

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOSEPH E. KAMINKOW  
and MARK R. CASS

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Appeal No. 2004-1254  
Application 09/625,884

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ON BRIEF

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Before FRANKFORT, MCQUADE, and BAHR, Administrative Patent Judges.

Per Curiam.

DECISION ON APPEAL

Joseph E. Kaminkow et al. appeals from the final rejection of claims 1 through 5, 7 through 20 and 22 through 27, all of the claims currently pending in the application.<sup>1</sup>

THE INVENTION

The invention relates to "[a] gaming device which simulates movement of the gaming device screen" (Abstract). Representative claim 1 reads as follows:

1. A gaming device comprising:

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<sup>1</sup> Claim 26 has been amended subsequent to final rejection.

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a video screen having a plurality of images and a plurality of positions for the plurality of images;  
at least one triggering event; and  
means for repeatedly repositioning the plurality of images as a unit in a coordinated manner to at least two of the positions to simulate movement of the entire video screen upon the occurrence of a triggering event.

#### THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Ugawa	5,836,819	Nov. 17, 1998
Bridgeman et al. (Bridgeman)	5,984,779	Nov. 16, 1999

Fey, Marshall; Slot Machines, A Pictorial History of the First 100 Years, Fifth Edition; page 79 (Liberty Belle Books 1997)

#### THE REJECTIONS

Claims 1 through 5, 7 through 20, 22 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fey in view of Ugawa.

Claims 24 through 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fey in view of Ugawa and Bridgeman.

Attention is directed to the main and reply briefs (Paper Nos. 21 and 23) and to the final rejection and answer (Paper Nos. 13 and 22) for the respective positions of the appellants and the examiner regarding the merits of these rejections.

DISCUSSION

Fey, the examiner's primary reference, discloses a picture of a so-called "Rock-A-Way" gaming device accompanied by the following caption:

This 5-pocket nickel version, similar to the Reno, used a wheel depicting two girls on a teeter-totter that rocked back and forth before releasing the coin into the playing field. Edmund Fey patented it as a game of skill in 1926 [page 79].

As indicated above, independent claim 1 recites a gaming device comprising, inter alia, a video screen having a plurality of images and a plurality of positions for the plurality of images, and means for repeatedly repositioning the plurality of images as a unit in a coordinated manner to at least two of the positions to simulate movement of the entire video screen upon the occurrence of a triggering event. Independent claims 7, 11, 13, 17 and 22 contain similar limitations. The examiner concedes (see page 2 in the final rejection) that Fey lacks response to these recitations. According to the examiner, "Fey's Rock-A-Way discloses a mechanical version of the claimed invention. Each and every salient feature of Appellant's claimed invention (except for the use of a video screen) was present and well known in the 1926 Rock-A-Way" (answer, page 6). The examiner further

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submits that "the circular display in the Rock-A-Way device [i.e., the wheel depicting two girls on a teeter-totter] corresponds to the video screen" (answer, page 7).

Ugawa discloses "an image display type game machine includ[ing] an image display apparatus that can provide an image display of a play field, a flipped ball moving around the play field, and a variable display device that can cause the visual representation of the display to change" (column 6, lines 8 through 13).

Equating Ugawa's image display apparatus to a video screen, the examiner submits that

[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to have used a video screen [as in Ugawa] instead of a mechanical display [as in Fey] in order to have fewer moving parts, thus making the [Fey] gaming machine easier to maintain [final rejection, page 3].

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Arguably, with the modernization of slot machines, it may have been obvious to one of ordinary skill in the art to update Fey's Rock-A-Way machine by using a video screen as taught by Ugawa instead of a mechanical system. Even as so modified, however, the Fey machine still would not respond to the above noted limitations in independent claims 1, 7, 11, 13, 17 and 22 relating to the repositioning of the plurality of images as a unit in a coordinated manner to simulate movement of the entire video screen. The collective disclosures of Fey and Ugawa simply do not teach, and would not have suggested, this feature. The examiner's attempt to overcome this deficiency by analogizing Fey's circular wheel to a video screen is not well taken as the wheel would constitute but a portion of the display shown on the video screen of the ROCK-A-WAY machine as modified in view of Ugawa. Hence, rocking movement of the wheel on the video screen would not simulate movement of the entire video screen.

Thus, the combined teachings of Fey and Ugawa do not justify the examiner's conclusion that the differences between the subject matter recited in independent claims 1, 7, 11, 13, 17 and 22 and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. Therefore, we shall not

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sustain the standing 35 U.S.C. § 103(a) rejection of claims 1, 7, 11, 13, 17 and 22, and dependent claims 2 through 5, 8 through 10, 12, 14 through 16, 18 through 20 and 23, as being unpatentable over Fey in view of Ugawa.

As the examiner's application of Bridgeman does not cure the flaws in the Fey-Ugawa combination relative to the subject matter recited in parent claims 13 and 17, we also shall not sustain the standing 35 U.S.C. § 103(a) rejection of dependent claims 24 through 27 as being unpatentable over Fey in view of Ugawa and Bridgeman.

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SUMMARY

The decision of the examiner to reject claims 1 through 5, 7 through 20 and 22 through 27 is reversed.

REVERSED

CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
	)	
	)	APPEALS AND
JOHN P. MCQUADE	)	
Administrative Patent Judge	)	INTERFERENCES
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JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

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BELL, BOYD & LLOYD LLC  
P. O. BOX 1135  
CHICAGO, IL 60690-1135