

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL W. WOOD and JOHN EDWARD ROETHEL

Appeal No. 2005-0983
Application 09/923,675

ON BRIEF

Before KRASS, BARRETT, and GROSS, Administrative Patent Judges.
KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-7.

The invention is directed to a video poker game. In particular, during the play session of video poker, one or more

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playing cards is/are designated and shown to the player on the video screen of the gaming machine. As the playing cards are dealt to a player during the regular play of the video poker game, each dealt card that corresponds to one of the designated cards results in a match of the designated card. The designated card that has been matched is shown by highlighting the matched card on the video screen. When the player has matched all of the designated cards, the player receives a bonus award. The amount of the bonus award is based on the number of deals of video poker that it took to match all of the designated cards.

Independent claim 1 is reproduced as follows:

1. A method of playing a video poker game having a bonus award feature comprising:

a) establishing a predetermined arrangement of cards as a winning bonus award;

b) dealing a first initial five card hand to a player;

c) determining whether any of the first initial five cards match any of the predetermined arrangement of cards and if any matches occur, noting the matched cards;

d) allowing the player to play out the first initial five card hand according to the conventional manner of play of video poker;

e) continuing to deal subsequent initial five card hands and determining whether any of the cards of each subsequent hand match any of the predetermined arrangement of cards and noting the matched cards;

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f) continuing to allow the player to play out each of the subsequent initial five card hands according to the conventional manner of play of video poker; and

g) when all the predetermined arrangement of cards have been matched, determining whether the player has achieved a bonus award.

The examiner relies on the following references:

Falciglia	5,935,002	Aug. 10, 1999
Holmes, Jr. et al. (Holmes)	5,957,774	Sep. 28, 1999
Schneider et al. (Schneider)	6,089,976	Jul. 18, 2000

Claims 1-7 stand rejected under 35 U.S.C. § 103 as unpatentable over Holmes, Schneider and Falciglia.

Reference is made to the brief and answer for the respective positions of appellants and the examiner.

OPINION

At the outset, we note that, in accordance with appellants' grouping of the claims, at page 5 of the brief, all claims will stand or fall together. Accordingly, we will focus on independent claim 1.

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In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To reach a conclusion of obviousness under § 103, the examiner must produce a factual basis supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The examiner may satisfy his/her burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

It is the examiner's position that Holmes discloses a video poker game having a bonus award associated with the game, and a predetermined arrangement of cards established as a winning bonus award. The examiner contends that Holmes does not disclose noting the matched cards as they occur, or continuing to deal subsequent hands and allowing a player to play out each of the subsequent hands in order to continue trying to match cards with

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the predetermined arrangement. Thus, the examiner turns to Schneider for a teaching of playing multiple rounds of a game in an attempt to achieve a match in order to win an award. Further, the examiner contends, unlike Holmes, Schneider's quest to match does not end after one hand and the process continues until an actual match is achieved.

The examiner combines Holmes and Schneider because of the "advantage," in using the match method of Schneider, of having two opportunities to win.

The examiner recognized that the combination of Holmes and Schneider still does not result in a teaching of how the bonus award would be calculated, so the examiner turns to Falciglia for a teaching of a game where a player attempts to match indicia chosen by the machine, the goal being to make the desirable matches in order to obtain an award. The examiner points to column 6, lines 11-23, of Falciglia for a teaching of basing the award received on the number of tries it took for all of the predetermined arrangement of criteria to be matched.

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The examiner finds that it would have been obvious to incorporate Falciglia's teachings into the Holmes/Schneider combination in order "to correct the improbable payouts associated with Holmes . . . in view of Schneider . . . thus motivating a skilled artisan to incorporate such a feature" (answer-page 7).

We have reviewed the references, as well as the arguments by appellants and the examiner, and we conclude that the applied references are not combinable, within the meaning of 35 U.S.C. § 103, to achieve the instant claimed subject matter.

Claim 1 requires that a player be able to play video poker in a conventional manner and that play continues until all of the predetermined arrangement of cards has been matched, if the player wishes to play that long. Each card of the predetermined arrangement of cards is matched, or not, during play.

Both appellants and the examiner agree that the matching in Schneider occurs after a winning hand and that once the player in Schneider qualifies for the bonus round, the player continues to attempt a match until a match, and a bonus award, is actually

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achieved. Unlike Schneider, instant claim 1 does not require some qualifying event, such as a winning hand, to qualify to get to the bonus round.

As correctly put by appellants,

Claim 1 simply establishes a bonus feature that is in play on every round of video poker. The accumulation of correct card matches continues through every subsequent round of video poker until a complete match has been achieved. Once a complete match has been achieved, the player may or may not win an award depending on how many rounds of video poker it took to achieve the complete match.

In Schneider, once the player qualifies for a bonus round, the matching action of the bonus round continues until the player wins an award. In Schneider, the player always wins an award once the player gets to the bonus round.

There is nothing in Falciglia that overcomes this deficiency of Holmes as modified by Schneider (brief-page 9).

We agree. With the deficiencies and differences noted supra with regard to Schneider, it is not apparent to us why the skilled artisan would have modified Holmes in any manner with the teachings of Schneider so as to arrive at the instant claimed invention.

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It is clear from the method steps of claim 1 that the matching of dealt cards to the predetermined cards is ongoing, during each new hand dealt to the player. We find no suggestion of such a method step in any of the applied references. Since Falciglia is employed only for a teaching of basing an award on the number of tries it took for all of a predetermined arrangement of criteria to be matched, and Holmes clearly allows a player only a single opportunity to obtain a match, the examiner must be relying on Schneider for this suggestion of matching dealt cards to a predetermined arrangement of cards on a continuous basis during play. Yet, Schneider does not suggest this at all, teaching, instead, that after qualifying with a certain outcome of a primary game, the player gets to play a bonus game, and continues to play that bonus game until such time as two images are matched, winning the associated award for that match. The matching in Schneider is not performed on an ongoing basis during the poker game, as new cards are dealt. Rather, Schneider's primary game is completed, and only if it has been completed in a qualifying manner does the player get to advance to the bonus round where the player is assured of winning an award. The bonus round continues until the player achieves a match of two images. Nothing in this teaching would have

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suggested any modification of Holmes to the artisan that would have resulted in the instant claimed subject matter.

We do not find any one of the three applied references, or any combination thereof, to have suggested the instant claimed invention.

Accordingly, we will not sustain the rejection of claims 1-7 under 35 U.S.C. §103.

The examiner's decision is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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