

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SCOTT D. SLOMIANY,
LAWRENCE E. DEMAR and
DUNCAN F. BROWN

Appeal No. 2006-1772
Application No. 09/993,359
Technology Center 3700

ON BRIEF

Before CRAWFORD, NAPPI and FETTING **Administrative Patent Judges**.

NAPPI, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. §134(a) of the final rejection of claims 109 through 115, claims 1 through 108 and 116 have been canceled. For the reasons stated *infra* we affirm-in part the examiner's rejection of these claims.

Invention

The invention relates to a gaming machine, which allows a player to play a dice type game having the attributes of the game Bunco. See page 2 of appellants' specification.

Claim 109 is representative of the invention and reproduced below:

109. A gaming machine for playing a Bunco-type dice game comprising:
a video display device;
a cpu having a program operating a dice game;
a wager input mechanism which registers a wager placed by a player;
said program establishing a set of differing gameplay dice elements, including a subset of at least one match point at the start of the game, each said match point having a match indicium for potential matching with a subsequent toss of the dice elements;
said program establishing and displaying a random toss of a plurality of dice elements at each stage of play, and determining for each die element tossed at a stage of play whether its randomly selected indicium matches said match indicium of said match point; and
a payout mechanism providing an award according to a predetermined first payable for each match on a toss.

References

The references relied upon by the examiner are:

Edgeworth	2,125,236	Jul. 26, 1938
Matsumoto	5,263,715	Nov. 23, 1993
Falciglia	5,647,798	Jul. 15, 1997

Dice Gamers Resources –Bunco Rules (<http://www.buncogame.com/brules.shtml>, January 2000).

Rejections at Issue

Claims 109 through 115 stand rejected under 35 U.S.C. § 103 as being unpatentable over Matsumoto in view of Edgeworth and Bunco Rules. The examiner's rejection is set forth on pages 3 through 5 of the answer. Claims 113 and 114 stand rejected under 35 U.S.C. § 103 as being unpatentable over Matsumoto in view of

Edgeworth, Bunco Rules and Falciglia. The examiner's rejection is set forth on pages 5 and 6 of the answer. Throughout the opinion we make reference to the briefs, the answer and the final Office action for the respective details thereof.

Opinion

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejections and the arguments of appellants and the examiner, and for the reasons stated *infra* we sustain the examiner's rejection of claims 109 and 115 under 35 U.S.C. § 103. However, we will not sustain the examiner's rejection of claims 110 through 114 under 35 U.S.C. § 103.

Appellants argue, on page 7 and 8 of the brief, that Matsumoto is directed to a device to display a dice throw where a track ball is used to roll the dice. Appellants argue that Matsumoto does not teach Bunco or matching the indicium on each dice element tossed with the match indicium of a match point, or a game played in successive stages.

On page 8 of the brief, appellants argue that Edgeworth teaches away from the invention and that Edgeworth does not teach the claimed features which are not taught by Matsumoto. Appellants state "[a]lthough the specification of Edgeworth mentions in passing that the invention may be adaptable to dice games such as 'twenty six' and 'Bunco' (col. 1, lns. 32-36), the present invention is quite simply not Bunco, but a Bunco-type dice game. Edgeworth does not disclose a Bunco-type dice game according to the present invention that includes a wager and payout on a video display device." Further, appellants state that Edgeworth does not teach a video display device including a wager and payout as claimed.

On pages 9 and 10 of the brief, appellants argues that the rules of traditional Bunco do not teach the claimed features that are not taught by Matsumoto and Edgeworth. Specifically, appellants argue that the traditional dice game of Bunco is played in rounds, where players roll the dice to get a match point determined based upon the round number. Appellants state, on pages 9 and 10:

The current invention of this application consists of a dice game that is loosely based on an individual player's turn during a round of Bunco. While this game may be played in a casino with live dealers (as is done with the casino game of Craps) or on a gaming machine that propels real physical dice, the preferred embodiment is on a video gaming machine.

But unlike the version of Bunco described above, in this embodiment there may be up to three points which the player is trying to roll. Instead of being a single number, any number that has been rolled on every stage of the current game is a match point. On the first roll, each number that appears on a die becomes a point, for a possible total of three points if all three dice are different (that is, all six possible numbers are points for the first roll). On the second roll, the player must roll one or more points matching the first roll to keep the game going. Any numbers that were rolled on both the first and second rolls remain points for the third roll. The player continues to roll until no dice match a number found in all previous rolls, or until the highest stage upon which a bet has been placed is rolled.

In further contrast, the present invention randomly selects a match point. Traditional Bunco is played in "rounds". [sic] The first round starts with all tables rolling for a "point" of one. The second round starts with all tables rolling for a "point" of two. The "point" increases by one for each subsequent round, whereas the match point of the present invention may be randomly selected.

These arguments by appellants have not persuaded us of error in the examiner's rejection. Appellants' arguments on pages 7 through 10 of the brief center on the disclosed features of appellants' Bunco type game and not the claimed features of gaming machine. As pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim" *In re Hiniker Co.* 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Claims will be given their broadest reasonable

interpretation consistent with the specification, and limitations appearing in the specification will not be read into the claims. *In re Etter* 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985). In analyzing the scope of the claim, office personnel must rely on the appellants' disclosure to properly determine the meaning of the terms used in the claims. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir. 1995). “[I]nterpreting what is *meant* by a word in a claim ‘is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.’” (emphasis original) *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1348, 64 USPQ2d 1202, 1205, (Fed. Cir. 2002) (citing *Intervet America Inc v. Kee-Vet Laboratories Inc.*, 887 F.2d 1050, 1053, 12 USPQ2d 1474, 1476 (Fed. Cir. 1989)).

The preamble of claim 109 states that the gaming machine is for playing a “Bunco-type” game, we consider this limitation to be more than an intended use limitation as the body of the claim further recites operations of the machine to implement the game. The dependent claims also are directed to further describing the operations of the machine to implement the game. However, we do not consider the recitation of a “Bunco-type” game to incorporate all of the rules and operations of appellants' disclosed “Bunco-type” game as to do such would be adding an extraneous limitation appearing in the specification defeat the doctrine of claim differentiation. Thus, we consider the claim term “Bunco-type” in the preamble of claim 109 to be a title for the game as further recited in the claim.

Claim 109 also recites, “a wager input mechanism which registers a wager placed by a player.” We note that the claim does not recite when or how often a wager is placed. Thus, the scope of the claim is broad and encompasses the situation where one wager is placed by a player or the situation where more than one wager is placed by a player. Thus, we do not find that the claim is limited to a wager in each stage of the game as argued by appellants on page 6 of the reply brief.

Claim 109 recites the limitation “said program establishing a set of differing gameplay dice elements, including a subset of at least one match point at the start of the game, each said match point having a match indicium for potential matching with a subsequent toss of the dice elements.” We consider the scope of the limitation of “gameplay dice elements” to include the virtual equivalent to a die (a gaming element that randomly generates values, the values are represented by indicia on the dice, i.e. the indicia of 2 is two dots). We consider the scope of the limitation “match point” to be a value, the indicium of which is to be matched with the indicia displayed by the roll of the dice. See for example page 5, lines 21 through 27 of appellants’ specification. Thus, we consider the scope of claim 109 to include that a set of dice elements are established and that a match point established is a subset of the values which can be generated on the dice. The purpose of the match point is for potential matching with subsequent toss of the dice. We do not find that this limitation of the claim recites how the match point is established or how many match points are used in the game, i.e. we do not find that the claim recites the match point being established by an initial roll of the dice elements as disclosed in appellants’ specification and argued by appellants on page 10 of the brief.

Claim 109 also recites the limitation of “said program establishing and displaying a random toss of a plurality of dice elements at each stage of play, and determining for each die element tossed at a stage of play whether its randomly selected indicium matches said match indicium of said match point.” We consider the scope of this limitation to include that there are multiple stages of play on the game and that a random toss of the dice elements, established in the prior limitation are displayed. Further, the indicium displayed on the dice are compared to the indicium of the match point. We do not find that this limitation recites the effect of a match. The further recitation of “providing an award according to a predetermined first payable for each match on a toss” does establish that an award is paid if there is a match. The limitation also does not identify what happens if no match is made, as such there is no claimed feature making successive stages dependent upon previous stages, as argued on page 5 of the reply brief.

Having determined the scope of claim 109, we next consider the teachings of the prior art.

Matsumoto teaches a computer gaming machine for playing dice games. See abstract. The machine makes use of a video display to display the gaming deck and the images of the dice. See column 3, lines 1 through 9. The players of the game can enter bets (a wager) and receive payouts based upon the bets. See column 14 through 18. The machine is used to play the game of craps where players place bets on the table, based upon the desired outcome of the dice roll, the odds of winning are based upon the position of the bets. See column 2, lines 64 through 67.

Edgeworth teaches a coin operated game device. See column 1, lines 1 through 6. The device can be used to play the dice game of “twenty six” or other games such a “Bunco”. See column 1, lines 32 through 36. Edgeworth describes the game “twenty six” as being a game where a player selects a character of the dice and then rolls the dice, the player is awarded points when the selected character is displayed by the roll of the dice. The player is given 13 rolls of the dice and if after the 13 rolls the player’s point total exceeds 26, the player wins. See column 1, lines 13, through 24. As is apparent from the figures, Edgeworth’s device is a mechanically implemented game as opposed to a game implemented on a digital computer.

The rules of traditional Bunco teaches a game played with three dice by multiple players, paired as teams, and is played in multiple rounds. In each round players roll dice to try to roll the same number as the round, i.e. in round 3 player are trying to roll at least one 3. If one of the dice in the roll matches the round number the player is awarded a point and the player is awarded a point for each match. If all three dice match the round number the player gets a “Bunco” and is awarded 21 points. If there are no matches the dice pass to the next player who rolls the dice. The round ends when one team reaches 21 points. The game is played for 6 rounds and then the player with the highest score wins.

We consider the game of the game of “twenty six” and the game of Bunco to meet the dice game as claimed in claim 109. As stated *supra*, claim 109 does not recite how the match point is determined, only that the match point is a subset of the value represented on the dice. In the game of “twenty six” as taught by Edgeworth, the player selects a match point. See column 1, line 13 and 14. The player then makes successive rolls and accumulates points based upon number of matches. While the selection of the match point is not based upon the initial roll of the dice as discussed in appellants’ specification, such a feature is not claimed. Similarly, we consider the game of Bunco to meet the disclosed dice game. For the forgoing reasons appellants’ arguments have not persuaded us that the claimed “Bunco-type” game differs from that taught by the prior art.

Appellants additionally argue, on pages 10 and 11 of the brief, there is no motivation to combine the references as asserted by the examiner. Appellants reason that Matsumoto contains no reference to matching indicium on the dice element with indicium of a match point. Further, appellants assert that Edgeworth and Bunco rules fail to make up for this deficiency, and in combination fail to teach or suggest the claimed invention of a video display and program to match the randomly selected indicia of the dice element with the selected dice element.

The examiner, in response states, on page 12 of the answer;

Matsumoto is a modern slot machine that is used in playing a dice game. It explicitly discloses craps, but it is clearly adapted to playing virtually any dice game. As noted several times above, craps have many elements of Bunco. Furthermore, one of ordinary skill in the art would have known that Bunco could be implemented on a slot machine - Edgeworth teaches that. Once a decision is made to implement Bunco, it is natural to look to the rules of the game for guidance.

We concur with the examiner. As discussed *supra* we find that Matsumoto teaches a video gaming machine, a slot machine, where a user can play dice games. The gaming machine has a payout mechanism and paytables to determine payout for bets. While we concur with appellants that craps is not a game of matching indicia on the dice

with matching point indicia, craps is a game of matching the sum of values indicated on the dice with player determined match values. Thus, the game of craps is similar to the game of Bunco and twenty six in that they are all games where the object is to have the roll of the dice mach some other value. Note, that the nature of Matsumoto's invention is not directed to the game but rather for "a dice displaying apparatus for a computer game machine which gives the pseudo-real feeling of 'throwing dice.'" Thus, we consider Matsumoto to provide suggestion that the device could be used to implement other dice games. As stated *supra*, Edgeworth teaches a gaming machine which can be used to play the game of "twenty six" and "Bunco." We consider the combination to teach use of the video display gaming machine of Matsumoto to play the game "twenty six" or Bunco. We are not persuaded by appellants' argument, on pages 7 and 8 of the reply brief, that Edgeworth's use of old mechanical technology proves that there is no suggestion to combine or that the combination would produce a computer machine with mechanical wheels to tumble dice. One of the important features of Matsumoto is to provide the feeling of throwing dice, thus we consider that one would recognize that Matsumoto is a teaching using a computer gaming system to play games such as taught by Edgeworth. As disused *supra*, we consider the games of "twenty six" and Bunco to meet the Bunco-type game as claimed in claim 109.

On page 11 and 12 of the brief, appellants present arguments directed to specific claims. On page 11, appellants argue that:

Claim 109 requires a "video display device" and "differing gameplay dice elements, including a subset of at least one match point" and "displaying a random toss of a plurality of dice elements at each stage of play". Although the Examiner contends that this embodiment of the invention would have been obvious to one of ordinary skill in the art at the time of the invention, the Examiner ignored the attributes of the present invention that are not found in light of the traditional rules of Bunco. In the present invention there may be up to three points which the player is trying to roll. Instead of being a single number, any number that has been rolled on every stage of the current game is a match point. On the first roll, each number that appears on a die becomes a point. On the second roll, the player must roll one or more points matching the first roll to keep the game going. Any

numbers that were rolled on both the first and second rolls remain points for the third roll. The player continues to roll until no dice match a number found in all previous rolls, or until the highest stage upon which a bet has been placed is rolled. In further contrast to traditional Bunco rules, the present invention randomly selects a match point, whereas traditional Bunco is played in "rounds" with the first round starting with a "point" of one, the second round starting with a "point" of two. etc.

We similarly are not persuaded by appellants' argument that the examiner's rejection of claim 109 is in error. As discussed *supra* we find that the combination of Matsumoto and Edgeworth teach a video gaming device with display device where there are differing gameplay dice elements, a match point, and wherein a display of a random toss of dice are displayed at each round of the display. Appellants' arguments regarding the number of match points, and the random selection of match points are not commensurate with the scope of the claim. For the forgoing reasons we are not persuaded of an error in the examiner's rejection of claim 109. Accordingly we sustain the examiner's rejection of claim 109 under 35 U.S.C. § 103.

Rejection of claims 110 and 111.

Appellants argue, on page 12 of the brief, claims 110 and 111 require that a bonus award increases with each successive stage of play. Appellants assert this feature is not taught or suggested by the prior art.

The examiner does not directly address this argument in the response to arguments section of the answer. However, in the statement of the rejection, on page 4 of the answer, the examiner states: "progressive jackpots (i.e., those that increase with each round of play until won) are well known to the art."

We do not agree with the examiner's rationale. Claim 110 recites "wherein the payout mechanism includes a second payable provided for a bonus award, said second payable increasing in bonus value with each successive stage of play." Claim 111 is dependent upon claim 110. In rejecting claims under 35 U.S.C. § 103 (a), the examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Oetiker*,

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977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. “In reviewing the [E]xaminer’s decision on appeal, the Board must necessarily weigh all of the evidence and arguments.” *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444). In addition, our reviewing court stated in *In re Lee*, 277 F.3d at 1343, 61 USPQ2d at 1433, that when making an obviousness rejection based on a combination, “there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by Applicant” (quoting *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998)).

We do not find that the examiner has provided objective evidence to show that one skilled in the art would have modified the combined teachings of Matsumoto Edgeworth and Bunco to include a second payable. Accordingly, we will not sustain the examiner’s rejection of claims 110 and 111 35 U.S.C. § 103.

Rejection of claim 112.

Appellants argue, on page 12 of the brief, that claim 112 recites elimination from play any match point, which is not matched on a toss and that this feature is not taught or suggested by the prior art.

The examiner does not directly address this argument in the response to arguments section of the answer. However, in the statement of the rejection, on page 5 of the answer, the examiner states:

In Bunco, any match point that is not matched on a toss is eliminated. (If the match point is 2 and the player fails to throw a 2, the "2" round is over and that match point is eliminated.) The rules teach determining whether to continue with a toss on a subsequent stage of play up to a preset maximum number of stages (6) provided that at least one match point remains for each such subsequent stage. If a player tosses a 1 in the 1 round, the 1 round continues until the player tosses a set of dice that does not contain a 1. Then the player tries to match the next match point (2). This continues through six rounds.

We disagree with the examiner. As stated *supra*, we find that in Bunco, if a roll of a dice does not result in a match point, the roll moves to the next player, the match point value does not change until the next round which begins after one player achieves a score of 21. Similarly, we do not find that the game of “twenty six” taught by Edgeworth, teaches of suggests this feature (in the game “twenty six” the match point remains until the completion of 13 rolls). Accordingly, we will not sustain the examiner’s rejection of claim 112 under 35 U.S.C. § 103.

Rejection of claim 115.

Appellants argue, on page 12 of the brief, that claim 115 recites a plurality of match points with match indicium where some or all of the indicium may be the same, is a feature which is not taught or suggested by the prior art. Further, on page 12 of the reply brief, appellants argue that neither Matsumoto, Edgeworth nor Bunco teach a randomly selected match indicium.

In the statement of the rejection on page 5 of the answer, the examiner refers to the game of “twenty six” taught by Edgeworth, and finds that the game makes use of a plurality of match points that are selected by the user at random.

We concur with the examiner’s rationale. Claim 115 is dependent upon claim 109 and further recites “wherein a plurality of match points are established, each of said plurality of match points having a match indicium selected at random, whereby some or all of said match indicia of said plurality of match points may thereby be the same.” We note that the examiner made the same point in the office action dated August 24, 2005. Appellants’ arguments have not specifically identified why the randomly selected match points in the game of “twenty six” do not meet this claim limitation. As stated *supra*, we find that that the game of “twenty six” meets the limitations directed to match points in claim 109. Further, we concur with the examiner’s finding that the game of “twenty six”

allows the user to select more than one match point. Edgeworth teaches that the user selects the match point, Edgeworth does not teach that the user is constrained as to which indicia must be selected, and thus the selection is random. Therefore, appellants' arguments have not convinced us of error in the examiner's rejection of claim 115. Accordingly, we sustain the examiner's rejection of claim 115 under 35 U.S.C. § 103.

Rejection of claims 113 and 114.

Initially we note that the examiner rejects claims 113 and 114 as being unpatentable over the combination of Matsumoto Edgeworth and Bunco; and also the combination of Matsumoto, Edgeworth, Bunco and Falciglia. As both rejections rely upon the combination of Matsumoto, Edgeworth and Bunco, we will treat both rejections in the same discussion.

On page 12 of the brief and page 11 of the reply brief, appellants argue that claims 113 and 114 contain a randomly allocated free advancement feature, which is not shown in the art. On page 9 of the reply brief, appellants argue that Falciglia discloses an extra spin in a video bingo game and that there is no suggestion or motivation to combine this reference with the dice games of Matsumoto, Edgeworth and Bunco Rules.

The examiner's statement of rejection based upon the combination of Matsumoto, Edgeworth and Bunco does not identify where this feature is taught. The examiner's statement of rejection based upon Matsumoto, Edgeworth, Bunco and Falciglia, state that this feature is not taught by Matsumoto, Edgeworth and Bunco, however is taught by Falciglia. The examiner finds that Falciglia teaches free spins and that their use is to continue a game that would otherwise terminate.

We disagree with the examiner and do not find that the free spin teaching of Falciglia in combination with Matsumoto, Edgeworth and Bunco teaches the limitations of claims 113 and 114. Claim 113 recites "the game includes a randomly selected free advancement feature, and determines a game ending condition if no match is made at a

stage of play unless said free advance feature has been allocated, in which event the game continues to the next stage of play.” Claim 114 recites similar limitations. Falciglia teaches a video bingo game wherein the user is given a number of spins per game to win. One of the characters the user can get is a “free spin” see figure 1, item 7e. If the user gets a free spin character they get to spin again up to a maximum number of spins. See column 5, lines 12 through 19 and column 6, lines 8 through 14. Though, as discussed *supra*, we find that both the game of “twenty six” and traditional Bunco, teach the game as recited in claim 109, we do not find that one skilled in the art would have been motivated to incorporate the free spin feature of Falciglia into either of these games to produce the game as claimed in claims 113 and 114. In the game of “twenty six” the user rolls 13 times and then the game ends, the game does not end when no match is made (as claimed in claims 113 and 114), thus incorporating the free spin of Falciglia into the game of “twenty six” would only result in extra rolls of the dice, not extra rolls of the dice if no match is made as is claimed. Similarly, in the game of Bunco the game does not end if no match is made, rather the roll of the dice is passed to the next player. Thus, we do not find that the combination of Matsumoto, Edgeworth, Bunco rules and Falciglia teach or suggest all of the limitations of claims 113 and 114. Accordingly, we will not sustain the examiner’s rejection of claims 113 and 114 under 35 U.S.C. § 103.

Conclusion

In summary, we sustain the examiner's rejection of claims 109 and 115 under 35 U.S.C. § 103. However, we will not sustain the examiner's rejection of claims 110 through 114 under 35 U.S.C. § 103. The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR ' 1.136(a) (1) (iv).

AFFIRMED-IN-PART

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