

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JOHN A. MARTA

Appeal No. 2004-1219
Application No. 10/115,632

HEARD: August 18, 2004

Before ABRAMS, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is in response to the appellant's request for rehearing¹ of our decision mailed August 31, 2004, wherein we affirmed the examiner's rejection of claims 1 to 6 under 35 U.S.C. § 103.

¹ Filed October 4, 2004.

We have carefully considered the argument raised by the appellant in their request for rehearing, however, that argument does not persuade us that our decision was in error in any respect.

The argument raised by the appellant is that there is no suggestion, teaching or motivation to combine the applied prior art so as to arrive at the playing of the conventional game of craps on a slot machine absent the use of hindsight knowledge derived from the appellant's own disclosure.²

Claim 1 on appeal reads as follows:

A slot machine gaming apparatus for play of the game of craps by a player, comprising:
a single, free-standing housing containing
 means for simulating play of the dice game of craps^[3], and
 means for tallying cumulative winning or positive outcomes of said play according to a predetermined schedule and the rules of said game, and
 means for displaying and paying out to said player the total winnings, if any, accrued during said play.

² The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

³ The American Heritage[®] Dictionary of the English Language, Third Edition, 1992, defines "craps" as "[a] gambling game played with two dice in which a first throw of 7 or 11 wins, a first throw of 2, 3, or 12 loses the bet, and a first throw of any other number (a point) must be repeated to win before a 7 is thrown, which loses both the bet and the dice." This is the broadest reasonable meaning of the term "craps" as it would be understood by one of ordinary skill in the art, taking into account the enlightenment afforded by the written description contained in the appellant's specification. See In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

In the BACKGROUND OF THE INVENTION section of the application (pp. 2-4), the appellant teaches that:

In the conventional game of craps, two standard, matched dice are used. The players start the game by rolling for "high dice" and the player who rolls the highest total on the two dice plays the game first, becoming the "shooter" (or the "roller" or "caster") Variations on the casino play of the game are discussed more fully below.

Initially, the shooter may bet any desired amount. He announces his bet and places it on the playing surface, generally in the center of the surface being played upon. The shooter's bet may be accepted, or "faded", in whole or in part, by any other player. Each player, in turn to the caster's left, may take (fade) as much of the shooter's bet as he wishes, with precedence accorded to a player willing to fade the entire bet.

When the bet is faded, the shooter rolls the dice from his bare hand, no cup ever being used, shaking them before rolling, generally producing clicking to assure the other players that he is not casting them in a preset position or mode.

Under the rules of the game, if the faces of the two dice add up to 7 or 11 on the first roll, that is termed a "natural", and the shooter wins immediately. He collects the bets and keeps the dice, and the betting and fading proceed to the next roll of dice.

However, if the total on the dice at the first cast is 2, 3 or 12, that outcome event is termed "craps" or "crapping out", and the shooter loses, but he keeps the dice.

If the total shown on the first roll is any other of the possible numbers--4, 5, 6, 8, 9 or 10--the number shown on the dice becomes the shooter's "point". At this stage of play, the shooter has neither won nor lost. He continues to roll until either: (a) the dice repeat the same number, that is, he makes his point, in which case he wins, or (b) the dice rolled total 7, in which case he loses and the dice pass to the next player on his left, who becomes the new shooter.

A winning roll, whether from a natural or from making a point, is called a "pass". After each pass, the shooter may change his bet.

In usual play, side bets are permitted. That is, having rolled a point, the shooter bets additionally on whether or not he will make his point, and other players may bet on the same question among themselves. To win consistently, a player must be cognizant of the odds available at each throw of the dice.

In most games, there is continual action in betting. If the shooter rolls a point, he may additionally bet on the series of rolls beginning with his next roll, which are called "come" or "don't come" bets. He may bet that he is "right" or "wrong", meaning that he will shoot a winning number or crap out, respectively, in the next roll. These designations may have different meanings in different localities, so the player should ascertain the meaning of these terms at the location of play.

The appellant's specification states (p. 7) that:

The present invention provides, in slot-machine format, all of the thrills associated with the play of the game of craps and is similar, in every respect, to the play of the game at a casino craps table. Eliminated in the device of the invention are all biases in favor of the house such as those arising from biased dice or an overly skilled croupier. In fact, in the play of the game according to the invention, human intervention is eliminated completely.

Other casino games, and even pari-mutuel horse racing, have been adapted so as to be played in slot-machine-like devices. For example, poker, keno, lotto and bingo all have slot-machine counterparts to be found in the patent literature (see, e.g., U.S. Pat. Nos. 5,935,002 and 5,800,269). No known reference, however, discloses or suggests play of the game of craps, in all its significant detail, in the configuration of a slot machine.

Moore's invention relates generally to dice games utilizing two dice outputs to generate numbers based multiple repetitions or a count of numbers prior to novel termination and payout events. Moore's invention may be used on a traditional craps table or on a Four The Money Table. Moore's dice game may be embodied in a table or slot

machine format. The preferred embodiment differs from traditional craps in that there is no requirement of a repeated number roll for a win. In one embodiment, a number other than seven, the target number, can be rolled on two six sided dice, numbered on sides from 1-6, in a tournament style fashion over a selected calendar period to win the primary wager. These games include counting the rolls on different players and comparing those rolls and making an award to the player making (a) the most rolls, (b) the most points, (c) the fewest points or rolls or (d) enhanced pay outs for higher targets during a limited (e.g., 4) number of dice rolls. The invention also envisions the addition of points in a given number of rolls to generate a total which is compared to a central number or to reach certain specific numbers. A video (slot) game (i.e., slot machine format) is disclosed which replaces traditional displays with multiple dice rolls in a novel fashion otherwise consistent with Moore's disclosure.⁴ Moore teaches (column 7, lines 18-19) that "the subject game could be incorporated completely or in part with a pre-existing craps game."

The Admitted Prior Art teaches the conventional game of craps.⁵

⁴ Thus, Moore's dice game differs from the conventional game of craps.

⁵ Note the BACKGROUND OF THE INVENTION section of the application quoted above.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art without the use of impermissible hindsight knowledge. As set forth in Ecolochem, Inc. v. Southern California Edison, 227

F.3d 1361, 1375, 56 USPQ2d 1065, 1075 (Fed. Cir. 2000):

"[T]he suggestion to combine may be found in explicit or implicit teachings within the references themselves, from the ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved." ... However, there still must be evidence that "a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." ... "[A] rejection cannot be predicated on the mere identification ... of individual components of claimed limitations. Rather particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.".... [Citations omitted].

Thus, the issue before us is whether the combined teachings of the applied prior art (i.e., Moore and the Admitted Prior Art) teaches or suggests the playing of the conventional game of craps on a slot machine without the use of impermissible hindsight knowledge.

It remains our opinion that there is sufficient suggestion, teaching or motivation in the applied prior art to arrive at the subject matter of claim 1.⁶ In that regard, Moore clearly

⁶ The teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999).

teaches that dice games can be embodied in either a table or slot machine format.^{7,8} In view of this teaching of Moore, it is our conclusion that it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have embodied the conventional game of craps in a slot machine for the self evident advantages thereof such as not having to physically contact and throw the dice. Moreover, in view of Moore's teaching that "the subject game could be incorporated completely or in part with a pre-existing craps game," it continues to be our view that Moore suggests a slot machine which can play both Moore's dice games and the conventional game of craps.

In light of the foregoing, the appellant's request for rehearing is granted to the extent of reconsidering our decision, but is denied with respect to making any change thereto.

⁷ The appellant admits (specification, p. 8) that other casino games (e.g., poker, keno, lotto and bingo) have been adapted so as to be played in slot-machine-like devices.

⁸ It must be borne in mind that where two known alternatives are interchangeable for their desired function, an express suggestion of the desirability of the substitution of one for the other is not needed to render such substitution obvious. See In re Fout, 675 F.2d 297, 301, 213 USPQ 532, 536 (CCPA 1982); In re Siebentritt, 372 F.2d 566, 568, 152 USPQ 618, 619 (CCPA 1967).

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

REQUEST FOR REHEARING - DENIED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
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Appeal No. 2004-1219
Application No. 10/115,632

Page 9

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