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D E C I S I O N
of 25 April 2003

Case Number: T 0060/98 - 3.4.1

Application Number: 90310496.6

Publication Number: 0420586

IPC: G07F 17/34

Language of the proceedings: EN

Title of invention:

A game machine

Patentee:

SIGMA, INCORPORATED

Opponent:

BALLY WULFF AUTOMATEN GMBH
NSM Aktiengesellschaft

Headword:

-

Relevant legal provisions:

EPC Art. 123(2), 52(1), 54(1),(2), 56

Keyword:

"Admissibility of amendments - (yes)"

"Novelty inventive step - (yes)"

Decisions cited:

T 0931/95, T 0641/00

Catchword:

-



Case Number: T 0060/98 - 3.4.1

D E C I S I O N
of the Technical Board of Appeal 3.4.1
of 25 April 2003

Appellant 1: NSM Aktiengesellschaft
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Appellant 2: BALLY WULFF AUTOMATEN GMBH
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Representative: -

Appellant 3: SIGMA, INCORPORATED
(Proprietor of the patent) 32-3, Seijo 9-chome
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
20 November 1997 concerning maintenance of
European patent No. 0420586 in amended form.

Composition of the Board:

Chairman: M. G. L. Rognoni
Members: R. Q. Bekkering
R. A. M. Moufang

Summary of Facts and Submissions

- I. The appeals lie from the interlocutory decision of the opposition division, dispatched on 20 November 1997, maintaining the European patent No. EP-B-0 420 586, in amended form according to the first auxiliary request.
- II. The notice of appeal of opponent 2 (appellant 1) was received on 15 January 1998, the appeal fee being paid on the same day, and the statement of grounds of appeal was received on 10 March 1998.
- III. The notice of appeal of opponent 1 (appellant 2) was received on 22 January 1998 and the appeal fee was paid on the same day. The statement of grounds of appeal was received on 29 January 1998.
- IV. The notice of appeal of the patentee (appellant 3) was received on 30 January 1998, the appeal fee being paid on the same day, and the statement of grounds of appeal was received on 25 March 1998.
- V. Oral proceedings were held on 25 April 2003.
- VI. The patentee requested that the decision under appeal be set aside and the patent be maintained in amended form on the basis of the following documents:

Claims: Claims 1 to 9 as filed during the oral proceedings on 25 April 2003;

Description: Pages 2 to 6 and insert pages 2, 3 and 3a as filed during the oral proceedings on 25 April 2003;

Drawings: Sheets 11 to 33 of the patent
 specification.

VII. Both opponent 1 and opponent 2 requested that the decision under appeal be set aside and the patent be revoked.

VIII. Reference was made in particular to the following documents:

D5: EP-A-0 238 289

D7: EP-B-0 122 138

IX. Claim 1 reads as follows:

"1. A game machine comprising a plurality of characters arranged to be stopped along a winning line (A, B, C), said characters including at least one substitutable character which can be used as a different character wherein the substitution of a said substitutable character can make a combination of characters stopped along a said winning line a winning combination having a win value different to the win value of the equivalent winning combination not containing a said substitutable character, characterised in that a said combination of characters stopped along a said winning line (A, B, C) is compared with a winning table in order to determine the presence of a win, in that said winning table comprises ranked value winning combinations of characters which combinations do not include a substitutable character when used as a different character to make a winning

combination (Fig 5; Fig 13) and in that the or each said substitutable character is a rank-up or a rank-down character such that substitution of a said rank-up character to make a combination of characters a winning combination ranks the combination higher than the equivalent winning combination not containing the said rank-up character thereby increasing the value of the win to that of a higher ranked winning combination and that substitution of a said rank-down character to make a combination of characters a winning combination ranks the combination lower than the equivalent combination not containing the said rank-down character thereby and decreasing the value of the win to that of a lower ranked winning combination."

- X. The opposition division found in the appealed decision that for claim 1 of the main request then on file, which corresponds to present claim 1, the requirements of Article 123(2) EPC were not met. In particular, the specification in amended claim 1 that the winning table comprised ranked value winning combinations of characters "which combinations do not include a substitutable character when used as a different character to make a winning combination" was considered to contravene Article 123(2) EPC. The application as originally filed disclosed three examples of winning tables. On the one hand, a fully worked-out table with all possible combinations of characters including substitutable characters used as different characters in figures 9A and 9B. On the other hand, two examples of winning tables with combinations which did not include a substitutable character when used as a different character in figures 5 and 13. In the decision it was held that although the winning tables

shown in figures 5 and 13 fell within the generalised definition of amended claim 1, they did not induce the skilled person to summarise them under this definition. Moreover, the application did not provide a basis for separating the table of figure 5 from that of figures 9A and 9B and excluding the latter from storage.

XI. The patentee argued essentially as follows:

In the application documents as originally filed it was disclosed that the winning tables depicted in figures 5 and 13 were used in the game machine. These winning tables did not comprise winning combinations including a substitutable character used as a different character to make a winning combination. The fully worked-out winning tables of figures 9A and 9B were merely provided for illustrative purposes and not meant for use in the game machine. In fact, for the third embodiment relating to a poker machine only the table of figure 13 was provided and no fully worked-out table. The algorithm for assessing, for a combination including a substitutable character stopped along the winning line, the equivalent winning combination, if any, was common in the technical field at issue and therefore not explicitly mentioned in the application. Accordingly, claim 1 was admissible under Article 123(2) EPC.

Furthermore, the subject-matter of claim 1 was not anticipated or rendered obvious by the cited prior art. Document D5, providing the closest prior art, disclosed a game machine with a substitutable character in accordance with the preamble of claim 1. However, the assessment of the winning of a combination including

one of the substitutable characters involved an arithmetic operation, ie a doubling or tripling of the winning with respect to the ordinary winning or the addition of an additional dividend to the ordinary winning. In contrast thereto, the subject-matter of claim 1 relied on a ranked winning table, the substitutable character causing the winning to be ranked up or down within that table, thereby rendering the game more sophisticated and interesting. Document D7 did not mention any substitutable characters and, as far as it disclosed a winning table, the table was not ranked by winning. Accordingly, both novelty and the presence of an inventive step had to be recognised for the subject-matter of claim 1.

XII. Submissions of opponent 1

Regarding the admissibility of the amendments to claim 1, the opponent 1 relied on the reasoning of the first instance in the decision under appeal.

Regarding novelty and inventive step, the opponent 1 argued that the claimed change in rank had the effect of changing the winning, just like eg the doubling and tripling of the winning suggested in document D5. Therefore, it had to be seen merely as an obvious modification of the teaching of D5. It was thereby noted that the use of winning tables was common in game machines, as exemplified by document D7.

XIII. The arguments of opponent 2 may be summarised as follows:

The application as originally filed disclosed that the game machine used the winning table of figures 9A and 9B and performed a comparison between the content of the table and the combination along the winning line for determining the winning. The original application did not contain any indication that the invention resided in the use of a table without substitutable characters. Accordingly, the amendments to claim 1 were inadmissible.

Moreover, the problem to be solved as derivable from the claimed subject-matter had to be seen as merely providing an alternative way of altering the winning. Instead of using a calculation, such as a multiplication or addition, as suggested in document D5, the claimed game machine read the winning from the winning table. However, reading the winning from a winning table as such was well-known, so that the claimed solution was obvious.

Furthermore, according to T 931/95 (OJ EPO 2001, 441) the contribution provided by an invention had to be technical, but no technical effect could be seen to be brought about by the game machine as defined in claim 1.

Reasons for the Decision

1. The appeal complies with the requirements of Articles 106 to 108 and Rule 64 EPC and is therefore admissible.

2. *Amendments (Article 123(2),(3) EPC)*

2.1 The application as originally filed discloses a game machine displaying a combination of characters stopped along a winning line. The examples given of the game machine are a three-reel slot machine, the corresponding video-type version and a poker machine. In addition to the normal characters pertaining to the specific type of game, special wild characters are provided.

Typically, ordinary wild characters, such as eg a joker, make the winning of a combination of characters including wild characters stopped along the winning line the same as that of the equivalent winning combination with the wild characters substituted by normal characters.

The special wild characters of the patent in suit, called "substitutable characters", however can make a combination of characters stopped along the winning line a winning combination having a win value different to the win value of the equivalent winning combination not containing the substitutable characters. In particular, a so-called rank-up or rank-down character is provided, whereby substitution of the rank-up character to make a combination of characters a winning combination ranks the combination higher than the equivalent winning combination not containing the rank-up character thereby increasing the value of the win to that of a higher ranked winning combination. Substitution of the rank-down character to make a combination of characters a winning combination ranks the combination lower than the equivalent combination

not containing the rank-down character thereby decreasing the value of the win to that of a lower ranked winning combination.

According to the application as originally filed (see in particular claims 1 to 3 as well as the summary of the invention (cf application as published, column 2, lines 11 to 21)), the value of the winning of a combination of characters stopped along the winning line is determined based on a winning table showing ranked winning combinations of characters. When the combination includes a rank-up or rank-down substitutable character, substitution ranks the combination higher or lower within the winning table and increases or decreases the value of the winning, respectively, with respect to the equivalent winning combination not containing the substitutable character.

It follows from the above that the winning table should only contain the equivalent winning combinations not containing the substitutable character, ranked by winning. For a given combination of characters including rank-up or rank-down substitutable characters stopped along the winning line, after determination of the equivalent winning combination not containing any substitutable characters from the winning table, the actual winning is determined by increasing or decreasing the winning to that of a higher or lower ranked character combination in the table.

Specific examples of such winning tables are depicted in figures 5 and 13 for a slot machine game and a poker game, respectively. However, contrary to what was argued by the opposition division and opponent 1, the

definition of the winning table in claim 1 as amended follows from the originally filed claims and description as discussed above, rather than having to be extracted from the tables of figures 5 and 13.

The specific circuit of the game machine in the embodiments disclosed in the description involves the comparison of the address data of the characters stopped along the winning line and the address data stored in the winning table memory in order to determine the winning (cf application as published, column 8, line 41 to column 9, line 22). The opponent 2 argued that this implied a direct comparison with a fully worked-out table, listing all winning combinations of characters including the rank-up and rank-down substitutable characters, of the form depicted in figures 9A and 9B. He noted furthermore that there was no disclosure of any means for determining, for a combination including substitutable characters, the equivalent winning combination with the substitutable characters replaced by normal characters.

However, it is noted that such a fully worked-out table is only provided for the slot machine game and not for the other embodiment relating to a poker game. Furthermore, the determination, for a combination including substitutable characters, of the equivalent winning combination with the substitutable characters replaced by normal characters is so common in the game machines at issue that not all details need to be specified.

Accordingly, from the above it cannot be concluded that only the use of a fully worked-out table was envisaged

in the application. Rather, the direct comparison with a fully worked-out table possibly constitutes an alternative to the use of a table not containing substitutable characters as discussed above, but does not alter the fact that the latter has been originally disclosed.

Finally, it is noted that there is no support for the contention that the original disclosure required both tables of figures 5 and 9A, 9B to be stored in the machine. The corresponding argument that there was no basis for separating these tables from each other is therefore unfounded.

Accordingly, the board comes to the conclusion that claim 1 as amended does not contain subject-matter which extends beyond the content of the application as originally filed, in accordance with the requirements of Article 123(2) EPC.

2.2 The above-mentioned limitation in amended claim 1 does not give rise to any objection under Article 123(3) EPC either.

3. *Novelty, inventive step (Articles 52(1), 54(1),(2) and 56 EPC)*

3.1 From document D5, which is considered to provide the closest prior art, a game machine according to the preamble of claim 1 is known. The combination of characters stopped along the winning line is compared with a set of predetermined winning character combinations in order to determine the presence of a win (cf abstract, claim 1). Special characters are

provided such as "Double", "Triple", "+10" and "+20", in addition to the normal characters such "7", "BAR", orange, plum, cherry etc. typical of the slot machines at issue. These special characters both act like wild characters and increase the winning of a combination of characters stopped along the winning line of the game machine with respect to the equivalent winning combination with the wild characters substituted by normal characters. The increase consists, depending on the special character, in a doubling or tripling of the winning of the equivalent character combination or in the addition of an extra dividend thereto. Thus, in accordance with the terminology of claim 1 of the patent in suit, the game machine of D5 has a set or "table" of winning combinations, "which combinations do not include a substitutable character when used as a different character to make a winning combination".

The subject-matter of claim 1 differs from the known machine of D5 in that the winning combinations of characters are ranked in the table by winning, and in that the winning for a combination of characters including special characters is increased or decreased with respect to the winning of the equivalent winning combination to that of a higher or lower ranked winning combination, depending on the special character.

Accordingly, the subject-matter of claim 1 is novel.

- 3.2 For determining the winning of a combination stopped along the winning line including special characters, the known machine only relies on the winning table for determining the winning of the equivalent winning combination of characters and then uses an arithmetic

operation such as a multiplication or addition to determine the actual winning. The game machine of claim 1 on the other hand does not rely on any arithmetic operation, but derives the actual winning from a ranked winning table by taking the winning from a higher or lower rank.

Starting from the teaching of D5, the objective problem to be solved may be seen as providing alternative technical means for determining the actual winning in case of occurrence of special characters in the combination of characters stopped along the winning line.

The patentee argued that the above difference also caused the game to be more sophisticated and interesting with respect to D5. However, as in substance argued by opponent 2, improvements which lie in the rules of the game cannot contribute to inventive step (see T 931/95, Reasons 8). The assessment of inventive step has to be carried out from the perspective of the technical expert entrusted with the development of the game machine based on a non-technical concept handed over to him from the non-technical game developer (see also T 641/00 to be published).

However, the claimed solution simplifies the game machine to the extent that the arithmetic operation can be dispensed with and as such provides a technical improvement over the teaching of document D5. There is no suggestion in the cited prior art to make use of the ranking of the winnings in a winning table for defining the winning of combinations of characters containing

special substitutable characters. Cited document D7 (cf figure 15 and corresponding description) discloses a game machine including a winning table with winning character combinations used for determining the winning. However, the combinations of characters are not ranked by winning. Furthermore, the game machine does not have any substitutable characters so that the document is of no particular relevance to the claimed solution.

Accordingly, the subject-matter of claim 1 is considered to involve an inventive step.

- 3.3 The remaining claims 2 to 9 are dependent on claim 1 and provide further developments of the subject-matter of claim 1. Therefore, the subject-matter of these claims also involves an inventive step.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance with the order to maintain the patent as amended in the following version:

Claims: Claims 1 to 9 as filed during the oral proceedings on 25 April 2003;

Description: Pages 2 to 6 and insert pages 2, 3 and 3a as filed during the oral proceedings on 25 April 2003;

Drawings: Sheets 11 to 33 of the patent specification.

The Registrar:

The Chairman:

R. Schumacher

M. Rognoni