

18th Sept 2007

## **PATENTS ACT 1977**

APPLICANT Christopher Mark Dale

ISSUE Whether patent application number GB  
0400838.9 complies with section 1

HEARING OFFICER Mrs S E Chalmers

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## **DECISION**

- 1 This application was filed on 15 January 2004 claiming a priority date of 1 February 2003 from an earlier GB application. It was published under serial no. GB 2397776 A on 4 August 2004
- 2 Despite amendment of the claims during substantive examination, the applicant has been unable to persuade the examiner that this is a patentable invention within the meaning of section 1(2) of the Act and involves an inventive step. The matter therefore came before me at a hearing on 30 August 2007. The applicant was represented by Mr Toby Gosnall, assisted by Mr Douglas Rankin, both of the patent attorneys Barker Brettell. The applicant Mr Dale and the examiner, Mr Andrew Hole, also attended.
- 3 Shortly before the hearing, Mr Gosnall filed a skeleton argument and three sets of amended claims and I confirm I have taken the submissions in the skeleton into account in coming to my decision. As I stated at the hearing, this decision covers only the questions of excluded matter and inventive step, leaving other questions to further processing of the application, if appropriate.

### **The invention**

- 4 The invention relates to apparatus for playing a game. As the specification explains, the apparatus comprises a display area providing a number of game play areas which are arranged in stages. All stages are visible to the player at the same time and each stage is associated with a prize and a winning or losing area is revealed by removing an obscuring means. The stages are arranged such that the chance of losing increases as the player progresses through the stages. On winning a stage, the player can therefore choose to stick at that particular prize level or can decide to continue the game and take a gamble on the outcome of the next stage. In one embodiment, the apparatus is a scratch card and the

stages are arranged such that should a player reveal a losing playing area, he or she forfeits any prizes that have been won up to that point in the game. The apparatus could also be a machine as may be found in amusement arcades or a computer connected to the internet.

- 5 Three amended sets of claims were submitted for discussion at the hearing (entitled main, first auxiliary and second auxiliary claims). The full text of the independent claims for each set of amended claims is set out in the Annex attached to this decision.

### The law and its interpretation

- 6 Section 1(1) reads:

“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) ... below”

- 7 Section 1(2) reads:

“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.**”

- 8 It was not disputed that the assessment of patentability is now governed by the judgment of the Court of Appeal in *Aerotel*<sup>1</sup>. In this case the court reviewed the case law on the interpretation of section 1(2) and approved a new four-step test for the assessment of patentability, namely:

- 1) Properly construe the claim
- 2) Identify the actual contribution
- 3) Ask whether it falls solely within the excluded matter
- 4) Check whether the contribution is actually technical in nature.

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

The operation of this test is explained at paragraphs 40-48 of the judgment. Paragraph 43 confirms that identification of the contribution is essentially a matter of determining what it is the inventor has really added to human knowledge, and involves looking at substance, not form. Paragraph 46 explains that the fourth step of checking whether the contribution is technical may not be necessary because the third step should have covered the point.

- 9 In paragraph 5 of the *Aerotel* judgment, the Court makes it clear that whether an invention covers patentable subject matter is a question of law which should be decided during prosecution of the patent application. It is not a question on which applicants are entitled to the benefit of the doubt. As the judgment says, giving benefit of reasonable doubt at the application stage may still be appropriate if debatable questions of pure fact, not law, arise.

## **Arguments and analysis**

### Patentability

- 10 The examiner has maintained objection that the invention was excluded as a scheme, rule or method for playing a game and the presentation of information, but Mr Gosnall argued that it made a contribution that did not lie solely within excluded areas. I shall deal with these arguments in accordance with the above four-step test.

### *Construction of the claims*

- 11 There is no dispute over the construction of the claims all of which relate to gaming equipment. The claims of the main and the first auxiliary requests relate to a scratch card and computer embodiments while the claims in the second auxiliary request generally relate to a scratch card and a method of making it.

### *Identification of the contribution of the invention*

- 12 In paragraph 43 of the *Aerotel/Macrossan* judgment, the Court restated its previous findings that in identifying the actual contribution it is substance that matters rather than the form of claim. The judgment says “What has the inventor really added to human knowledge perhaps best sums up this exercise”. It is an exercise in judgment probably involving the problem said to be solved, how the invention works, what its advantages are.
- 13 Mr Gosnall presented the contribution as a gaming apparatus which provided increased security and player confidence by making it hard for the game provider to act fraudulently. Taking the scratch card embodiment as an example of the invention, Mr Gosnall explained that once a game had been played and a player had lost (perhaps by revealing a losing identity game play area), the player would be free to reveal all of the other game play areas to determine that he/she could have won a prize. In other words, when a player bought the card, they knew they were in with a chance of winning the top prize. I am not sure that Mr Gosnall’s analysis is entirely consistent with the specification as filed which suggests that the game makes it hard for the player to cheat. Nevertheless, I am willing to accept that increased security forms part of the contribution but I also need to

identify the actual contribution over the prior art.

- 14 I must admit that I have some difficulty in identifying what that actual contribution is. From the documents cited by the examiner in the course of examination, the use of obscuring means to enable a player to “rub and reveal” predetermined winning or losing outcomes such as symbols, either physically or virtually on a computer, is known. These documents also show that multi-level lottery-type games embodied in physical or virtual form are also known. For example, WO 02/05916 discloses a game arranged in stages with decreasing probability of success as the player progresses through the stages. As far as I can see, there is nothing in the specification to suggest the hardware used in the computer embodiments is other than standard. Furthermore, the cited prior art also discloses multi-level lottery-type games in which all stages of the game play area are visible to a player at the same time are also known.
- 15 Nevertheless, I am willing to accept Mr Gosnall’s assessment that the contribution lies in the predetermination of the winning or losing identity of the game areas such that, at the outset, every game is a potential winner. In addition, it seems to me that the display of all stages of the game at the same time also forms part of the contribution by providing further reassurance to the player that he is not being cheated.

*Whether the contribution relates solely to excluded matters*

- 16 Mr Gosnall was adamant that the wording used in the claims did not encompass a method of how a game should be played: rather it related to new apparatus defined by functional language which allowed a game to be played. He warned me of the potential trap in saying “Well, the claim involves the use of a computer and it is merely running a game, so it must be excluded”. Mr Gosnall reminded me of the *No-Fume*<sup>2</sup> judgment which expressly allowed claims that included functional limitations. He also referred me to other UK judgments<sup>3</sup> and EPO Technical Board of Appeal decisions<sup>4</sup> to reinforce his point that apparatus *per se* for playing a game is in principle, patentable and to highlight differences in practice between UK and EPO practice. In particular he referred me to paragraph 40 of the IGT judgment which I quote in full:

“Dr Colley also submits that it is important to keep in mind the distinction between a game and the rules for playing a game. A newly-invented board game might be patentable because the board and the pieces are patentable. But the rules for playing the newly-invented game would not be. This may or may not be true: but it does not follow from that distinction that the patent claim is excluded only when the claim itself claims a “scheme, rule or method for playing a game”. The important question, following *Aerotel*, is, so it seems to me, not whether the subject matter of the claim is patentable and outside the excluded territory, but whether the contribution over and above the prior art, assuming that the claim is otherwise sufficient to result in patentability, is within the excluded territory. The question is whether the contribution identified consists of excluded subject matter as such ... It is fair to note, however, that Article 52 does not, as it might have done, exclude games *per se*. **The apparatus for playing a game remains, in theory, patentable**”  
[emphasis added]

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<sup>2</sup> *No-Fume Ltd v Frank Pitchford Co Ltd* 52 RPC 231

<sup>3</sup> *CFPH* [2005] EWHC 1589; *IGT* [2007] EWHC 1341

<sup>4</sup> T 60/98 *Sigma*; T 928/03 *Konami*

- 17 Mr Gosnall saw the combination of the gaming apparatus and its purpose ie increased security, as providing a contribution that took it outside the excluded field and drew an analogy with *Fishburn*<sup>5</sup>. 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. He also directed me to the Office’s Manual of Patent Practice which, 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.
- 18 Mr Gosnall submitted that this was the case with this application – the effect of the invention was to provide a new gaming apparatus, which as discussed in both *CFPH* and *IGT* was not excluded. In addition to being able to provide a game, the new gaming apparatus had significant technical features. He highlighted the provision of stages with winning identities where such identities would be obscured and therefore not presented to a user when using the apparatus. In his view, the invention therefore was not a presentation of information since, in use, no information would be presented to the user.
- 19 Mr Gosnall was at pains to point out that the applicant was not seeking to obtain a monopoly on a method of playing the game. Indeed, he envisaged it would be possible for a person to provide the game disclosed in the specification with other apparatus. What was sought was a monopoly for the apparatus described in the claims. Indeed, he acknowledged, there might be other apparatus that provided the same game as described in the application, which would not fall within the present claims.
- 20 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. It therefore does not follow that a patent claim is excluded under section 1(2)(c) only when the claim itself claims a “scheme, rule or method for playing a game”. Furthermore, the mere fact that physical apparatus may be involved in the presentation of information will not suffice to avoid the exclusion.
- 21 I agree with Mr Gosnall that, in theory, apparatus for playing a game is patentable – for example the bendy bat of *IGT* or a rugby ball. While the *No-Fume* ashtray, which was defined in functional terms, was held to be a patentable invention, I do not consider this decision assists the applicant in the present case. It is clear from *IGT*, in which the claimed inventions were also defined in terms of gaming apparatus, that the important question is whether the contribution identified consists of excluded subject matter as such. Furthermore, I do not think that *Fishburn* supports Mr Gosnall’s case either. Even if the *Fishburn* ticket were not excluded under section 1(2)(d) because the arrangement of the information can be regarded making a contribution in a non-excluded area, I do not think the same is true in the present case. It seems to me that the information provided by the winning or losing identity of the game areas (irrespective of whether they are obscured) and the display of all stages to a player at the same time relates to the presentation of information as such. Anything over and above that information

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<sup>5</sup> *Fishburn’s Application* 57 RPC 245

relates to the way in which the game is played and therefore relates to a method of playing a game as such.

- 22 To summarise, although the invention is claimed in apparatus terms as gaming equipment, in my view this does not save it from the exclusion because, in substance, the contribution made by the invention is still about the way in which a game is played and the display and arrangement of the stages of the game play areas. I therefore consider that the invention as claimed in all three claim sets is excluded from patentability under section 1(2).

*Whether the contribution is technical in nature*

- 23 I do not need to consider this step as the contribution has failed the third step of the test.

Does the invention involve an inventive step?

- 24 In view of my findings on patentability, it is not strictly necessary for me to go on to consider the separate issue of whether the invention involves an inventive step. However, inventive step was in issue at the hearing, and I think that it will be helpful to consider the arguments that were before me. Since the scope of the amended sets of claims differs from those claims currently on the official file, I shall re-assess the inventiveness of the inventions claimed afresh.
- 25 Adopting the well known structured analysis in the Windsurfing<sup>6</sup> test, the inventive concept in all three sets of claims appears to reside in the combination of (a) providing a plurality of stages each with a winning identity game play area and (b) displaying all these game play areas to a player at the same time. In Mr Gosnall's submission, none of the citations showed or suggested an apparatus in which a guaranteed prize might be won and in which the user was assured that the prize could be won. In particular, he argued that there was nothing in WO 02/05916 to encourage the skilled person to modify the game to display all the game stages at the same time, as asserted by the examiner. He also thought that it would not occur to the skilled person that the electronic game of WO 02/05916 could be modified in the way suggested by the examiner to present it in scratch card format. Finally, Mr Gosnall pointed out that it was clear that scratch cards and the like had been around for a number of years without a similar apparatus being developed.
- 26 There appears to be no dispute that features (a) and (b) are individually known. So is this combination obvious to the person skilled in the art of designing lottery-type games? WO 02/05916, relied on by the examiner, discloses a game arranged in stages with decreasing probability of success as the player progresses through the stages. The game may be implemented via the internet using remote terminals and a central host (server) and is based on animations, with different animations being shown if the player has guessed either correctly or incorrectly. The player is given an increasing number of options to choose from as the game progresses, with only one option being correct and he/she has no

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<sup>6</sup> Windsurfing International Inc. v Tabur Marine (Great Britain) Ltd [1985] RPC 59

idea which option to choose as all options are similarly marked. As shown in Figures 2 and 3, screens 3 to 8 show a game with increasing odds of failure as the game progresses.

- 27 Although Mr Gosnall's argument has some force, I do not think I should consider WO 02/05916 in isolation from the other prior art cited by the examiner in the earlier exchange of correspondence with the applicant. I was not addressed at the hearing on what might be the common general knowledge of the person skilled in the art at the priority date of the application. I am also conscious that the disclosures contained in patent documents may or may not constitute part of that common general knowledge. However, from the background art (WO 01/58550 and US 5092598) cited by the examiner and my own personal knowledge, it is clear that the use of obscuring means to enable a player to "rub and reveal" predetermined winning or losing outcomes, either physically or virtually on a computer, would have been well known to the skilled person. In addition, WO 01/58550 and US 5092598 also disclose multi-level lottery-type games embodied in physical or virtual form and US 5092598 discloses multi-level lottery-type games in which all stages of the game play area are visible to a player at the same time.
- 28 In my judgment, in the light of the disclosure of US 5092598, it would be a matter of routine for a person skilled in the art of designing lottery-type games to modify the game of WO 02/05916 so that all stages of the game play area were visible to a player at the same time. Alternatively, in relation to the scratch card claimed in the second auxiliary request, I do not consider it would be inventive to modify the multi-level scratch card of US 5092598 to provide that every stage is a potential winner in the light of the disclosure in WO 02/05916.

### **Conclusions**

- 29 I find that the invention as claimed in the independent claims of the main, first and second auxiliary claim sets lack an inventive step as required by section 1(1)(b). Although, the inventiveness of the appendant claims was not argued before me, they seem to me to relate to conventional features. I have also found that the invention as claimed in all three claim sets is excluded from patentability under section 1(2) because it relates to a method for playing a game as such and the presentation of information. I have carefully read the application but I have been unable to find anything that could form the basis of a patentable invention. I therefore refuse the application.

### **Appeal**

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

**MRS S E CHALMERS**

Deputy Director acting for the Comptroller

**MAIN REQUEST**

1. Gaming equipment arranged to provide a game to a player, said gaming equipment comprising a display means providing a plurality of game play areas, said game play areas each having either a winning or a losing identity, the equipment being arranged such that in an un-played state the identity of a game play area is obscured by an obscuring means, said game play areas being arranged in stages, each of said stages comprising at least one game play area having a winning identity such that, in playing a game, a game play area can be selected from each stage, and the stages can be played in sequence such that the chance of selecting a losing area in a subsequent stage is greater than the chance of selecting a losing area in a previous stage, and the equipment being arranged such that in use of said equipment, said obscuring means can be removed from said selected game play area to reveal if the selected game play area is a winning area or a losing area, wherein all stages are visible to a player at the same time.

9. An entertainment machine arranged to provide a game and comprising a processing means and a display means arranged to display a game including a plurality of game play areas, said game play areas each having either a winning or a losing identity, the data being arranged such that in an un-selected state, a game play area is represented by an obscuring means, said game play areas being arranged in stages, each of said stages comprising at least one game play area having a winning identity such that, in playing a game, a game play area can be selected from each stage, and the stages can be played in sequence such that the chance of selecting a losing area in a subsequent stage is greater than the chance of selecting a losing area in a previous stage, and the machine being arranged such that in use of said machine, once a said obscuring means has been selected the display is altered to reveal whether a game play area is a winning or a losing area, wherein the processing means and the display means are arranged to display a game such that all stages are visible to a player at the same time.

22. A processing apparatus arranged to provide a game and comprising a processing means and an access means, the access means being arranged to receive requests from remote devices and to send said requests to said processing means which is arranged to process said requests and to send game playing data to said remote devices via said access means; said game playing data is arranged to cause said remote devices to display a game having a plurality of game play areas, said game play areas each having either a winning or a losing identity, the game playing data being arranged such that in an un-selected state a game play area is represented by an obscuring means, said game play areas being arranged in stages, each of said stages comprising at least one game play area having a winning identity such that, in playing a game, a game play area can be selected from each stage, and the stages can be played in sequence such that the chance of selecting a losing area in a subsequent stage is greater than the chance of selecting a losing area in a previous stage, and the apparatus being arranged such that said processing apparatus is arranged such that the game playing data causes the remote device to show whether a game play area is a winning or a losing area once said obscuring means has been selected, wherein said game playing data is arranged to cause said remote device to display a game such that all stages are visible to a player at the same time.

28. A server arranged for being connected to remote devices across a network, the server comprising a processing means and an access means, the access means being arranged to receive requests from said remote devices and to send said requests to said processing means which is arranged to process said requests and to send game playing data to said remote device via said access means; said game playing data is arranged to



cause said remote devices to display a game having a plurality of game play areas, said game play areas each having either a winning or losing identity, the data being arranged such that in an un-selected state a game play area is represented by an obscuring means, said game play areas being arranged in stages, each of said stages comprising at least one game play area having a winning identity such that, in playing a game, a game play area can be selected from each stage and the stages can be played in sequence such that the chance of selecting a losing area in a subsequent stage is greater than the chance of selecting a losing area in a previous stage, and, wherein all stages are visible to the player at the same time and the game play data causes the obscuring means to show whether a game play area is a winning or a losing area once said obscuring means has been selected.

31. Gaming equipment substantially as described and as illustrated with reference to the accompanying drawings.

32. A processing apparatus arranged to provide a game substantially as described and as illustrated with reference to the accompanying drawings.

33. An entertainment machine substantially as described and as illustrated with reference to the accompanying drawings.

## 1st AUXILIARY REQUEST

1. Gaming equipment comprising a display means providing a plurality of game play areas, said game play areas each having either a winning or a losing identity, the equipment being arranged such that the identity of each game play area is obscured by a removable obscuring means, said game play areas being arranged in a plurality of stages all visible to a player at the same time, wherein each stage has at least one game play area having a winning identity and the proportion of winning identity game play areas to losing identity game play areas reduces from one stage to a subsequent stage.

9. An entertainment machine comprising a processing means and a display means arranged to display a plurality of game play areas, said game play areas each having either a winning or a losing identity, the machine being arranged such that a game play area can be represented by an obscuring means, and wherein the processing means is arranged to the cause the display to reveal the identity of a game play area if a game play area is selected, said game play areas being arranged in a plurality of stages, all visible to a player at the same time wherein each stage has at least one game play area having a winning identity and the proportion of winning identity game play areas to losing identity game play areas reduces from one stage to a subsequent stage.

21. A processing apparatus comprising a processing means and an access means, the access means being arranged to receive requests from remote devices and to send said requests to said processing means which is arranged to process said requests and to send game playing data to said remote devices via said access means; said game playing data is arranged to cause said remote devices to display a plurality of game play areas, said game play areas each having either a winning or a losing identity, the game playing data being arranged such that a game play area can be represented by an obscuring means, and wherein the processing means is arranged to the cause a remote device to reveal the identity of a game play area if a game play area is selected,, said game play areas being arranged in stages, all visible to a player at the same time, wherein each stage has at least one game play area having a winning identity and the proportion of winning identity game play areas to losing identity game play areas reduces from one stage to a subsequent stage.

27. A server arranged for being connected to remote devices across a network, the server comprising a processing means and an access means, the access means being arranged to receive requests from said remote devices and to send said requests to said processing means which is arranged to process said requests and to send game playing data to said remote device via said access means; said game playing data is arranged to cause said remote devices to display a plurality of game play areas, said game play areas having either a winning or losing identity, the game playing data being arranged such that a game play area can be represented by an obscuring means, and wherein the processing means is arranged to the cause a remote device to reveal the identity of a game play area if a game play area is selected, said game play areas being arranged in stages all visible to a user at the same time, wherein each stage has at least one game play area having a winning identity and the proportion of winning identity game play areas to losing identity game play areas reduces from one stage to a subsequent stage.

30. Gaming equipment substantially as described and as illustrated with reference to the accompanying drawings.

31. A processing apparatus arranged to provide a game substantially as described and as illustrated with reference to the accompanying drawings.

32. An entertainment machine substantially as described and as illustrated with reference to the accompanying drawings.

## 2nd AUXILIARY REQUEST

1. A scratch card comprising a plurality of game play areas, said game play areas each having either a winning or a losing identity, the scratch card being arranged such that the identity of each game play area is coated by a removable opaque obscuring film, said game play areas being arranged in a plurality of stages, wherein each stage has at least one game play area having a winning identity and the proportion of winning identity game play areas to losing identity game play areas reduces from one stage to a subsequent stage.
7. A processing apparatus which is arranged to provide the function of the scratch card of any of the claims 1 to 6.
8. A processing apparatus according to claim 7 in which the apparatus is an entertainment machine.
9. A server which is arranged to provide the function of the scratch card of any of the claims 1 to 6 on a remote device.
10. A method of providing a prize winning scratch card in which it is hard to cheat, comprising the steps of:
  - providing a plurality of game play areas, said game play areas each having either a winning or a losing identity;
  - arranging the game play areas in stages wherein each stage has at least one game play area having a winning identity;
  - coating said game play areas with a removable opaque obscuring film;
  - arranging the scratch card such that each stage has at least one game play area having a winning identity and the proportion of winning identity game play areas to losing identity game play areas reduces from one stage to a subsequent stage.
10. A scratch card or processing apparatus as described and as illustrated with reference to the accompanying drawings.
11. A method of providing a game in which it is hard to cheat as described and as illustrated with reference to the accompanying drawings.