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**Datasheet for the decision
of 12 May 2011**

Case Number: T 2127/09 - 3.2.04

Application Number: 05011411.5

Publication Number: 1600198

IPC: A63F 13/00

Language of the proceedings: EN

Title of invention:

Game apparatus and control method therefor

Applicant:

Bandai Co., Ltd., et al

Headword:

-

Relevant legal provisions:

EPC Art. 123(2)

Relevant legal provisions (EPC 1973):

EPC Art. 84, 111

EPC R. 45

Keyword:

"Mixture of technical and non-technical features"

"Rules of playing games"

"No search declaration under Rule 45 EPC 1973"

"Amendment filed at the oral proceedings - admitted"

"Remittal"

Decisions cited:

T 0012/08, T 0336/07, T 1515/07, T 0690/06, T 1543/06,

T 0641/00,

Catchword:

-



Case Number: T 2127/09 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 12 May 2011

Appellant: Bandai Co., Ltd., et al
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Representative: T. Koch c/o
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 12 June 2009
refusing European patent application
No. 05011411.5 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: M. Ceyte
Members: M. Poock
T. Bokor

Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division posted 12 June 2009 in which European patent application No. 05 011 411.5 was refused.

The examining division held that the subject-matter of the independent claims did not involve an inventive step as required by Articles 52(1) and 56 EPC. The notoriously well known "Tetris" computer game was considered to represent the closest prior art. The features characterising the invention related to an obvious implementation of game rules and presentation of information. Removing blocks when a sequence bar scrolls across them, did not solve a technical problem and served merely as a particular presentation of information according to a game rule.

Also the search division considered that the claimed subject-matter was merely an obvious implementation of game rules on known hardware and did not carry out a search in accordance with Rule 45 EPC. It was indicated, that a search may be carried out during examination when the problems mentioned in the declaration are overcome.

- II. The applicant lodged the appeal on 12 August 2009 and paid the prescribed appeal fee simultaneously. The statement of grounds of appeal was received on 22 October 2009.
- III. Oral proceedings before the board were held on 12 May 2011.

The board referred to decisions T 336/07 and T 12/08 for its understanding of the term "game rules". Such rules defined "inter alia" the structural setup of the game that allows choice making to occur and determines how the game play evolves from the beginning to its end in response to player actions and decisions.

The appellant (applicant) submitted an amended set of claims as sole request and argued that this was a reaction on the discussion in the oral proceedings on the meaning of "game rules".

IV. The appellant requested that the decision under appeal be set aside and that the patent be granted on the basis of claims 1 to 19, filed during the oral proceedings before the board.

V. The independent claims read as follows:

"1. A game apparatus for making a player operate a falling object (102) that falls within a predetermined display area (100), and clearing the falling object (102) and falling stop objects (103) by combining the falling object (102) and the falling stop objects (103) under a predetermined condition, the apparatus comprising:
a CPU (1101),

a) said CPU (1101) being adapted to display a falling object (102) at a falling start position (101) of a predetermined display area (100);

b) said CPU (1101) being adapted to display the displayed falling object (102) to move in a lower

direction of the display area independently of an operation input from the player;

c) said CPU (1101) being adapted to display the falling object (102) to move in the lower or horizontal direction of the display area in accordance with an operation input to the falling object (102); and

d) said CPU (1101) being adapted to, when the falling object (102) reaches a falling stop position of the display area (100) and satisfies a falling stop condition, stop falling of the falling object (102), and display the falling object (102) as a falling stop object;

e) said CPU (1101) being adapted to determine if the falling stop object and other falling stop objects (103) which are arranged around the falling stop object in advance satisfy clear conditions, characterized by further comprising:

f) said CPU (1101) being adapted to, when the clear conditions are satisfied, register a portion of the falling stop object which satisfies the clear conditions as an object to be cleared;

g) said CPU (1101) being adapted to display a sequence bar (701) when a counter, counting given timings independently of the music data, reaches a predetermined value, the sequence bar being displayed to move from left to right in the display area in synchronism with a music which is output along with progress of a game; and

h) said CPU (1101) being adapted to, when the sequence bar (701) has passed the portion of the falling stop object registered as the object to be cleared, clear the portion of the falling stop object".

"9. A method of controlling a game apparatus having an operation unit (1106) which makes an operation input to a game, which makes a player operate a falling object (102) that falls within a predetermined display area (100), and clears the falling object (102) and falling stop objects (103) by combining the falling object (102) and the falling stop objects (103) under a predetermined condition, a display unit (1105) which displays information associated with the game, a storage unit (1102, 1103, 1104) which stores data required to execute the game, and an audio output unit (1107) which outputs music data of the stored data along with progress of the game, the method comprising:

a step of displaying the falling object (102) at a falling start position (101) by setting display position data of the falling object (102) at the falling start position (101) in the predetermined display area (100) of the display unit (1105);

a step of changing the display position data of the falling object (102) to move the falling object (102) displayed on the display unit (1105) in a lower direction of the display area

independently of an operation input from the operation unit (1106);

a step of changing the display position data of the falling object (102) to move the falling object (102) in the lower or horizontal direction of the display area in accordance with an operation input from the operation unit (1106) to the falling object (102);

a step of stopping, when the falling object (102) reaches a falling stop position of the display area and satisfies a falling stop condition, falling of the falling object (102), and displaying the falling object (102) as a falling stop object;

a step of determining if the display position data of the falling stop object and display position data of other falling stop objects (103) which are arranged around the falling stop object in advance satisfy clear conditions; and

a step of generating, when the clear conditions are satisfied, clear object data used to register a portion of the falling stop object which satisfies the clear conditions as an object to be cleared, and storing the generated data in the storage unit (1102, 1103, 1104) , characterized by further comprising:

a step of displaying a sequence bar (701) when a counter, counting given timings independently of the music data, reaches a predetermined value, the

sequence bar being displayed to move it in the display area from left to right in synchronism with the music data which is read out from the storage unit (1102, 1103, 1104) and is output from the audio output unit (1107) along with progress of the game;

a step of determining on the basis of display position data of the sequence bar (701) if the sequence bar (701) has passed the portion of the falling stop object corresponding to the clear object data stored in the storage unit (1102, 1103, 1104) and

a step of clearing, when it is determined that the sequence bar (701) has passed the portion of the falling stop object, display of the portion."

"18. A computer program product adapted to perform the method steps of one or more of claims 9 to 17."

"19. A computer readable recording medium recording a computer program product of claim 18."

VI. The appellant argued that the subject-matter of the independent claims involves an inventive step. The problem is how to implement the standard "Tetris" computer game to make it more attractive. This technical problem is solved by features including technical means (features f) to h) in claim 1) or by steps for achieving the functions of these means (claims 9, 18 and 19).

Reference was made to decision T 12/08 in which an identical case was decided. According to this decision, a prerequisite of game rules was that the player can influence them.

With the amendment in feature g) in claim 1 and the corresponding amendments in claim 9, it is now claimed that the CPU starts to display the sequence bar to move it from left to right - independently of the music - only when a predetermined counter value is reached. Then, after the movement has been started, the sequence bar moves in synchronism with the music, i.e. slowly when the music has a slow tempo and fast when the music has a fast tempo.

Reasons for the Decision

1. The appeal is admissible.
2. Amendments
 - 2.1 The amendments in the independent claims 1, 9, 18 and 19 are supported by the originally filed claims 5, 9, 1 and 13 and figures 12 to 15 with their respective description.

More particularly, the amendment in feature g) of claim 1 and the corresponding amendment in claim 9 is supported by figure 15 and column 11, line 53 to column 12, line 4 of the published application.

- 2.2 The latter amendment sets out that the central processing unit (CPU) starts to display the sequence

bar to move it from left to right - independently of the music - only when a predetermined counter value is reached. Then, after the movement has been started, the sequence bar moves in synchronism with the music, i.e. slowly when the music has a slow tempo, fast when the music has a fast tempo.

2.3 Thus, the requirements of Articles 123 (2) and 84 EPC are satisfied.

3. Inventive step

3.1 The application relates to a computer game like "Tetris" in which objects as blocks are displayed to fall down and fill a row. Once a row is fully filled, the blocks will be cleared immediately. It can be stated that the blocks will be cleared when they satisfy a first condition.

The idea behind the claimed subject-matter is now to introduce a second condition which has to be satisfied before the blocks are cleared. According to claims 1, 9, 18 and 19, the second condition is implemented with a sequence bar moving over the blocks to be cleared.

3.2 The rules of the notoriously known "Tetris" computer game could be described as follows:

A random sequence of objects appear at the top of a playing field display and fall down to the bottom thereof. The objects stop falling when they hit either the bottom line of the playing field or an object that has already fallen and stopped before. In the latter case, the objects will be stacked towards the top of

the display. When new objects cannot fall any longer because the fallen objects are stacked and reach the top of the playing field where the new objects are supposed to fall, the game is over.

A player can move the falling objects to the left or to the right and can thus try to fully fill a horizontal row of objects. When a row is fully filled with objects, these are immediately cleared, i.e. they disappear, and any object above a cleared one, will fall into the cleared space.

The new objects appear at the top of the playing fields display as soon as the falling object stop moving.

3.3 Compared with the standard "Tetris" game in which objects are cleared when a first condition is satisfied, the distinguishing features f) to h) of claim 1 and the corresponding features in claims 9, 18 and 19 include now a second condition which has to be satisfied before the objects are cleared and disappear.

3.3.1 These distinguishing features have both technical and non-technical aspects.

(a) "Game rules" form part of "the regulatory framework agreed between [or with] players concerning conduct, conventions and conditions that are meaningful only in a gaming context (T 0012/08 of 6 February 2009, reasons 4.6; not published in OJ EPO). They govern the conduct and actions of the players during game play (T 336/07 of 11 October 2007, reasons 3.3.1; not published in OJ EPO).

Thus, "games rules" define inter alia the structural setup of the game that allows choice making to occur and determines how the game play evolves from the beginning to its end in response to player actions and decisions. It should be noted that the structural setup of the game does not require a player's interaction.

- (b) Such "games rules" are clearly recognisable in the independent claims. The game apparatus of claim 1 and the method of claim 9 are setup such that the objects are cleared only when the first and the second clearing conditions are satisfied. The same can be stated with respect to claims 18 and 19.
- (c) From this it follows that the non-technical aspects reflect modified "Tetris" game rules and the technical aspects reflect the technical implementation of these modified game rules.

3.3.2 Since these distinguishing features include both technical and non-technical aspects, the subject-matter of claims 1, 9, 18 and 19 is of "mixed" nature.

- (a) In dealing with such "mixed" inventions the board adopts the approach as set out in T 1543/06 of 29 June 2007 (reasons 2, not published in OJ EPO) which is based foremost on T 641/00 (OJ EPO 2003, 352). Thus, only those features that contribute to technical character are to be taken into account when assessing inventive step.

That requirement cannot rely on excluded (non-technical) subject-matter alone, however original that matter might be. The mere technical implementation of something excluded cannot form the basis for inventive step. Decisive for inventive step is the question how excluded subject-matter has been technically implemented, and whether such implementation is obvious in the light of the prior art. As explained in reasons 2.7 to 2.9 of T 1543/06, such a consideration focuses on any further technical effects associated with implementation of the excluded subject-matter over and above those inherent in the excluded subject-matter itself.

- (b) In the present case, the independent claims have been substantially amended and specify now in addition the control of the sequence bar in accordance with a counter when a predetermined count value is reached.

However, since the search division did not carry out a search under Rule 45 EPC 1973, the board is unable to finally assess whether the claimed subject-matter involves an inventive step, and in particular whether these amended features provide any further technical effects associated with the implementation of the modified "Tetris" game rules over and above those inherent in these rules themselves.

4. Procedural matters

4.1 The oral proceedings before the board focused in particular on the definition of "game rules" and resulted in amendments to the claims which addressed the board's objections. Thus the amended claims have been filed in response to the board's objections at the oral proceedings.

4.2 It is true that according to Article 13(3) of the Rules of Procedure of the Boards of Appeal (RPBA) amendments made especially at the oral proceedings should not be admitted if they raise issues which the board cannot reasonably be expected to deal with without adjournment of the oral proceedings.

However, in the present case, the search division decided under Rule 45 EPC 1973 to draw up no search report, without consulting the applicant, so that the claims on file contain unsearched matter and that an amendment to the claims also necessarily introduces unsearched matter.

Thus, the board at the oral proceedings was not able to examine whether the amended claimed subject-matter involves an inventive step, not because this amendment had been submitted at a very late stage namely at the oral proceedings but because it merely relates to unsearched matter.

The fact that the board was not in a position to decide on the issue of inventive step at the oral proceedings is clearly not dependent on the degree of lateness of the applicant's amendment, it is primarily the result

of the search division's decision that no search should be carried out so that only unsearched matter could be used by the applicant for amending the claims.

- 4.3 In cases in which the search division did not carry out a search under Rule 45 EPC 1973 and features are claimed which are neither notoriously known nor explicitly accepted by the applicant as known, the boards of appeal have decided (see e.g. T 1515/07 of 3 July 2008, reasons 6; T 690/06 of 24 April 2007, reasons 2; both not published in OJ EPO) that an additional search must be carried out.

Since the amendment in feature g) of claim 1 and the corresponding amendment in claim 9 meet these requirements, it is necessary to carry out an additional search according to Rule 63 EPC.

Moreover, already in the annex to the oral proceedings, the board expressed the view that if a request were found to be allowable on the basis of the available facts and evidence, then the case should be remitted to the department of first instance for carrying out an additional search.

- 4.4 The above notwithstanding, the board emphasizes that remittal should be seen as an exceptional procedural possibility, and it must be also examined whether the applicant could have been expected to make the amendments which were made during the appeal before the board earlier (see Rule 12(4) RPBA), and thereby could have requested from the examining division to perform the necessary search. For example, the board notes that the applicant did not file any auxiliary request before

the examining division, and therefore the question arises if the appellant could have been expected to file these amendments at least by way of an auxiliary request.

To this the board notes that the identification and separation of the technical effects which may and may not contribute to the technical character of an invention (and thus to inventive step) is far from straightforward. Further, the assumption of a general obligation to file auxiliary requests - in the sense that the party must fear adverse procedural consequences if he does not - appears problematic. Firstly, if one were to recognise this as a procedural obligation, one must immediately also answer the question: how many auxiliary requests are then "expected", given that it is also standing jurisprudence of the boards that too many auxiliary requests can be seen as an abuse of the procedure. Secondly, the EPC as such is completely silent on auxiliary requests: while the board recognises that these are well established in the proceedings before the European Patent Office, both before the first and appeal instances, there is no legal basis for penalising an applicant for not using them. In other words, it should be possible for an applicant to act in good faith also without making use of auxiliary requests.

On the other hand, it is also clear that parties have no entitlement to a remittal as of right (apart from those cases where the first instance commits a procedural violation). This means that a party restricting itself to a single request before the first

instance must be prepared for the possibility that he will not be able to present further requests and have them examined.

Considering the above, the board finds that the appellant himself is also not completely without fault, as nothing prevented him from introducing the subject-matter of the present amendments earlier into the procedure. However, an examination of the first instance proceedings reveals that while the applicant possibly might have realised that further technical features in the claims could lead to the identification of potentially patentable and searchable subject-matter, it would be exaggerated to state that the applicant could have been expected to recognise what amendments he needs to make there and then. He was apparently not invited to make such amendments - and indeed the examining division had no obligation to invite him -, but apparently he also could not have been expected to realise that by way of the further amendments he might at least achieve the recognition of a searchable invention. Apparently the examining division did accept that the claims on file at that time do contain technical features and as such are not excluded from patentability on the basis of Art. 52(2) EPC, see point 3 of the Minutes, first sentence. However, all the recognised technical features were considered notorious and not contributing to inventive step. At no time did the examining division indicate (at least according to the file) that it intends to perform a further search. In other words, there is some justification for the applicant for not trying to find further technical features which could potentially

overcome the Art. 56 objections of the examining division.

- 4.5 In view of these particular circumstances, the board decided to admit the amendments to the claims submitted for the first time at the oral proceedings before the board and, in accordance with Article 111(1) second sentence EPC, to remit the present case to the department of first instance for further prosecution, starting with an additional search.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Register:

The Chairman:

G. Magouliotis

M. Ceyte