 The invention is concerned with card games such as poker and blackjack in which combinations of cards make up a winning hand, and also with slot machines in which combinations of symbols make up a winning sequence. In the card game embodiments, certain cards have associated with them other, different, cards; for example the seven of hearts could be associated with the ace of diamonds. When playing the game, if the player found the seven of hearts in his hand, and was able to remember that its associated card was the ace of diamonds, he would have the option of substituting the one for the other if he felt that the ace of diamonds was a more advantageous card. Similarly with slot machine symbols, if as a result of a play, a row of symbols came up containing a symbol which the player knew had a more advantageous symbol associated with it, he could select the better symbol instead.
- 3 The examiner issued a number of reports during examination of the application, giving his view that the subject matter of the invention is excluded from patentability. The applicant argued to the contrary in a number of letters in response. The examiner was unable to accept the applicant's view, and the matter has come before me for consideration on the papers.
- 4 The examiner also reported during examination that the invention, at least as far as some of the claims are concerned, lacks novelty and inventive step. Those issues had not been resolved in the latest exchange between the examiner and the applicant, but I will not address them in this decision since they are not critical

at this stage. If I find the subject matter to be allowable, the case can be remitted to the examiner to continue consideration of the other validity issues.

The invention

5 The claims were amended during prosecution, and claim 1 now reads as follows:

1. *A gaming device comprising:
a display device;
a processor;
a memory device;
a value input device; and
a player input means;
the memory device storing a deck of cards, the deck of cards comprising a plurality of playing cards, each card comprising a face having a first value and a first suit combination selected from a first set of value and suit combinations;
the processor being operable with said display device, memory device, value input device and player input means to:
display at least one playing card of a deck of cards, the cards being dealt either with face showing or face down and later revealed to show the face;
associate a second value and suit combination with at least one first value and suit combination;
provide a hint concerning the association between said first and second combinations;
provide an option for the said card to activate the second value and suit combination that is associated with the first value and suit combination over a duration of play of the poker game; and
provide a poker evaluation using said second value and suit combination where activated.*

6 Independent claim 12 relates to a wagering gaming device having similar characteristics to the gaming device of claim 1, but in which the associations are between first and second symbols rather than cards. Independent claim 28 relates to a variation on the device of claim 1 using a normal first set of cards and a second set of cards, each of which has a first value and suit on one side and a second value and suit on the other side, where an option provides for the second value and suit of a card to be activated when a card from the first set corresponds with one side of a card from the second set.

7 Claim 36 sets out the underlying principle of the invention, and reads as follows:

- A method of operating a gaming device comprising the steps of:
generating a first symbol;
providing an opportunity to remember that the first symbol is predetermined to be associated with a second symbol for at least a number of game plays; and
providing an option to have the second symbol used in a*

decision.

- 8 Claims 40, 41 and 42 relate variously to “providing the method” of claim 36 via a data network, over an internet or on a memory storage device.
- 9 The invention also relates to real games using physical playing cards instead of electronic simulations, as is described in relation to figures 12 to 14. These variations are not claimed in the present version of the claims, so it is not clear if it is intended that they should be included within the scope of the patent, but that does not affect the determination as to patentability.

The Law

- 10 The provisions in relation to subject matter excluded by the Act are set out in section 1(2) which reads as follows:

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

- 11 The approved approach to determining whether matter is excluded is the four part test formulated 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)

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

- c) Ask whether it falls solely within the excluded subject matter
- d) Check whether the actual or alleged contribution is actually technical in nature.

12 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.

The present case

- 13 The first *Aerotel and Macrossan* step is to construe the claims. The broadest aspect of the invention is the method set out in claim 36, and the same method underlies the gaming devices claimed in the other independent claims. I take the invention to be the method of claim 36 and also the gaming devices of claims 1, 12 and 28 which operate according to the method.
- 14 The second step is to identify the contribution which the invention makes to the art. The applicants in their attorney's letter of 22 March 2007 say, (I paraphrase slightly) that the contribution is the association of a first displayed element with a second displayed element and the option for activation of the second element in exchange for the first element, for use in evaluating an award. Claim 36 does not specify "display" as such; it refers to "generating" symbols, but I don't suppose there is any material difference in the present context between "displaying" and "generating". It is however necessary to specify that the operations referred to in the definition are part of a game. With these interpretations, I am happy to accept this definition of the contribution.
- 15 The third step is to ask whether the contribution falls solely within excluded subject matter. The contribution involves the display of cards or other gaming symbols. As part of a game, players remember associations between the cards or symbols and act on them by exchanging one card or symbol for another. The system then involves determining the value of combinations of cards or symbols based on the players' selections.
- 16 The applicants say in their letter that the contribution provides: "a functional link between elements, an activation mechanism to activate the linked element for further use; and a player-input mechanism for implementing said activation mechanism". They say that none of these features relates solely to a gaming method, and that "the functional linking, the activation and the player-input mechanism are individually technical parts, which make up a technical combination of parts". I do not agree. The contribution seems to me to be entirely and solely related to the playing of games. Some of the features that the applicant mentions - for example "a functional link between elements" - are to do with the scheme for playing the game. The rest are to do with commonplace features of electronic apparatus used for playing games - for example the player input mechanism. I cannot see that the contribution is anything other than a scheme rule or method for playing a game. If the game is poker, this is just

another way of playing poker.

- 17 It is not necessary to apply the fourth step since I have already found the invention to be excluded under step three.

Conclusion

- 18 In conclusion, I have found that the invention is excluded from patentability because it relates to a scheme, rule or method for playing a game, contrary to section 1(2)(c) of the Act. I have considered the application in its entirety, and do not believe that it would be possible to formulate patentable claims. I therefore refuse the application under section 18(3) of the Act.

Appeal

- 19 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