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**Datasheet for the decision
of 29 June 2007**

Case Number: T 1543/06 - 3.2.04

Application Number: 02764683.5

Publication Number: 1406709

IPC: A63F 13/00

Language of the proceedings: EN

Title of invention:

System and method for adding a skill aspect to games of chance

Applicant:

Gameaccount Limited

Opponent:

-

Headword:

game machine/GAMEACCOUNT

Relevant legal provisions:

EPC Art. 52(1), 52(2), 52(3), 56, 112(1)

Keyword:

"Patentable inventions - technical and non-technical features"
"Patentable inventions - games"
"Inventive step - no (all requests)"
"Enlarged Board - request for referral - admissible (no)"

Decisions cited:

T 0931/95, T 0935/97, T 1173/97, T 0060/98, T 0641/00,
T 0258/03, T 0928/03, T 0154/04

Judgment of the England and Wales Court of Appeal in re
Aerotel Ltd. v Telco Holdings Ltd. (and others) and
Macrossan's Patent Application [2006], ECWA Civ 1371



Case Number: T 1543/06 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 29 June 2007

Appellant: Gameaccount Limited
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Representative: Lawrence, John
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 30 March 2006
refusing European application No. 02764683.5
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: M. Ceyte
Members: A. de Vries
T. Bokor

Summary of Facts and Submissions

I. On 14 June 2006 the Appellant lodged an appeal against the decision of the Examining Division posted 30 March 2006, refusing the European patent application no. 02 764 683.5 and paid the prescribed fee. The grounds of appeal were filed with letter of 8 August 2006.

The Examining Division held that the application did not meet the requirements of Articles 52(1) and 56 EPC.

II. Oral proceedings were held on 29 June 2007 in the absence of the duly summoned Appellant who, with letter of 28 June 2007 stated he would not appear.

III. The Appellant requests that the decision under appeal be set aside and that a patent be granted on the basis of the set of claims on which the examining division made its decision (main request) or, alternatively, on the basis of one of the sets of claims in accordance with first or second auxiliary requests filed with the grounds of appeal, or in accordance with third, fourth or fifth auxiliary requests submitted with letter of 29 May 2007. As a final, sixth auxiliary request, the Appellant requests to refer the present case to the Enlarged Board of Appeal.

IV. The wording of the independent claims of the requests is as follows :

Main Request

1. "A system for executing a game or other application in which users makes moves, the system comprising:

a processor; and

a monitor for displaying an indicator, the indicator displaying a plurality of numbers,

wherein the processor is configured to:

advance a piece a number of positions in a game corresponding to a plurality of numbers pursuant to user input from an input device; and

control the indicator so as to activate the indicator a predetermined number of times to determine a first sequence of a plurality of move numbers, and wherein said advancing comprises advancing a first time by a number of positions corresponding to the first move number of the first sequence of move numbers and advancing a second time by a number of positions corresponding to the second move number of the sequence of move numbers."

11. "A system for executing a game or other application in which users makes moves, the system comprising:

a processor; and

a monitor for displaying an indicator, the indicator displaying a plurality of numbers,

wherein the processor is configured to:

advance a number of positions corresponding to the one or more numbers; and

control the indicator so as to activate the indicator a predetermined number of times to determine a first group of a plurality of move numbers,

wherein said advancing comprises advancing a first time by a number of positions corresponding to a first move number of the first group of move numbers; and

the processor is further configured to control the indicator so as to activate the indicator a second time to determine a substitute move number to replace the first move number of the first group of move numbers."

1st Auxiliary Request

Claim 1 is as in the main request but for a minor change in lines 12 and 13 ("comprising the plurality" instead of " of a plurality"), while in the final feature advancing first and second times is by a number of positions corresponding to "one of a plurality of numbers" respectively "a different number of the plurality of numbers" instead of "first move number" respectively "second move number".

Claim 14 is as claim 1 but drops the last two lines of the last feature ("advancing a second time plurality of numbers") while adding the following further feature : "the processor is further configured to control the indicator so as to activate the indicator a second time to determine a substitute number to replace the first number of the first group."

2nd Auxiliary Request

Claim 1 reads: "A system for displaying moves in a game or other application, comprising:

a processor, and

a monitor for displaying a fixed predetermined plurality of numbers, wherein the processor is

configured to use an indicator to display the plurality of numbers, and wherein the processor is arranged to control the indicator so as to display the plurality of numbers so that a user can see the same number of future numbers as they use the system to play a game".

Claim 14 is as in the 1st auxiliary request but adds the final lines "so that the number of numbers in the first group remains constant".

3rd Auxiliary Request

The claims are identical to those of the 2nd auxiliary request but for a minor re-edit in claim 1 ("system to display" instead of "system for displaying").

4th Auxiliary Request

Sole independent claim 1 is identical to claim 14 of the 1st auxiliary request.

5th Auxiliary Request

Sole independent claim 1 is as claim 1 of the main request but replaces the final feature ("and wherein said advancing ...") by the following wording: "and wherein said advancing comprises advancing a first time by a number of positions corresponding to the first one of the sequence of the plurality of numbers and advancing a second time by a number of positions corresponding to the second number in the sequence of the plurality of numbers, and wherein the processor is arranged to control the indicator so as to display to a user using the system said sequence of fixed

predetermined plurality of numbers and is arranged so as to add a new number to one end of the sequence when the first number is used from the other end of the sequence, so that the same number of numbers in the sequence is visible to a user using the system for each of their turns for moving pieces".

V. In its decision the Examining Division argued that the claimed invention was an obvious implementation of game rules on a computer. Regardless of whether they are novel or not, game rules can not contribute to inventive step as they are excluded from patentability under Article 52(2)(c)ECP following the approach of T 641/00 ("Comvik").

VI. The Appellant argues as follows:

The claimed invention does not concern the game rules per se, but rather a new apparatus for playing a game and is thus clearly patentable. In particular it is directed at a new type of number indicator which is divorced from any particular game rules. This indicator is a technical tool that adds a degree of predictability and a degree of skill to a game.

Assessing inventive step following the approach of T 0641/00 is inherently wrong as that approach is based on the fiction that what is in fact hidden from the public may be regarded as prior art.

If it is to be applied it should be done in a fair manner by consideration to the true technical contribution as in T 0060/98 and T 0928/03. Such a contribution resides in the provision of a graphical

user interface by way of an indicator presenting fixed or scrolled sets of number, which has the effect of affecting the efficiency of the process of playing the game which also adds a degree of skill, predictability, sophistication and interest to the game.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.
2. *"Mixed" inventions*
 - 2.1 Before considering the present case in detail, and in view of the Respondent's main arguments questioning the validity of methodology applied by the Boards of Appeal of the EPO in dealing with "mixed" inventions, the Board wishes to summarize that methodology. "Mixed" inventions are inventions having both technical and non-technical features, where "non-technical" relates to matter which under Article 52(2) EPC is not to be regarded as an invention in the sense of Article 52(1) EPC.
 - 2.2 Article 52(1) EPC in conjunction with Articles 52(2) and (3) EPC is generally interpreted as implying a requirement of technical character for a claimed invention to be patentable, cf. Case Law of the Boards of Appeal of the EPO, edition 2006 (hereinafter CLBA), I.A.1. Whereas technical character was previously assessed using the "contribution approach" (see CLBA, I.A.1, second paragraph), recent case law has abandoned this approach in favour of one which recognizes the

requirement of technical character as separate and independent of the remaining requirements of Article 52(1) EPC, in particular novelty and inventive step, and compliance of which can therefore be assessed without having recourse to the prior art. The most liberal approach (from the applicant's point of view) is that first adopted in T 931/95 (OJ EPO 2001, 441) and refined in T 258/03 (OJ EPO 2004, 575) according to which (see reasons 4.5; head-note I) technical character results either from the physical features of an entity or (for a method) from the use of technical means. While an invention as a whole may possess technical character, it may nevertheless legitimately include both technical and non-technical features, cf. T 641/00 (OJ EPO, 2003, 352).

2.3 The cornerstone of the assessment of inventive step by the EPO is the problem-solution approach, which is fundamentally technical in nature. Such an approach must necessarily differentiate between technical and non-technical features when applied to "mixed" or hybrid inventions, cf. CLBA, I.D.8.1.2. In the approach adopted by T 641/00, head-note I, an "invention consisting of a mixture of technical and non-technical features and having technical character as a whole is to be assessed with respect to the requirement of inventive step by taking account of all those features which contribute to said technical character whereas features making no such contribution cannot support the presence of inventive step". This principle is recognized also by the present Board.

2.4 The Board is aware of criticism of the above approach as e.g. most recently expressed in the Judgement of the

England and Wales Court of Appeal in re Aerotel Ltd v Telco Holdings Ltd (and others) and Macrossan's Patent Application, ECWA Civ 1371, and echoed in the Respondent's submissions in the present case. Decision T 0154/04 of 15 November 2006 (to be published in the OJ EPO) has addressed these criticisms in detail. It summarizes the main principles underlying the relevant jurisprudence of the Boards of Appeal (see reasons 5) and provides a solid analysis of their legal basis (reasons 8 to 17). Of particular interest, see reasons 12, are possible differences in interpretation of the legal concept of "invention" that may lie at the heart of the criticisms.

- 2.5 The Board adds that the principle as expressed in T 641/00 may also reformulated as follows: an invention which as a whole falls outside the exclusion zone of Article 52(2) EPC (i.e. is technical in character) cannot rely on excluded subject matter *alone*, even if novel and non-obvious (in the colloquial sense of the word), for it to be considered to meet the requirement of inventive step. The Board is of the firm belief, that it cannot have been the legislator's purpose and intent on the one hand to exclude from patent protection such subject matter, while on the other hand awarding protection to a technical implementation thereof, where the only identifiable contribution of the claimed technical implementation to the state of the art is the excluded subject-matter itself. It is noted that here the term "contribution" encompasses both means (i.e. tangible features of the implementation) and effects resulting from the implementation. In that case Article 52(2) EPC would be reduced to a mere requirement as to form, easily

circumvented. The Board believes it is intended as substantive in nature, whatever considerations may have been the source of this exclusion at the time of its adoption.

- 2.6 It follows from the above that the mere technical implementation of excluded subject-matter *per se* cannot form the basis for inventive step. The Board concludes that inventive step can be based only on the *particular manner* of implementation. To this end it is therefore necessary to ask *how the per se excluded subject-matter (e.g. a game or business method) is implemented*. In the context of the problem-solution approach this can be rephrased as a fictional technical problem in which the *per se* excluded subject matter appears as an aim to be achieved, cf. T 641/00 head-note II. Where such excluded subject matter is novel such a formulation of the problem seemingly implies that such matter may be regarded as a given in the assessment of inventive step, which thus appears to depart from what is in fact a hidden starting point. The Board views this fiction as an artefact of the systematic use of the problem-solution approach for assessing inventive step and the need to differentiate between excluded and non-excluded matter. This should not detract from the basic tenet that excluded subject-matter cannot form the sole basis for a patentable invention. Nor should it obscure the significance of the Boards' approach summarized under points 2.2 and 2.3 above, which allows the issues of technicality and inventive step to be untangled in a manner enabling a much more systematic and objective assessment to be made of all patentability requirements than has hitherto been possible under the contribution approach.

- 2.7 A consideration of the particular manner of implementation must focus on any *further* technical advantages or effects associated with the specific features of implementation over and above the effects and advantages inherent in the excluded subject-matter. The latter are at best to be regarded as incidental to that implementation.
- 2.8 The explicit requirement of a "further" technical effect has been first formulated for computer-related inventions in decisions T 1173/97 (OJ EPO, 1999, 609), see head-note and point 9.4 of the reasons, and see also T 935/97 (not published in the OJ EPO), but the same principle holds also for other categories of excluded subject-matter which may inherently possess some "technical" effect. In fact, inherent and arguably technical effects may be easily identified for practically all excluded subject-matter, for example such a simple one as reducing time when using or performing it. This is why it needs to be stressed that the "further" technical effect can not be the same one which is inherent in the excluded subject-matter itself.
- 2.9 This consideration of the specific implementation must moreover be from the point of view of the relevant skilled person under Article 56 EPC, who may be identified on the basis of the invention's technical character. This is analogous to the approach of T 928/03 (not published in the OJ EPO), which considers the actual contribution of each feature to the technical character by, for each feature, stripping away its non-technical content. Thus, see reasons 3.2, "the extent to which the characterizing features

contribute to the technical character ... in relation to the effects achieved by those features" must be determined.

3. *The invention*

The present invention relates to games in which moves are made based on randomly-generated numbers. It is concerned in particular with introducing an element of predictability and hence skill into the game, and does so by providing a *plurality* of move numbers *in advance* and in such a manner that a player in any given turn can play his piece(s) using his knowledge of numbers available for future turns. This central idea is presented in a number of variant forms in which the numbers are used in a given order or in any order; or in which they are replaced when all have been exhausted, or individually, after each number is used. These variations - and combinations thereof - as implemented on a system with a processor and a monitor form the subject of the claims of the main to fifth requests.

4. *Technical Nature of the Invention*

4.1 As the claims (main to fifth auxiliary request) are directed at a system including at least a processor and a monitor, the claimed subject-matter undoubtedly has technical character following the approach of T 931/95 and T 258/03 mentioned in section 2.2 above. Thus, each of the claims (all requests) define subject-matter which is an "invention" in the sense of Article 52(1) read in conjunction with Articles 52(2) and (3) EPC.

4.2 As noted above, the central idea of the present invention concerns the way move numbers are generated and used in game play, namely in groups provided in advance to the player. This may in fact be read as instructions typical of playing a (board) game as these would for example appear on a sheet of game rules provided with such a game ("each player throws six dice and in turn moves his pieces by a number of places on one of the dice until all numbers have been exhausted"). One can easily imagine their inclusion in modified versions of Monopoly, Snakes and Ladders etc. Description page 9, lines 14 to 16, in fact explicitly suggests an embodiment in which "a game or other application comprises *rules* to implement any of the methods described ", where, see page 3, lines 32 and 33, numbers can be generated by dice or dominos.

From the above, the Board can draw no other conclusion than that the central concept pertains to rules of playing a game, in particular those rules of the game defining the steps in which numbers are generated and used. Rules of playing games are explicitly mentioned under Article 52(2)(c) EPC as not to be regarded as inventions within the meaning of Article 52(1) EPC. Consequently, the claims (all requests) also include non-technical features (following the definition of section 2.1) so that the inventions claimed therein are of "mixed" nature.

5. *Inventive Step*

5.1 Though the claims clearly do not relate to rules for playing a game *as such* and their subject-matter is thus not excluded from patentability under Article 52(3) EPC,

nevertheless, following the principle of T 641/00 (see section 2.3 above) as reformulated in sections 2.5 and 2.6, inventive step cannot be based on the mere technical implementation of these rules. It is therefore necessary - see section 2.7 above - to consider more closely *how*, i.e. in what particular manner the rules have been implemented.

5.2 Implementation is by way of a monitor and processor of what is effectively a computer system, which in most of the claims also has an input device. Computer implementation of games is per se manifestly known. This fact allows the Board to identify the skilled person as a gaming software engineer, skilled in the field of computer games.

5.3 The details of the implementation are as follows: the processor controls an "indicator", i.e. some functionality for producing move numbers, to provide a sequence of move numbers, which is displayed on the monitor, and advances pieces using the numbers generated and user input in accordance with one of the game rule variants described in section 3 above (in claim 1 of the 2nd auxiliary request this latter function is missing). In some claims it also controls the indicator to replace used numbers, see section 3 above. In short, the processor is configured to carry out game play including move number generation in accordance with the game rules, the monitor serving as interface. The processor thus carries out the steps in game play normally carried out by a player in a board game according to the same game rules (throwing dice, moving pieces) with the monitor displaying the faces of the dice. From the skilled person's perspective, these

are precisely those functions that would be assigned as a matter of course to processor and monitor, if he were given the task to implement the game rules of section 3 on a computer with the purpose of automating game play. In fact the claims (main to fifth auxiliary requests) define no more than the general idea of implementing these rules on a computer.

5.4 The Board is unable to identify any effects other than those inherent in the game rules themselves or those connected to the carrying out of functions by a computer with a processor and display. There is also no identifiable synergic effect between the game rules and the technical implementation. The claims (and description) provide no detail as to how exactly the processor is configured to perform these functions, or how the monitor displays the indicator. The effect identified by the Respondent as "affecting the efficiency of the process of *playing the game* which also adds a degree of skill, predictability, sophistication and interest" (italics added) relates entirely to gaming concerns and factors that may be of importance in the non-technical domain of games, and which in any case flow from the rules' central idea. They are not a result of displaying a set of numbers either fixed or scrolled on a monitor. As indicated under section 2.7 such non-technical effects inherent in non-technical game rules cannot be taken into account in assessing inventive step.

5.5 The above situation distinguishes the present case from T 0060/98 and T 0928/03 cited by the Respondent, where further technical effects were indeed identified in the specific details of the technical implementation of

excluded subject-matter. In T 0060/98, see reasons 3.2, the effect of providing a more sophisticated and interesting game was expressly rejected as contributing to inventive step, but a simplification in the way the system determined winning (from a ranked winning table) was recognized as a technical effect. T 0928/03, see reasons 4, while disregarding those effects that were of non-technical nature, identified technical effects in the particular manner in which information was displayed on the graphic interface of a video game.

5.6 From the above the Board concludes that the subject-matter of the claims of the main and first to fifth auxiliary requests lacks inventive step and thus fails to meet the requirement of Article 52(1) and 56 EPC.

6. *Alternative approaches*

6.1 The above analysis is irrespective of any prior art (other than that of manifestly known computer games). Nevertheless, the known variant of domino backgammon described e.g. in the paragraph bridging description pages 1 and 2, in which sets of dominos provide groups of move numbers in advance, already clearly anticipates the central concept discussed above. Though the concept is known in a classical board game context, its application to the different context of computer implemented games is not seen to require any form of ingenuity.

6.2 Similarly, even adopting the 4 step "contribution" approach as favoured in the above "Macrossan" judgement, see discussion, point 40, the claimed invention would fail to meet all patentability requirements. Starting

from manifestly known computer gaming systems with processor and monitor, after claim construction the actual contribution (step (2)) is seen to reside in the central idea in one of its variant forms as discussed in section 3 above. As detailed in section 4.2 this idea pertains to rules for playing games, and falls solely within subject-matter excluded under Articles 52(2) and (3) EPC (steps (3) and (4)). Following this approach the claimed subject-matter would fail the requirement that it be an invention in the sense of Article 52(1) EPC.

7. *Referral to the Enlarged Board*

The sixth auxiliary request is a general request to "refer this case to the Enlarged Board of Appeal". No specific question has been formulated for referral, and any such question is not apparent to the Board from the Respondent's submissions. Neither does it seem appropriate to direct to the Enlarged Board a general request for guidance on the methodology for treating excluded subject-matter. The working out of a methodology cannot be regarded either as a decision or as an opinion on a point of law within the meaning of Article 112(1) a, or b, EPC, such decisions or opinions being the single responsibility of the Enlarged Board of Appeal as foreseen by the Convention.

Nor has any question arisen in the Board's deliberations which might require a decision to ensure uniform application of the law or to clarify an important point of law. Its deliberations and findings have followed, and are in conformity with existing relevant jurisprudence.

A basic prerequisite for an admissible referral under Article 112(1)(a) EPC is thus lacking and the request for referral is therefore inadmissible.

Order

For these reasons it is decided that:

1. The request for referral to the Enlarged Board of Appeal is rejected as inadmissible.
2. The appeal is dismissed.

The Registrar

The Chairman

G. Magouliotis

M. Ceyte