

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK L. YOSELOFF and RUSSELL BROOKE DUNN

Appeal No. 2002-1022
Application 09/326,934

HEARD: JANUARY 14, 2003

Before COHEN, ABRAMS, and FRANKFORT, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 14 and 18 through 21, all of the claims remaining in this application. Claims 15 through 17 have been canceled.

Appellants' invention relates to a reel slot casino wagering apparatus in both a virtual reel format played on a video display screen and a physical reel format which uses actual physical reels with symbols, characters or alphanumeric characters on an outer

peripheral surface thereof in the play of the wagering game. As noted on page 7 of the specification, it is an objective of appellants' invention to provide both physical reel slot games and virtual reel slot games with enhanced playing features by the use of novel formatting or display aspects on the physical reels or virtual reels and to enhance play by providing a sound system for the wagering apparatus that produces special sound effects. One aspect of visual enhancement of the physical or virtual reels involves the use of a border on the physical or virtual reels that simulates a thematic border around each frame or the majority of the frames, particularly a border that emulates or duplicates the appearance of a motion picture film strip. Attention is directed to pages 11-14 of the specification for insights into this aspect of appellants' invention. As for the special sound effects, appellants note (specification, page 15) that many visually impaired persons would appreciate the ability to play reel gaming apparatus independently and therefore the invention provides novel audio features or sound effects targeted at such potential players. This aspect of appellants' invention is set forth on pages 15-18 of the specification. Claims 1, 9,

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10 and 21 are representative of the subject matter on appeal. A copy of those claims, as reproduced from the Appendix to appellants' brief, is attached to this decision.

The references of record relied upon by the examiner in rejecting the appealed claims are:

Andersen	4,138,114	Feb. 6, 1979
Yamamoto et al. (Yamamoto)	5,135,224	Aug. 4, 1992
Marnell II	5,393,057	Feb. 28, 1995
Howard	RE 35,188	Mar. 26, 1996
Ishibashi	5,695,188	Dec. 9, 1997
Okuniewicz	5,908,354	Jun. 1, 1999
Falciglia	5,971,849	Oct. 26, 1999
Barrie	5,980,384	Nov. 9, 1999

Claims 1, 3 and 5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Andersen or Yamamoto or Howard.

Claims 2, 4 and 6 through 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Andersen or Yamamoto or Howard in view of Barrie or Marnell II or Falciglia.

Claims 9 through 14 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishibashi in view of Okuniewicz.

Claims 18 through 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishibashi in view of Okuniewicz and further in view of Andersen or Yamamoto or Howard.

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Rather than reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding those rejections, we make reference to the examiner's answer (Paper No. 12, mailed July 3, 2001) for the reasoning in support of the rejections, and to appellants' replacement brief (Paper No. 13, filed April 25, 2001) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

We turn first to the examiner's rejection of claims 1, 3 and 5 under 35 U.S.C. § 102(b). At the outset we note that independent claim 1 defines a reel slot casino wagering game that includes a housing having at least two displayed reels therein, with each reel having symbols, characters or alphanumerics on an outer surface of the reel that are displayed as frames, wherein combinations of the frames define game outcomes, and wherein at least some of the frames have "borders as images on the reels

that surround the symbols, characters or alphanumerics." Since it is the above-quoted language regarding "borders as images on the reels" that appellants have specifically argued for patentability, we look to the specification to see exactly what that language means.

More particularly, we look to pages 11-14 of appellants' specification and observe that in a virtual reel format wherein the reel slot casino wagering game is played on a video screen, the reels, the symbols, characters or alphanumerics, and the borders are all images produced on the video screen and, thus, as noted by appellants on page 14 of the brief, in a virtual reel format, the total reel format image includes "borders as images on the reels." However, in a physical reel format the reel must be provided with visually apparent borders around each symbol containing frame to clearly locally define the frame. One way of achieving this type of border is noted on page 13, lines 2-4, of the specification, wherein "a continuous overlay edge and spacing line element could be temporarily removed from the reel and replacement imagery placed under the overlay that is then replaced." This type of physical reel format and border arrangement is shown in Figure 2 of the application drawings and described in the paragraph bridging pages 13 and 14 of the

specification. In addition, on pages 15-16 of the brief, appellants make the following argument,

Borders are shown on the reel whether a virtual reel or physical reel, the borders are images as opposed to a physical structure, such as the three-dimensional frame overlay of Anderson on the reels themselves. The images must be on the reel. In a virtual system, that would be performed by imaging software that provides the data for display of a border. In a reel system, any format for an image e.g., painting, printing, decal, etc. of the border applied to the reel itself is intended and enabled.

Accordingly, in a physical reel format, we are of the view that one of ordinary skill in the art would understand the language "borders as images on the reels" in appellants' claim 1 to require some form of addition to the reel itself (e.g., painting, printing, decal, overlay, etc.) applied to the reel to provide visually apparent borders on the reel that surround the symbols, characters or alphanumerics and clearly locally define the frames.

With the above noted understanding in mind, we look to the examiner's use of Andersen or Yamamoto or Howard in the rejection of claims 1, 3 and 5 under 35 U.S.C. § 102(b). Andersen discloses a physical reel slot machine like that generally defined in claim 1 on appeal and, as seen in Figure 1 of the patent, includes a plurality of reels or wheels (4) carried in a cabinet or housing having a window (10). On page 9 of the

answer, the examiner directs us to Figures 3 and 4 of Anderson, and to the reel or wheel (52), urging that this patent teaches a mechanical reel having borders as images on the reel that surround the symbols, characters or alphanumerics that are on the reel, and a reel wherein the frames and borders on the reel have the visual appearance of a motion picture film strip. We agree.

In particular, we note that the transparent, flexible plastic strip (54) seen in Figure 4 of Andersen has symbols (8) and borders (unnumbered) printed thereon and located adjacent to identification markings (58) on one edge of the strip. The borders are visually apparent and clearly surround each of the symbols to locally define a frame. When the transparent overlay strip (54) is applied to the reels (52), the borders will clearly appear as images on the reels and visually appear as a frame around each symbol. Appellants' argument that a physical appliance like that placed on the reels in Andersen has a function and is not an "image," may be true, but nonetheless, the borders printed on the transparent strip (54) do serve to provide "borders as images on the reels" as required in appellants' claim 1 on appeal. For that reason, we will sustain the examiner's rejection of claim 1 under 35 U.S.C. § 102(b) based on Andersen.

As noted on page 12 of the brief, appellants have grouped dependent claims 3 and 5 with claim 1, indicating with regard to the rejection under 35 U.S.C. § 102(b) that claims 1, 3 and 5 "shall stand or fall with the patentability of claim 1." We therefore also sustain the examiner's rejection of claims 3 and 5 under 35 U.S.C. § 102(b) based on Andersen.

Looking now to Yamamoto, we note that this patent discloses a physical reel slot machine like that generally defined in claim 1 on appeal and, as seen in Figures 1 through 4 of the patent, includes a plurality of reels or rotary members, each in the form of an endless belt (34) that carries symbols (not shown) associated with the reel slot game on an outer surface thereof. In addition, the endless belts each have perforations (36) provided along the opposite edges to allow driving thereof by sprocket wheels (32). While the examiner directs us to Figure 2 of Yamamoto for reels that have "actual, physical borders on the reels that surround the symbols, characters, or alphanumerics that are on the reels" (answer, page 9), we find no such showing in Figure 2, or any other figure, of Yamamoto. Consequently, we must agree with appellants that there is absolutely no disclosure

in this patent of the use of "borders as images on the reels," and the examiner's rejection of claims 1, 3 and 5 under 35 U.S.C. § 102(b) based on Yamamoto will not be sustained.

The last reference applied by the examiner under 35 U.S.C. § 102(b) against claims 1, 3 and 5 is Howard. This patent discloses a reel structure for use in a physical reel slot machine game and includes a reel drum (Figs. 5 and 6) over which is applied a thin plastic reel-strip (e.g., Figs. 3 and 4) carrying a plurality of symbols (5) formed in relief, sunken regions (6) surrounding the symbols (5), and raised sections (4) and (7) surrounding the sunken regions (6). Note also, the reel-strip seen in Figure 7 of Howard. Like the examiner, it is our opinion that when either of the thin plastic reel-strips in Howard is applied over the reel drum and used in a gaming machine as described in column 1, lines 13-21 of that patent, the areas (e.g., (4), (6) and (7)) surrounding the symbols (5) will visually define "borders as images on the reels that surround the symbols . . .," as set forth in appellants' claim 1 on appeal. Again, we recognize appellants' argument that a physical structure cannot be an image, however, appellants' own disclosure regarding physical reel formats (specification, pages 12-14) belies that argument. Moreover, the physical reel drum seen in

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Figure 5 of Howard has no symbols, frames or borders on it at all until such time that one of the thin plastic reel-strips disclosed in Howard is added to the reel drum, thereby providing the reel drum with the visual appearance of symbols on its outer surface displayed as frames and visually apparent borders on the reel that surround the symbols, characters or alphanumerics and clearly locally define the frames.

In light of the foregoing, we will sustain the examiner's rejection of claim 1 under 35 U.S.C. § 102(b) based on Howard. As noted above, appellants have grouped dependent claims 3 and 5 with claim 1, indicating with regard to the rejection under 35 U.S.C. § 102(b) that claims 1, 3 and 5 "shall stand or fall with the patentability of claim 1." We therefore also sustain the examiner's rejection of claims 3 and 5 under 35 U.S.C. § 102(b) based on Howard.

Regarding the examiner's rejection of claims 2, 4 and 6 through 8 under 35 U.S.C. § 103(a) as being unpatentable over Andersen or Yamamoto or Howard in view of Barrie or Marnell II or Falciglia, we note that, although somewhat inartfully stated, it appears to be the examiner's position that it would have been obvious to one of ordinary skill in the art at the time of appellants' invention, based on the teachings of the virtual

game/machine formats in either Barrie or Marnell II or Falciglia, to convert the physical reel slot machines as seen in either Andersen or Yamamoto or Howard to a virtual format so that they could be played on a video monitor wherein the reels as disclosed in any of Andersen or Yamamoto or Howard would appear as virtual reels displayed on a monitor. Appellants argument (brief, pages 19-21) again focuses on the physical nature of the structures in the primary references to Andersen, Yamamoto and Howard, and urges that there would be absolutely no functional benefits for creating an image in a video game of a physical reel element that served a functional purpose on a physical reel. We do not agree.

Assuming it is the desire of an artisan to faithfully recreate the slot reel game of Andersen or Howard in a virtual reel format, we are convinced that it would have been obvious to such artisan to recreate the entire visual impression of the physical reel arrangement as seen in Andersen (Figs. 4-5) or Howard (Figs. 3 and 7), and thus provide the reels, the symbols, characters or alphanumerics, and the borders seen in such patents all as images produced on a video screen. Thereby, in our opinion, providing a virtual reel format wherein the total reel format image includes "borders as images on the reels." While a physical structure may well have a functional purpose in a

physical reel format, we see no reason why an artisan seeking to faithfully recreate such a physical reel game in a video format would not recreate each and every one of the features visually seen by the user of the physical reel game as part of the virtual reel game so that users of the video version of the reel slot gaming machine would appear to see the same images as they did when they played the physical reel version of the game. Whether or not the reel slot games of Andersen or Howard recreated in a virtual reel format would provide the same benefits urged by appellants on page 21 of their brief, is of no moment, since nothing in the claims on appeal requires separate image (symbol, character or alphanumeric) and border software so that games can be quickly and readily changed merely by replacing symbol image formatting (software) for the pre-existing frame software.

In light of the foregoing, we will sustain the examiner's rejection of claim 2 under 35 U.S.C. 103(a) based on Andersen or Howard in view of Barrie or Marnell II or Falciglia. Following appellants' grouping of the claims set forth on page 12 of the brief, we will also sustain the rejection of claims 4 and 6 through 8 under 35 U.S.C. 103(a) on that same basis.

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As for the examiner's proposed modification of Yamamoto into a video format reel slot game wherein the reels or endless belts (34) of Yamamoto would be recreated in a virtual format, we note that since Yamamoto shows no symbols, no frames and no borders on the endless belts (34), it would be impossible to say exactly what such a virtual reel format would look like. Thus, we are unable to agree with the examiner's conclusion of obviousness based on Yamamoto as modified by Barrie or Marnell II or Falciglia, and that rejection will not be sustained.

The next rejection for our review is that of claims 9 through 14 and 21 under 35 U.S.C. § 103 as being unpatentable over Ishibashi in view of Okuniewicz. Independent claim 9, as well as independent claims 10 and 21, are directed to another aspect of appellants' disclosed invention, that being the use of unique, special audio sounds specifically designed to allow visually impaired persons to play reel slot casino gaming apparatus independently, i.e., without the need for a sighted spotter. Listings of possible special audio features or sounds increasing accessibility of the visually impaired to appellants' reel casino wagering apparatus are set forth on pages 16 through 18 of the specification and in claims 9, 10 and 21.

According to the examiner, Ishibashi discloses a slot machine including a sound generating means that makes distinct sounds for each of the plurality of symbols displayed on the reels (2), (3) and (4) therein, but does not disclose sound effects like those required in appellants' claims on appeal. Turning to Okuniewicz, the examiner notes that this reference discloses a sound card for making various sound effects for casino gaming devices and indicates that the sound files can be changed to make customized sound effects. From these teachings, the examiner concludes that "[i]t would have been obvious to a person of ordinary skill in the art to include the sound card of Okuniewicz in Ishibashi to create the specific sounds of the instant claims" (answer, page 6). The examiner further asserts that the programmable sound card of Okuniewicz is functionally capable of providing those sound effects and that it is "merely a matter of obvious design choice."

Contrary to the examiner's apparent belief that appellants have argued that the applied references are "not capable of producing the instant claimed sound effects" (answer, page 15), we note that appellants have actually asserted that neither Ishibashi nor Okuniewicz discloses or suggests any of the sound emitting functions that are recited in the presently rejected

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claims, and that the applied prior art makes no provision for audio effects for the specific game or play conditions set forth in those claims. We agree with appellants. Although it is entirely possible that the programmable sound producing device of Okuniewicz would be "capable of" producing sound effects for the game or play conditions set forth in appellants' claims on appeal, there is absolutely no teaching, suggestion or incentive in either Ishibashi or Okuniewicz to do so.

Accordingly, since neither of the applied references teaches or suggests the specific sound functions set forth in appellants' claims on appeal or the problem of increasing accessibility of the hearing impaired to reel casino wagering apparatus, it follows that the examiner's rejection of claims 9 through 14 and 21 under 35 U.S.C. § 103 as being unpatentable over Ishibashi in view of Okuniewicz will not be sustained.

In that regard, the examiner is reminded that a rejection based on § 103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the examiner has the initial duty of supplying the factual basis for the rejection he advances. He may not, because he doubts that the invention is patentable, resort to speculation, unfounded assumptions or

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hindsight reconstruction to supply deficiencies in the factual basis. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967) cert. Denied, 389 U.S. 1057 (1968).

We have also again reviewed the patents to Andersen, Yamamoto and Howard additionally relied upon by the examiner in the rejection of claims 18 through 20 under 35 U.S.C. § 103(a), but find nothing in these references which would make up for or otherwise supply the deficiencies noted above in the basic combination to Ishibashi and Okuniewicz. Thus, the examiner's rejection of claims 18 through 20 will likewise not be sustained.

To summarize our decision, we note that a) the examiner's rejection of claims 1, 3 and 5 under 35 U.S.C. § 102(b) has been sustained with regard to Andersen and Howard, but not with regard to Yamamoto; b) the examiner's rejection of claims 2, 4 and 6 through 8 under 35 U.S.C. § 103(a) has been sustained with respect to Andersen or Howard in view of Barrie or Marnell II or Falciglia, but not with regard to Yamamoto in view of Barrie or Marnell II or Falciglia; c) the examiner's rejection of claims 9 through 14 and 21 under 35 U.S.C. § 103 based on Ishibashi in view of Okuniewicz has not been sustained; and d) the rejection

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of claims 18 through 20 under 35 U.S.C. § 103(a) as being unpatentable over Ishibashi in view of Okuniewicz and further in view of Andersen or Yamamoto or Howard has not been sustained.

In light of the foregoing, the decision of the examiner is affirmed-in-part.

No time period for taking any subsequent actio in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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NEAL E. ABRAMS)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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CHARLES E. FRANKFORT)	
Administrative Patent Judge)	

CEF:pgg

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Schwegman, Lundberg, Woessner & Kluth, P.A.
P.O. Box 2938
Minneapolis, MN 55402

APPENDIX

1. A reel slot casino wagering apparatus comprising a housing having at least two displayed reels therein, each reel having symbols, characters or alphanumerics on an outer surface of the reel that are displayed as frames, wherein combinations of frames define game outcomes, at least some of the frames having borders as images on the reels that surround the symbols, characters or alphanumerics.

9. A reel slot casino wagering apparatus comprising a housing having at least three displayed reels thereon, each reel having symbols, characters or alphanumerics that are displayed, a wager entering system, a CPU and a sound system, wherein the CPU has software and/or hardware that provides distinctly different audio signals for at least one of 1) availability of the apparatus to start a new wagering game, 2) presence of bet credits, 3) amount of bet credits available, 4) number or amount of bet credits wagered or coins or token wagered, 5) revelation of a non-payout configuration, 6) position of only particular symbols where the total configuration of all symbols does not provide a payout, 7) size of a payout inclusive of payouts for non-jackpot awards, 8) denomination of currency or credits deposited, and 9) denoting one or more game losses.

10. A reel slot casino wagering apparatus comprising a housing having at least three displayed reels thereon, each reel having symbols, characters or alphanumerics that are displayed, a wager entering system, a CPU and a sound system, wherein the CPU has software and/or hardware that provides distinctly different audio signals for each different subunit from among the sets consisting of 1) availability of the apparatus of start a new wagering game, 2) presence of bet credits, 3) amount of bet credits available, 4) number or amount of bet credits wagered or coins or token wagered, 5) size of a payout including payouts for non-jackpot awards, 6) denomination of currency or credits deposited, and 7) denoting one or more game losses.

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21. A reel slot casino wagering apparatus comprising a housing having at least three displayed reels thereon, each reel having symbols, characters or alphanumerics that are displayed, a wager entering system, a CPU and a sound system, wherein the CPU has software and/or hardware that provides distinctly different audio signals for at least one of 1) availability of the apparatus to start a new wagering game, 2) presence of bet credits, 3) amount of bet credits available, 4) number or amount of bet credits wagered or coins or token wagered, 5) position of particular symbols where the total configuration of all symbols does not provide a payout, 6) size of a payout inclusive of payouts for non-jackpot awards, 7) denomination of currency or credits deposited, and 10) denoting one or more game losses.