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**Datasheet for the decision
of 14 December 2007**

Case Number: T 1704/06 - 3.5.01

Application Number: 99964344.8

Publication Number: 1151407

IPC: G06F 17/60, A63F 5/00

Language of the proceedings: EN

Title of invention:
Methods of paying winning bets

Applicant:
Rudd, Clarence Ernest

Opponent:
-

Headword:
Paying winning bets/RUDD

Relevant legal provisions:
EPC Art. 56, 113(1), 123(2)
RPBA Art. 15(3), (6)

Relevant legal provisions (EPC 1973):
-

Keyword:
-

Decisions cited:
T 0599/93, T 0258/03, T 0602/03, T 0198/06

Catchword:

In the situation where an appellant submits new claims after oral proceedings have been arranged but does not attend these proceedings, a board can refuse the new claims for substantive reasons, specifically lack of inventive step, even if the claims have not been discussed before and were filed in good time before the oral proceedings. This will in particular be the case if an examination of these substantive requirements is to be expected in the light of the prevailing legal and factual situation (point 7.6 of the reasons).



Case Number: T 1704/06 - 3.5.01

D E C I S I O N
of the Technical Board of Appeal 3.5.01
of 14 December 2007

Appellant: Rudd, Clarence Ernest
5 Sonama Court
Burleigh Waters QLD 4220 (AU)

Representative: Naylor, Matthew John
Mewburn Ellis LLP
York House,
23 Kingsway
London WC2B 6HP (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 17 May 2006
refusing European application No. 99964344.8
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: S. Steinbrener
Members: S. Wibergh
P. Schmitz

Summary of Facts and Submissions

I. This appeal is against the decision of the examining division to refuse the European patent application No. 99 964 344.8 (published as WO-A-00/34903).

II. The reason for the refusal was that the subject-matter of claim 1 of the main request and the first to third auxiliary requests lacked an inventive step over a combination of the documents

D1: FR-A-2 696 855 and

D2: US-A-5 384 561.

Claim 1 of the fourth auxiliary request was held to infringe Article 123(2) EPC.

III. In the statement setting out the grounds of appeal, the appellant essentially argued that the invention provided inter-related technical features that combined their effects to yield an advantageous technical solution by allowing all participants in a game of roulette, including the croupier, to monitor all relevant activity in the game, in particular simultaneous checking of the calculation that leads to each player's winnings (p. 1,4). As this advantage was achieved by the inter-relationship of three novel technical features and there was no incentive in the available prior art to apply the combination of these features to the device known from document D1, the subject-matter of claim 1 (main request) involved an inventive step.

- IV. By letter dated 13 November 2006, the appellant filed evidence consisting of opinions in the form of answers to a questionnaire of three "experts in the technical field of casinos".
- V. The Board summoned to oral proceedings, as requested by the appellant on an auxiliary basis. In the accompanying communication, the Board stated that "/the/ main issue to be discussed will be the inventive step". In the Board's preliminary opinion the appealed decision was justified, since nothing inventive was seen in the idea of inputting, calculating and displaying data that was of interest to the participants in a game in order to allow them to monitor all relevant activity.
- VI. By a letter dated 6 November 2007, the appellant withdrew his request for oral proceedings and filed claims according to a main request and five auxiliary requests. The main request and the first to fourth auxiliary requests essentially corresponded to the requests before the first instance whereas the fifth request contained subject-matter not previously included in an independent claim. Furthermore, the appellant requested the opportunity to address in writing any remaining or new objections to the grant of a patent, for example objections which were not set out in the decision under appeal or in the written preliminary opinion of the Board. This could be either before the Board itself, or via remittal back to the examining division.

VII. Claim 1 of the *main request* read:

"A roulette payout calculation aid of the type including:
a set of chips for each player, each player's chips being distinguishable by colour from another said player's chips to identify said player;
a data input module;
a computational module coupled to the data-input module and arranged to calculate payouts to each player on the basis of data input to the data-input module;
and
a player's display to display a cumulative total of the number of chips won by a player as winning bet data is input to the data module,
characterised in that
said data input module (12) includes a player identification key (22) for each of said number of players, bet entry means (24) for inputting payment odds of winning bets of a player, numeric value entry means (16) for entering the number of chips wagered on each winning bet and chip value data entry means (26) for entering the monetary value of said chips; said computational module (15) outputs to the player's display (14) for displaying to the players the bets of a player identified by key including the chips wagered by the player on each winning bet, its respective odds, the value of each winning bet and the total payout to be returned to the player".

Claim 1 of the *first auxiliary request* was identical.

Claim 1 according to the *second auxiliary request* added the feature that "said data-input module (12) includes

a croupier's display (28) for displaying data input to the data-input module (12)".

Claim 1 according to the *third auxiliary request* added to the main request the feature that "said data-input module (12) including a recall request button (32) for requesting recall of the details of a previous computation, said payout calculation aid (10) arranged to display details of the previous computation upon a croupier's display (28) and upon the player's display (14) upon activation of the recall request button (32)".

Claim 1 according to the *fourth auxiliary request* was a combination of claim 1 of the second and third auxiliary requests.

Claim 1 according to the *fifth auxiliary request* read as follows:

"A roulette payout calculation aid including:
a set of chips for each of a number of players, each player's chips being distinguishable by colour from another said player's chips to identify said player;
a data input module (12) including a croupier's display for displaying data input to the data-input module (12);
and
a computational module coupled to the data-input module and arranged to calculate payouts to each player on the basis of data input to the data-input module;
characterised in that
said data input module (12) further includes:
a player identification key (22) for each of said number of players;

bet entry means (24) for inputting payment odds of winning bets of a player;

numeric value entry means (16) for entering the number of chips wagered on each winning bet;

chip value data entry means (26) for entering the monetary value of said chips;

a buzzer (30) arranged to sound upon entry of data by the data-input module (12);

a recall request button (32) for requesting recall of the details of a previous computation,

the roulette payout calculation aid further including a player's display (14), wherein in operation, said computational module (15) outputs to the player's display (14) for displaying to the players, as winning bet data is input to the data input module, simultaneously:

- (i) the colour assigned to a player whose payout is being determined;
- (ii) the bets of said player identified by said colour, including the chips wagered by the player on each winning bet;
- (iii) the respective odds of said bets;
- (iv) the cumulative total of the number of chips won by a player;
- (v) the value of each winning bet; and
- (vi) the total payout to be returned to the player,

and wherein said payout calculation aid (10) is arranged to display details of the previous computation upon both the croupier's display (28) and upon the player's display (14) upon activation of the recall request button (32)."

- VIII. On the Board's inquiry, the appellant's representative stated that it was probable that nobody would appear for the appellant at the oral proceedings.
- IX. Oral proceedings were held on 14 December 2007 in the appellant's absence. It was verified that the appellant requested, apart from his being given a further opportunity to deal with the case in writing, that the decision under appeal be set aside and a patent be granted on the basis of one of the main request and first to fifth auxiliary requests. At the end of the oral proceedings the Chairman announced the decision.

Reasons for the Decision

1. Technical character

Claim 1 of all requests involves the use of technical means, such as an input module, a computational module, and displays. Therefore, following decision T 258/03 - Auction method/HITACHI (OJ EPO 2004,575), the claimed subject-matter is an invention within the meaning of Article 52(1) EPC.

The main request

2. Inventive step

- 2.1 The present claim 1 is identical with claim 1 of the main request in the first instance. The examining division identified three features in the claim that were not present in D1 (decision under appeal, point 8):

- a) player identification keys to represent an individual player,
- b) chip value data entry means for entering the monetary value of the chips, and
- c) a player's display for displaying to the players the bets of a player identified by key.

These findings were agreed upon by the appellant (cf the statement of grounds of appeal, p.2 and 3).

The division argued (cf the decision under appeal, points 9 to 13) that each feature solved a partial and independent problem in an obvious manner, namely:

Problem P1: How can data input be related to an individual player?

Problem P2: How can the total payout in terms of monetary value be calculated?

Problem P3: How can the players be informed about game related data?

Feature a) was found to be obvious in the light of a combination of D1 and D2. Features b) and c) were part of the common general knowledge of the skilled person. There was no combination effect.

- 2.2 The Board however first notes that D1, which is undisputedly the closest prior art document, already discloses a display for displaying data to the players ("un tableaux d'affichage général 9'... lisible de tous", p.7). Thus the only possibly new aspects of the display in claim 1 are the details of the information it serves to present, namely "the bets of a player identified by key including the chips wagered by the

player on each winning bet, its respective odds, the value of each winning bet and the total payout to be returned to the player". It is however well established by the jurisprudence of the Boards of Appeal that mere presentations of information cannot contribute to an inventive step (see eg T 599/93, point 4; T 198/06 - Petit écran/PHILIPS, both not published in OJ EPO).

The appellant has argued that it "was only when the technical feature of a display to the players, for each player, of the bets laid down, their respective odds, the value of each winning bet and the total payout to be returned to each player, that the device of the present invention was accepted and became commercially useful to casino owners" (statement of grounds of appeal, p.3). Moreover, the three statements filed as evidence by the appellant - made by a croupier, a casino manager and a "gambler" - indeed suggest that the display serves to increase the confidence of the audience.

The Board does not doubt this evidence. However, it merely shows that players want to be able to verify the croupier's calculations. This is clearly not a technical issue but a matter of trust in the croupier (or the lack of it). As to the alleged commercial success of the invention, it should be kept in mind that the success of a product need not be due to its technical excellence. In the present case, the calculation aid is such that the players can follow the croupier's calculations on it. It is thus not so much the actual display, of which no particulars are given, that the players appreciate but the fact that they are at all permitted a data check. The technical

contribution lies only in finding a way of making the desired information available to all participants. However, providing a display for this purpose would be trivial even if it had not been known from D1.

Therefore distinguishing feature c) above need not be further considered since it is in substance anticipated by the closest prior art.

- 2.3 Distinguishing features a) and b) (the player identification keys for identifying players and the chip value data entry means for entering the monetary value of the chips) involve similar informational aspects. If it is desired visually to identify the player whose bets are being calculated (no doubt a sensible requirement), it should be possible to input this information in the calculation aid. Keys will be the first choice for achieving this. The same applies to the keys for entering chip values, which are clearly desirable if the rules of the casino happen to foresee different chip values.

The appellant has furthermore argued that there was no motivation in the prior art to combine features a) to c) in the manner set out in claim 1. The Board is however of the opinion that such motivation did exist, since the distinguishing features have in common that they all relate to the presentation of important game data. In fact, it would have been obvious to add any number of such features as long as their technical implementation was conventional.

- 2.4 It follows that the subject-matter of claim 1 lacks an inventive step (Article 56 EPC).

Auxiliary request 1

3. This request must also be refused since claim 1 is identical with claim 1 of the main request.

Auxiliary request 2

4. Claim 1 according to this request contains the additional feature that the data-input module includes a croupier's display for displaying data input to the data-input module. However, as the examining division noticed, the apparatus in D1 is also provided with a display (9 in fig.1) on its data-input module. Thus claim 1 contains no further distinguishing feature.

Auxiliary request 3

5. Claim 1 additionally contains the feature that the data-input module includes a recall request button for requesting recall of the details of a previous computation on the croupier's display and the player's display. Again (cf point 2.3 above) the technical contribution lies solely in the word "button", the rest of the feature being concerned with a mere display of information judged to be of interest to the participants. To store such possibly contentious information and recall it on request by actuating a dedicated button would be readily contemplated by a skilled person as a standard solution for avoiding repetitive calculations or the need for memorising the results. Hence, the subject-matter of claim 1 of auxiliary request 3 cannot be considered inventive either.

Auxiliary request 4

6. Claim 1 according to this request contains a combination of the additional features introduced in auxiliary requests 2 and 3. However, since claim 1 of request 3 already mentions the croupier's display (introduced in auxiliary request 2), auxiliary request 4 effectively adds nothing to it.

Auxiliary request 5

7. Procedural matters

- 7.1 Claim 1 according to auxiliary request 5 was submitted about one month before the date of the oral proceedings before the Board, together with the appellant's withdrawal of his (auxiliary) request for oral proceedings. The appellant was not represented at the hearing. In view of the requirements of Article 113(1) EPC (the right to be heard), the Board had to consider at the oral proceedings whether it was in a position to decide on this claim, which contained subject-matter not previously present in an independent claim.

- 7.2 Article 15(3) RPBA (as of 13 December 2007, previously Article 11(3)) reads:

"The Board shall not be obliged to delay any step in the proceedings, including its decision, by reason only of the absence at the oral proceedings of any party duly summoned who may then be treated as relying only on its written case".

7.3 The explanatory notes to this Article state the following (CA/133/02 dated 12 November 2002, available at the EPO web site):

"This provision does not contradict the principle of the right to be heard pursuant to Article 113(1) EPC since that Article only affords the opportunity to be heard and, by absenting itself from the oral proceedings, a party gives up that opportunity".

7.4 In the case T 602/03 - Programmable smart card/TRANSACTION TECHNOLOGY (not published in the OJ EPO), the deciding board held that by filing amended claims shortly (about one month) before the oral proceedings and subsequently not attending these proceedings, the appellant must expect a decision based on objections which might arise against such claims in his absence (point 7 of the reasons).

7.5 Allowing an appellant to delay a decision by filing amended claims and not attending the oral proceedings at which they could be discussed would also be contrary to Article 15(6) RPBA, which stipulates that a Board shall ensure that each case is ready for decision at the conclusion of the oral proceedings, unless there are special reasons to the contrary. An appellant's request to address any remaining or new objections to the grant of a patent in writing, without giving any reasons for not attending the oral proceedings already arranged, does not comply with this regulation.

7.6 Thus, in the situation where an appellant submits new claims after oral proceedings have been arranged but does not attend these proceedings, a board has a number

of different options. It can continue the examination in writing, remit the case, grant a patent, or reject the claims as inadmissible. But it can also refuse the new claims for substantive reasons, specifically lack of inventive step, even if the claims have not been discussed before and were filed in good time before the oral proceedings. This will in particular be the case if an examination of these substantive requirements is to be expected in the light of the prevailing legal and factual situation. In the present case an assessment of inventive step could indeed be expected since the Board's communication clearly indicated that the main issue at the oral proceedings would be the inventive step. Furthermore, the admissibility of amendments to a claim must be examined as a matter of course.

8. The Board is of the opinion that auxiliary request 5 cannot be allowed for two reasons:

The first reason is that there are doubts about claim 1 being properly based on the application documents as initially filed (Article 123(2) EPC). According to the claim, three values are displayed: the cumulative total of the number of chips won by a player, the value of each winning bet, and the total payout to be returned to the player. According to fig.3, however, it seems that only two values are displayed (50,52).

The second reason is that the main addition to the claim, namely the buzzer arranged to sound upon entry of data by the data-input module, is obvious. The feature has been commented on by the examining division, albeit only summarily and only in a communication. It was contained in dependent claim 4 of the set of claims

according to the main request before the examining division. These claims were found not to involve an inventive step because of the objections raised in the communication accompanying the summons to oral proceedings before the examining division (decision under appeal, point 15). In this communication, dated 26 August 2005, it is stated at point 2.6 that "claims 2-4 do not appear to contain any additional features which, in combination with the features of the independent claim 1 to which they refer, meet the requirements of the EPC with respect to inventive step (Art. 56 EPC) as they refer to mere standard features related to displaying, entering and manipulating data in a calculation aid". The Board can only agree with the examining division that the provision of a buzzer, which the appellant himself does not argue is new as such, was obvious in the present context. The appellant's observation that the buzzer provides feedback to the croupier of successful entry of data into the data input module (letter dated 6 November 2007, page 3 bottom) cannot change this view. The skilled person would have been aware that a buzzer is suitable for providing audible feedback.

Conclusion

9. Thus, the subject-matter of claim 1 of all requests lacks an inventive step (Article 56 EPC) over D1 combined with the skilled person's common general knowledge.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

T. Buschek

S. Steinbrener