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**Datasheet for the decision
of 14 June 2013**

Case Number: T 1009/11 - 3.2.04

Application Number: 04783785.1

Publication Number: 1663422

IPC: A63F9/24, G06F7/08

Language of the proceedings: EN

Title of invention:

GAMING DEVICE HAVING A CARD MANAGEMENT SYSTEM FOR THE
MANAGEMENT OF CIRCULATING DATA CARDS

Applicant:

IGT

Headword:

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

Amendments - added subject-matter (yes)

Decisions cited:

Catchword:



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Case Number: T 1009/11 - 3.2.04

D E C I S I O N
of Technical Board of Appeal 3.2.04
of 14 June 2013

Appellant: IGT
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 8 December 2010 refusing European patent application No. 04783785.1 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: A. de Vries
Members: J. Wright
T. Bokor

Summary of Facts and Submissions

I. On 01 February 2011, the appellant (applicant) lodged an appeal against the decision of the examining division dispatched on 08 December 2010, refusing the European patent application No. 04783785.1, and paid the prescribed fee at the same time. The statement of grounds of appeal was received on 08 April 2011.

The examining division held that the subject matter of the independent claims according to the applicant's main request, and first and second auxiliary requests did not meet the requirements of Article 52(1) EPC with Article 56 EPC.

II. By summons dated 08 March 2013, the appellant was duly summoned to attend oral proceedings before the Board on 14 June 2013. In the annex to the summons pursuant to Article 15(1) RPBA, the Board expressed the opinion that specific points concerning subject matter extending beyond the application as filed, Article 123(2) EPC, in claims of all requests on file needed to be addressed. These points included:
the feature "each of the plurality of cards is resettable a predetermined number of times" in conjunction with an embodiment of the invention in which cards are thermally printed; and
the feature "player specific information accessed by the processor over a network", in conjunction with the remaining features of the claim.

III. In a letter received 30 May 2013, the appellant informed the Board that they would not appear at the oral proceedings. Oral proceedings were duly held on 14 June 2013 in the absence of the appellant.

IV. The appellant requests that the decision under appeal be set aside and a patent be granted on the basis of a claim set according to a main request filed with letter of 03 May 2013, or alternatively, on the basis of claim sets according to first, second, third or fourth auxiliary requests filed with the statement of grounds for appeal on 08 April 2011.

V. The wording of the independent claims (claims 1 and 23) of the main request reads as follows:

1. "A gaming device (110) comprising:
a housing;
a game operable upon a wager;
a data card acceptor (140) supported by the housing;
a read-write device (132) connected to the housing;
a card transporter (130) connected to the housing;
a plurality of resettable data cards (116), wherein each of the plurality of resettable data cards (116) is resettable a predetermined number of times, the predetermined number of times being greater than one, two or more card holders (120, 122) including a used card holder (120) and a new card holder (122), connected to the housing and operable to receive, hold and distribute the plurality of resettable data cards (116);
a thermal energy supplier supported by the housing;
a thermal energy director coupled to the thermal energy supplier, the thermal energy director operable to direct thermal energy toward a resettable data card (116) received through the data card acceptor (140);
a processor (112) in communication with the read-write device (132) and operatively coupled to at least one of the thermal energy supplier and the thermal energy director; a memory device in communication with the processor (112),

wherein the processor (112) is adapted to control movement of a data card (116) from the data card acceptor (328) to the used card holder (120), and/or control movement of a data card (116) from either the used card holder (120) or the new card holder (122) toward the data card acceptor (140); and cause the thermal energy director to cause a human-readable symbol to be produced and viewable on a resettable data card (116) received through the data card acceptor (140), the human readable symbol indicating at least a portion of player specific information accessed by the processor (112) over a network.

23. "A method for operating a gaming device (110), the method comprising:

- (a) receiving a resettable data card (116) from a player, the data card (116) storing data and configured to be reset a predetermined number of times, the predetermined number of times being greater than one;
- (b) reading the data on the data card (116);
- (c) transporting a data card (116);
- (d) enabling the player to play at least one game;
- (e) determining a balance of credit units for the player;
- (f) storing data on the data card (116) which is associated with cashed [sic] based on said credit units;
- (g) storing the received data card (116) in a used card holder (120) after a first event occurs; and
- (h) dispensing a data card from either the used card holder (120) or the new card holder (122) that is another data card holder to the player after a second event occurs;
- (i) causing a human-readable symbol to be produced and viewable on a resettable data card (116) by directing

thermal energy toward a resettable data card (116), the human readable symbol indicating at least a portion of player specific information accessed over a network".

For all requests, only the features of claims 1 and 23 pertaining to resettable data cards and to player specific information accessed by the processor over a network are of relevance to this decision. The wording of claims 1 and 23 of the requests for these features are as follows:

First auxiliary request

1: "A gaming device (110) comprising:...a plurality of resettable data cards (116), wherein each of the plurality of resettable data cards (116) is resettable a predetermined number of times, the predetermined number of times being greater than one,...wherein the processor (112) is adapted to...cause the thermal energy director to cause a human-readable symbol to be produced and viewable on a resettable data card (116) received through the data card acceptor (140), the human readable symbol indicating at least a portion of player specific information accessed by the processor (112) over a network."

23. "A method for operating a gaming device (110), the method comprising:

- (a) receiving a resettable data card (116) from a player, the data card (116) storing data and configured to be reset a predetermined number of times, the predetermined number of times being greater than one;...
- (j) causing a human-readable symbol to be produced and viewable on a resettable data card (116) by directing

thermal energy toward a resettable data card (116), the human readable symbol indicating at least a portion of player specific information accessed over a network."

Second auxiliary request

1. "A gaming device (110) comprising:...
a data card acceptor (140) supported by the housing and configured to receive a plurality of resettable data cards (116), wherein each of the plurality of resettable data cards (116) is resettable a predetermined number of times, the predetermined number of times being greater than one;...
a memory device configured to ...cause the processor to...(c) operate with the thermal energy director, the thermal energy supplier, and the card transporter (130) to cause the thermal energy director to cause a viewable human-readable symbol to be produced on at least one of the resettable data cards (116) received through the data card acceptor (140), the human readable symbol indicating at least a portion of player specific information accessed by the processor (112) over a network."

23. "A method for operating a gaming device (110), the method comprising...
(a) receiving a resettable data card (116) from a player, the data card (116) storing data and configured to be reset a predetermined number of times, the predetermined number of times being greater than one;...
(j) causing a viewable human-readable symbol to be produced on at least one of the resettable data cards (116) by directing thermal energy toward a resettable data card (116), the human readable symbol indicating

at least a portion of player specific information accessed over a network."

Third auxiliary request

1. "A gaming device (110) comprising:...
a data card acceptor (140) supported by the housing and configured to receive a plurality of resettable data cards (116), wherein each of the plurality of resettable data cards (116) is resettable a predetermined number of times, the predetermined number of times being greater than one;...
a memory device... storing a plurality of instructions which, when executed by the processor, cause the processor to...(c) operate with the thermal energy director, the thermal energy supplier, and the card transporter (130) to cause the thermal energy director to cause a viewable human-readable symbol to be produced on at least one of the resettable data cards (116) received through the data card acceptor (140), the human readable symbol indicating at least a portion of player specific information accessed by the processor (112) over a network."

The relevant parts of claim 23 according to the third auxiliary request are as in claim 23 of the second auxiliary request.

Fourth auxiliary request

1."A gaming device (110) comprising:...
a data card acceptor (140) supported by the housing and configured to receive a plurality of resettable data cards (116), wherein each of the plurality of resettable data cards (116) is resettable a

predetermined number of times, the predetermined number of times being greater than one;...
a memory device... storing a plurality of instructions which, when executed by the processor, cause the processor to...(c) operate with the thermal energy director, the thermal energy supplier, and the card transporter (130) to cause the thermal energy director to cause a viewable human-readable symbol to be produced on at least one of the resettable data cards (116) received through the data card acceptor (140), the human readable symbol indicating at least a portion of player specific information accessed by the processor (112) over a network."

The relevant parts of claim 23 according to the fourth auxiliary request are as in claim 23 of the second auxiliary request.

VI. The appellant's arguments, which apply to the main and auxiliary requests, may be summarised as follows:

- a) Regarding the basis in the application as filed for the claimed feature "each of the plurality of cards is resettable a predetermined number of times", Article 123(2) EPC, the appellant argued that, in certain embodiments, the gaming device includes a card read-write device configured to reset a data card (such as by resetting credit unit data on the data card), and that each data card may be reset a predetermined number of times. Furthermore the appellant argued that the application discloses embodiments of a gaming device including a graphics write-erase device in addition to the data exchange read-write device.

- b) Regarding the basis in the application as filed for the claimed feature "player specific information accessed by the processor over a network" in conjunction with the remaining features of the claim, Article 123(2) EPC, the appellant argues that, in response to the Board's objection to this feature, claim 1 of the main request is amended to excise the objected statement and replace it by the wording "player-readable text". The appellant further argues that the term "player specific information accessed by the processor over a network" is not present in claim 1 of any of the auxiliary requests.

Reasons for the Decision

1. The appeal is admissible.
2. Added subject matter, Article 123(2) EPC main request

Claims 1 and 23 appear to be based on claims 1 and 82 respectively of the application as published, but have been substantially amended with respect to these claims.

It is established case law of the Boards of Appeal that the relevant question to be decided in assessing whether an amendment adds subject-matter extending beyond the content of the application as filed is whether the proposed amendment is directly and unambiguously derivable from the application as filed. See "Case Law of the Boards of Appeal of the European Patent Office", 6th edn., July 2010 (CLBA) Section III. A.7.

In the annex to the summons to attend oral proceedings, the Board questioned whether there was a basis for, *inter alia*, the following features in independent device claim 1 (and in corresponding method step features of independent claim 23) according to all requests then on file.

(i) "each of the plurality of cards is resettable a predetermined number of times" in conjunction with an embodiment of the invention in which cards are thermally printed, and

(ii) "player specific information accessed by the processor over a network", in conjunction with the remaining features of the claim.

The Board will herein refer to these features as features (i) and (ii).

2.1 Concerning feature (i)

2.1.1 The Board first notes that claim 1 of the main request claims a gaming machine comprising a plurality of resettable cards. Therefore the cards are an integral part of the subject matter claimed.

2.1.2 None of the claims of the application as published refer to data cards as being resettable a predetermined number of times. This feature can therefore only have a basis in the description or drawings of the application as filed.

2.1.3 With their letter received 3 May 2013, the appellant argues that the feature (i) has support from the application as published page 7, lines 10–11 stating

that "the data card of the present invention has the capacity to be repeatedly reset".

The Board holds that the fact that a card reset operation is repeatable means that it can be performed more than one time. However this gives no indication as to whether or not the number of times is predetermined or not. Furthermore, there is no mention in connection with the embodiment described on page 7 of the fact that cards are thermally printable. Therefore the Board considers that the above reference does not support the feature (i).

- 2.1.4 The appellant furthermore argues that support for feature (i) can be found on page 38, lines 14-19 stating that "in one embodiment, data card ROM 212 includes data regarding a predetermined number of times in which the data card 206 can be reset or returned to a predetermined state".

The Board agrees with the appellant that cards according to this embodiment are resettable a predetermined number of times. The Board must therefore establish whether the cards in this embodiment are also disclosed as being thermally printable, as claimed in claim 1.

Page 38, lines 14 to 18, is an integral part of the description of an embodiment of cards found in the section III of the description entitled "Data Card having Processor", see page 37, line 26 to page 39, line 27 and figure 13. In this section there is no mention of a card which is thermally printable. Nor does figure 13 show the card to have any printed data, in contrast to the card shown in figure 11 for example. Furthermore the embodiment of the gaming device

described here is said to be an "alternative embodiment". The Board therefore does not consider this embodiment as forming part of other embodiments of the invention described in which cards are thermally printed.

- 2.1.5 The appellant also argues that the feature (i) is supported by page 8, lines 26-28 stating that "the card read-write device enables the gaming device processor to electronically communicate with the data card for reading, updating or resetting credit unit data on a data card".

The Board notes that this citation appears in the context of an embodiment described on page 8, line 9, to page 9, line 4, that contains no suggestion that the card might be resettable a predetermined number of times, let alone any information as to how many times a data card can be reset. It therefore does not support the feature of resetting cards a predetermined number of times.

- 2.1.6 The appellant also cites, page 9, lines 5 to 10 and page 29, line 18 to page 30, line 29 in reference to figures 9 to 11 as basis.

These passages indisputably disclose embodiments of a gaming device having both a data exchange read-write device and a thermal graphics write-erase device. However, the Board cannot derive from these passages, or the context in which they appear, that the data cards referred to are resettable a predetermined number of times, since this is neither stated nor inferred.

Furthermore the passages make no reference to, nor has the appellant provided any argument which could link

these embodiments with the cards disclosed on page 38, lines 14 to 18 and as shown in figure 13. On the contrary, the Board notes that the only card memory described on pages 29 to 30 is a magnetic strip memory, see page 29, lines 21 to 25: "*in one embodiment where the card 116 has a magnetic strip...the processor uses the magnetized device 144 to read the data on the card*". The data disclosed as being stored thereon being inter alia "*fund data*", player "*credit units*", and "*player name*", but not a number of times the card can be reset, see page 29, lines 25-30.

- 2.1.7 The Board therefore considers that there is no direct and unambiguous disclosure in the application as filed of a card being both resettable a predetermined number of times and thermally printable.

Thus the Board holds that, for these reasons alone, the subject matter of claim 1 of the main request adds subject matter extending beyond the application as filed, and therefore the application according to this request does not meet the requirements of Article 123(2) EPC.

- 2.2 The Board also notes that, according to established jurisprudence of the Boards of Appeal, if a claim is to be restricted to a preferred embodiment, it is normally not admissible under Article 123(2) EPC to extract isolated features from a set of features which have originally been disclosed in combination for that embodiment. Such kind of amendment would only be justified in the absence of any clearly recognisable functional or structural relationship among said features, see the examples cited in CLBA, III-A,2.

In the case of claim 1 of the appellant's main request, data cards which can be reset a "predetermined number of times" are only disclosed on page 38, lines 14 to 18 in and in figure 13 of the application as published.

The Board notes that the remaining features of these cards, such as a processor and a ROM memory have not been claimed. The "predetermined number" is disclosed as being stored in ROM. Once the predetermined number is reached, the card processor uses this data to deactivate the card, see page 38, lines 14 to 18. Therefore the Board sees at least the ROM and the processor as elements having a direct functional relationship with the feature that the card is resettable a predetermined number of times. These features are inextricably linked in the original specific disclosure so that, following the above jurisprudence, incorporating only the feature of the predetermined number into the claim without the others, results in a generalisation of this specific disclosure for which there is no basis in the originally filed application. Thus the Board holds that also for this reason, claim 1 of the main request contravenes Article 123(2) EPC.

- 2.3 Concerning feature (ii), "player specific information accessed by the processor over a network", in conjunction with the remaining features of the claim

In claim 1 of the main request, this feature is reformulated to read: "*...the human readable symbol indicating at least a portion of player specific information accessed by the processor (112) over a network*".

According to the claim, this information or symbol is *"to be produced and viewable on [the] resettable data card"*.

- 2.3.1 The Board acknowledges that the application as filed discloses data networks for interconnecting gaming machines, see for example the application as published, page 48, lines 15 to 24: *"In one embodiment, as illustrated in Fig. 15B, one or more of the gaming devices 310 of the present invention may be connected to each other through a data network ... "*.

However neither this citation nor nor any other part of the application as published discloses any connection between information accessed via a network and the information printed on cards in a gaming device, nor has this been argued by the appellant. Thus the Board holds that the application as filed does not provide a basis for a gaming device having cards printed with a human readable symbol *"indicating...player specific information accessed by the processor over a network"*.

Therefore, also for this reason, the Board considers that claim 1 according to the main request includes amendments which add subject matter extending beyond the application as filed.

3. Auxiliary Requests

- 3.1 Claim 1 of all the auxiliary requests includes the above features (i) and (ii). Therefore the Board holds that claim 1 of these requests contravenes Article 123(2) EPC for the same reasons as are given for the main request in sections 2.1 and 2.3.

- 3.2 In a letter received 03 May 2013, page 4, point 3.2, the appellant argues that "player specific information accessed by the processor over a network", feature (ii), is not present in claim 1 of the auxiliary requests.

Each of these versions of claim 1 contains the feature of the processor (112) being adapted (or caused) to..."*cause the thermal energy detector to cause a human-readable symbol to be produced and viewable on a resettable data card (116) ...the human readable symbol indicating at least a portion of player specific information accessed by the processor (112) over a network.*" Therefore the Board cannot follow the appellant's argument in this respect.

- 3.3 The Board notes that, whilst claim 1 of the main request and first auxiliary request expressly include the data cards themselves, claim 1 of the second to fourth auxiliary request merely state that the gaming device is arranged to receive the cards, which no longer form part of the claimed device. However, whether or not features (i) and (ii), which appear in all versions of claim 1, limit the matter for which protection is sought is immaterial. They still form part of the *disclosure* of claim 1, which teaches the use of cards in a particular gaming device and having a combination of features not disclosed anywhere in the application as filed in that particular context.

The Board holds that, because the features (i) and (ii) of the cards are present as such in claim 1 of each of these requests, the requirements of Article 123(2) EPC are contravened regardless of whether the cards are claimed by reference or as part of the gaming device.

4. Independent method claim of all requests

The independent method claim 23, of all requests is effectively directed at the method of operation of the gaming device of claim 1 and includes features corresponding to the above features designated (i) and (ii) by the Board. Therefore for the same reasons as given for claim 1 of the respective requests, the Board holds that claim 23 according to all the appellant's requests contravenes Article 123(2) EPC.

5. The Board concludes that amendments to claims 1 and 23 of all the requests on file extend the subject matter claimed beyond the application as filed, contrary to Article 123(2) EPC. Thus none of these requests is allowable. The appeal must therefore fail.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



G. Magouliotis

A. de Vries

Decision electronically authenticated