

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CLIFTON LIND and JEFFERSON C. LIND

Appeal 2008-4790
Application 10/862,089
Technology Center 3700

Decided: January 5, 2009

Before DONALD E. ADAMS, DEMETRA J. MILLS, and
RICHARD M. LEOVITZ, *Administrative Patent Judges*.

LEOVITZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1, 2 and 4-28. Jurisdiction is under 35 U.S.C. § 6(b). We affirm-in-part the Examiner's final rejection.

STATEMENT OF THE CASE

The claimed invention is to a bingo gaming system “in which a player may use a physical bingo card to participate in bingo games played through an electronic player station. The invention encompasses methods for conducting bingo games, gaming apparatus, and program products” (Spec. 3: 12-15). The claims involve issuing a physical bingo card which is scanned at a player station to produce a scanned output of the card. Game play requests are entered from the player station. After the game is conducted, the game result is also displayed at the player station.

Claims 1, 2, and 4-28 are appealed and stand rejected by the Examiner as follows:

Claims 1, 2, 4-21, and 24-27 under 35 U.S.C. § 102(e) as anticipated by Itkis et al. (US Pub. No. 2003/0137143 A1, published Jul. 24, 2003) (Ans. 3); and

Claims 22, 23, and 28 under 35 U.S.C. § 103(a) as obvious in view of Itkis (Ans. 8).

Claims 1, 8, and 16, which are representative, read as follows:

1. A method including the steps of:

(a) issuing a physical bingo card, the physical bingo card being associated with a card bingo structure;

(b) scanning the physical bingo card at a player station to produce a scan output and applying pattern recognition to the scan output in identifying the card bingo structure through the player station;

(c) collecting a game play request entered from the player station with at least one additional game play request to form a first game group, the game play request being associated with the card bingo structure and each additional game play request in the first game group being associated with a respective additional bingo structure;

(d) conducting a bingo game between the card bingo structure and each additional bingo structure to identify a bingo game result for the card bingo structure; and

(e) displaying the bingo game result for the card bingo structure at the player station.

8. An apparatus including:

(a) a physical bingo card issuing station for issuing a physical bingo card, the physical bingo card being associated with a card bingo structure;

(b) a player station having a scanner associated therewith, the scanner for scanning the physical bingo card to identify the card bingo structure, and the player station for producing a game play request associated with the card bingo structure in response to a player input at the player station and for communicating a bingo game result to a player at the player station; and

(c) a game server in communication with the player station, the game server for collecting the game play request produced by the player station with at least one additional game play request associated with a respective bingo structure to form a first game group, and for conducting a bingo game between the card bingo structure and each additional bingo structure to identify the bingo game result for the card bingo structure.

16. A program product stored on a computer readable medium, the program product including:

(a) scanner program code for controlling the operation of a player station scanner to identify a card bingo structure associated with a physical bingo card;

(b) player station program code for producing a game play request associated with the card bingo structure in response to a player input at the player station, and for controlling communication of a bingo game result to a player at the player station;
and

(c) game server program code for controlling collection of the game play request produced by the player station

program code with at least one additional game play request associated with a respective additional bingo structure to form a first game group, the game server program code also for conducting a bingo game between the card bingo structure and each additional bingo structure to identify the bingo game result for the card bingo structure.

ISSUES ON APPEAL

Claim 1

Does Itkis describe a method of claim 1 comprising: “(c) collecting a game play request entered from the player station” and “(e) displaying the bingo game result for the card bingo structure at the player station”?

Claim 8

Does Itkis describe an apparatus comprising “(a) a physical bingo card issuing station,” “(b) a player station having a scanner associated therewith,” and “(c) a game server” as in claim 8?

Claim 16

Does Itkis describe a play station code “for producing a game play request associated with the card bingo structure in response to a player input at the player station, and for controlling communication of a bingo game result to a player at the player station” as recited in claim 16?

PRINCIPLES OF LAW

Because the hallmark of anticipation is prior invention, the prior art reference – in order to anticipate under 35 U.S.C. § 102 – must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements “arranged as in the claim.” *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983).

Net MoneyIN, Inc. v. VeriSign, Inc., 545 F.3d 1359, 1369 (Fed. Cir. 2008).

[W]here a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation. *See Bell Communications*, 55 F.3d at 620; *Kropa v. Robie*, 38 C.C.P.A. 858, 187 F.2d 150, 152, 88 USPQ 478, 481 (1951).

The determination of whether preamble recitations are structural limitations or mere statements of purpose or use “can be resolved only on review of the entirety of the patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim.” *Corning Glass Works*, 868 F.2d [1251] at 1257 [(Fed. Cir. 1989)]. The inquiry involves examination of the entire patent record to determine what invention the patentee intended to define and protect.

Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997).

“There is an extensive body of precedent on the question of whether a statement in a claim of purpose or intended use constitutes a limitation for purposes of patentability. . . . Such statements often, although not necessarily, appear in the claim’s preamble” *In re Stencel*, 828 F.2d 751, 754 (Fed. Cir. 1987).

Claim 1

Findings of Fact

1. Itkis teaches a self-service kiosk 1, operated by a user, which dispenses bingo cards printed by a printer responsive to a computer (Itkis, at ¶¶ 1, 26, 28).
2. Using a touchscreen, a user purchases the bingo cards from the self-service kiosk (Itkis, at ¶ 26 (col. 2)). Upon purchase, the kiosk dispenses computer-printed bingo cards (*id.* at ¶ 26).

3. The printed bingo cards include a barcode 48 which “may be a concatenated and/or hashed number consisting of a bingo pack number **15**, series number **47** and bingo game number **16**” (Itkis, at ¶ 29).
4. The kiosk comprises a personal computer (PC) 4 and a barcode reader 37 to scan a refund receipt 64 (Itkis, at ¶¶ 27 and 37 (col. 2)). The barcode reader is a scanner.
5. The kiosk can be networked to a bingo caller terminal 23 that comprises a personal computer PC 24, a barcode reader 35, and a bingo ball blower 31 to call bingo numbers (Itkis, at ¶¶ 14, 27; Fig. 2).
6. The bingo terminal 23 comprising PC 24 can coordinate kiosk activities, including broadcasting called bingo numbers to participating kiosks (Itkis, at ¶ 36).
7. The PC 24 acts as a server (Itkis, at ¶ 37 (col. 2)) and maintains a database of all sold cards and can verify a winning card (*id.* at ¶ 35). Fig. 2 shows a verified card being displayed at a touchscreen monitor 29 of the bingo caller terminal 23 (Itkis, at ¶ 27; *see* Fig. 2).

Claim 1

8. Claim 1 is directed to a method comprising the following steps:
 9. (a) issuing a physical bingo;
 10. (b) “scanning” the bingo card at a player station;
 11. (c) “collecting” a game request entered from the player station with the “request being associated with the card bingo structure”;
 12. (d) conducting a bingo game; and
 13. (e) “displaying” the bingo game result at the player station.
14. The steps of “(b) scanning,” “(c) collecting,” and “(e) displaying” occur at the play station of claim 1.

15. We interpret the claimed step (c) of “collecting a game play request entered from the player station” to read on the purchase of a computer-printed bingo cards from the kiosk 1 of the Itkis system (FF1, 2).

16. Thus, in the parlance of claim 1, Itkis kiosk 1 serves as a “player station.”

17. We further interpret step (e) of claim 1 reciting “displaying the bingo game result for the card bingo structure” to correspond to the verification and display of a verified bingo card on the touchscreen monitor 29 of the terminal 23 as taught by Itkis (FF7).

18. The (e) “displaying” and winning verification described in Itkis occurs at the terminal 23 (FF7), not the kiosk “player station” 1 as required by claim 1 (see FF13).

19. In sum, both steps (c) and (e) as described in Itkis do not occur at a “player station” as required by claim 1 (*see* FF14).

Analysis

Anticipation requires that every element of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Net MoneyIN*, 545 F.3d at 1369. Claim 1 is directed to a method comprising (c) “collecting” a game request entered at a play station and (e) “displaying” a bingo game result also at the play station (FF11, 13, 14). Itkis describes a method in which the game request is entered at a play station (“kiosk 1) (FF15) (i.e., step (c) of claim 1). However, the (e) displaying step occurs at a bingo caller terminal 23, which is a separate location from the player station (FF7, 17, 18). In sum, steps (c) and (e) as described in Itkis do not occur at a “player station” as required by claim 1 (FF19). Therefore, Itkis

does not describe every element of the claimed invention as arranged in the claim and does not anticipate it. We reverse the rejection of claim 1.

Claim 8

Findings of Fact

20. Claim 8 is directed to an apparatus comprising:
21. (a) a physical bingo card issuing station,
22. (b) “a player station having a scanner associated therewith,” and
23. (c) “a game server.”
24. The scanner is “for scanning the physical bingo card to identify the card bingo structure.”
25. The player station is “for producing a game play request associated with the card bingo structure in response to a player input at the player station and for communicating a bingo game result to a player at the player station.”
26. The Specification describes the claimed uses of the scanner and play station to be embodied by program code:

A program product embodying the principles of the invention includes scanner program code, player station program code, and game server program code. The scanner program code controls the operation of the player station scanner to identify the card bingo structure associated with the physical bingo card. The player station program code produces the game play request in response to the player input at the player station and controls the communication of the bingo game result to the player at the player station.

(Spec. 5: 6-14.) *See also* Spec. 13: 12-15 which refers to a “computer program code” for performing player station functions (“EPS 103”) and which is referenced in the Appeal Brief on page 3 in its summary of the play station as recited in claim 8.

27. We interpret the phrase “for scanning” (FF24), “for producing” (FF25), and “for communicating” (FF25) as intended uses of the claimed scanner and player station and not to further limit the scanner and station structures.

28. Itkis describes a physical bingo card issuing station (FF2) as in (a) of claim 8 (*see* FF21).

29. Itkis also describes a kiosk with a barcode reader (FF4) which meets the limitation of claim 8 of (b) “a player station having a scanner associated therewith” (*see* FF22).

30. Itkis’s system comprises a server as part of terminal 23 (FF6, 7) that satisfies the limitation of claim 8 of (c) “a game server” (*see* FF 23).

Analysis

Claim 8 is directed to an apparatus comprising a physical bingo card issuing station, a play station with a scanner, and a game server (FF20-23). Itkis describes a bingo system with all three elements (FF28-30).

The claim also states what each of the play station and scanner is “for” (FF24-25) and thus specifies a use of these claimed elements. The determination of whether a recitation is a structural limitation or a mere statement of purpose or use “can be resolved only on review of the entirety of the patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim.” *Rowe v. Dror*, 112 F.3d at 478. In this case, the Specification refers to a “program code” which is responsible for performing each of the uses recited in claim 8 for the play station and scanner (FF26; Spec. 5: 6-14; 13: 12-15). Thus, the claimed “for scanning,” “for producing,” and “for communicating” (FF24-25) limitations are described in the Specification as produced by program code and are not characterized as structural limitations of the play station and scanner,

themselves. For this reason, we treat these as “intended use” limitations that do not modify the play station or scanner structures. Consequently, since Itkis teaches a bingo system meeting the structure required by claim 8, we agree with the Examiner’s determination that claim 8 is anticipated by Itkis. Appellants have not identified any structural components of the claimed play station, scanner, and game server which distinguish this claimed subject matter from Itkis’s bingo system. We therefore affirm the anticipation rejection of claim 8.

Claim 16

Findings of Fact

31. Claim 16 is directed to a program product comprising:

32. (a) scanner program code “for controlling the operation of a player station scanner to identify a card bingo structure associated with a physical bingo card.”

33. (b) player station code “for producing a game play request associated with the card bingo structure in response to a player input at the player station” and “for controlling communication of a bingo game result to a player at the player station”; and

34. (c) game server program code for controlling collection of the game play request and conducting a bingo game.

35. As with claim 1, we interpret kiosk 1 of Itkis to serve as the player station (FF16).

36. The (b) player station code is required to produce a game play request associated with a card bingo structure (*see* FF33), a function which is

performed by Itkis kiosk 1 in dispensing computer printed bingo cards in response to a user request made by a touchscreen (FF1, 2).

37. The player station code is also required by the claim to have a structure “for controlling communication of a bingo game result to a player at the player station” (*see* FF33).

38. The Itkis kiosk does not communicate the bingo result to the player as in claim 1 (*see* FF37). Rather, this is performed at the bingo call terminal 23 which displays a winning verified card at its touchscreen monitor 29.

Analysis

Claim 16 is directed to a program product comprising scanner program code, player station code, and game server code (FF31-34). The player station code is required to produce a game play request associated with a card bingo structure, a function which is performed by Itkis kiosk 1 in dispensing computer printed bingo cards in response to a user request made by a touchscreen (FF36). The player station code is also required by the claim to have a structure “for controlling communication of a bingo game result to a player at the player station” (FF37). The Itkis kiosk does not *communicate* the bingo result to the player as in claim 1 (FF38). Rather, this step is performed at the bingo call terminal 23 which displays a winning verified card at its touchscreen monitor 29. Since Itkis fails to teach all the elements of claim 16 as arranged in the claim, we reverse its rejection.

CONCLUSIONS OF LAW

Itkis does not describe a method in which a play station is “(c) collecting a game play request entered from the player station” and “(e) displaying the bingo game result for the card bingo structure at the player

station” as in claim 1. We reverse the anticipation rejection claim 1 and dependent claims 2, 4-7 and 21.

Itkis describes an apparatus comprising (a) a physical bingo card issuing station, (b) “a player station having a scanner associated therewith,” and (c) “a game server” as in claim 8. We affirm the rejection of claim 8 as anticipated by Itkis. Claims 9-15, 24, 25, and 26 fall with claim 8 because separate reasons for their patentability were not provided. 37 C.F.R. § 41.37(c)(1)(vii).

Itkis does not describe a play station code “for producing a game play request associated with the card bingo structure in response to a player input at the player station, and for controlling communication of a bingo game result to a player at the player station” as recited in claim 16. We reverse the anticipation rejection of claim 16 and dependent claims 17-20 and 27.

Claims 22, 23, and 28

Claims 22, 23, and 28 under 35 U.S.C. § 103(a) as obvious in view of Itkis (Ans. 8).

Claims 22 and 23 depend on claim 1 and therefore incorporate all its limitations. Claim 28 depends on claim 16 and therefore incorporates all its limitations. We reversed the anticipation rejections of claims 1 and 16. The Examiner has not provided any additional rationale as to why the subject matter of claims 1 and 16 would have been obvious in view of Itkis. As the limitations of independent claims 1 and 16 have not been met, we conclude that the Examiner has not provided sufficient evidence that claims 22, 23, and 28, which incorporate all the limitations of the independent claims, would have been obvious in view of Itkis.

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CONCLUSION OF LAW

The rejection of claims 22, 23, and 28 as obvious in view of Itkis is reversed.

TIME PERIOD

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

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