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**Datasheet for the decision
of 12 September 2019**

Case Number: T 1386/15 - 3.4.03

Application Number: 12704914.6

Publication Number: 2666149

IPC: G07F17/32

Language of the proceedings: EN

Title of invention:
GAMING SYSTEM AND METHOD OF USE

Applicant:
Novomatic AG

Headword:

Relevant legal provisions:

EPC Art. 56, 84
RPBA Art. 13(1)

Keyword:

Inventive step - main and auxiliary requests - (no)
Late-filed requests - submitted during oral proceedings -
admitted (no)

Decisions cited:

Catchword:



Beschwerdekammern
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Case Number: T 1386/15 - 3.4.03

D E C I S I O N
of Technical Board of Appeal 3.4.03
of 12 September 2019

Appellant: Novomatic AG
(Applicant) Wiener Strasse 158
2352 Gumpoldskirchen (AT)

Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 23 February 2015 refusing European patent application No. 12704914.6 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman G. Eliasson
Members: M. Papastefanou
C. Heath

Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division refusing the European patent application No. 12 704 914.6 (published as WO 2012/098532 A1) on the ground of lack of inventive step within the meaning of Article 56 EPC.
- II. The appellant's (applicant's) final requests were that the decision under appeal be set aside and that a patent be granted based on the Main Request or one of the 1st to 3rd Auxiliary Requests. The Main and (1st) Auxiliary Requests were filed with the statement of the grounds of the appeal. The 2nd and 3rd Auxiliary Requests were filed during the oral proceedings before the board.
- III. Reference is made to the following document, cited in the decision under appeal:
- D1 (WO 2007/032945 A2).
- IV. Claim 1 of the **Main Request** is worded as follows:

*A gaming system (100) comprising:
multiple electronic gaming machines (110; 535, 540),
each configured to play a game and including at least:
a display (120);
an interface (215; 220) capable of accepting
instructions from a player to initiate play of the
game;
memory (125, 126) capable of storing a plurality of
software instructions;
a random number generator (130) capable of randomly
generating game outcomes; and
a processor (115) for controlling the display, the*

*interface and the random number generator,
a controller (105; 400; 525) in communication with each
of said multiple electronic gaming machines (110; 535,
540), said controller configured to:
randomly select fixed bonus code symbols from a pool of
symbols;
randomly select a quantity of game code symbols from
said pool of symbols wherein said quantity of game code
symbols equals a quantity of fixed bonus game symbols;
prior to each play of each of said multiple electronic
gaming machines, randomly determine (320) a direction
of movement for selection of each of said game code
symbols;
responsive to play of one of said multiple electronic
gaming machines, adjust (330) at least one game code
symbol in said randomly determined direction (835) of
movement;
compare respective adjusted game code symbols (810) to
corresponding code symbols (805);
lock (570) game code symbols (810) matching said bonus
code symbols (805); and
responsive to each of said game code symbols matching a
corresponding one of said bonus code symbols, trigger
an award to players playing one of said networked
multiple electronic gaming machines.*

- V. Claim 1 of the **(1st) Auxiliary Request** is worded as follows (features added with respect to claim 1 of the Main Request underlined by the board):

*A gaming system (100) comprising:
multiple electronic gaming machines (110; 535, 540),
each configured to play a game and including at least:
a display (120);
an interface (215; 220) capable of accepting
instructions from a player to initiate play of the*

game;
memory (125, 126) capable of storing a plurality of software instructions;
a random number generator (130) capable of randomly generating game outcomes; and
a processor (115) for controlling the display, the interface (215; 220) and the random number generator, a controller (105; 400; 525) in communication with each of said multiple electronic gaming machines (110; 535, 540), said controller configured to:
randomly select fixed bonus code symbols (830) from a pool of symbols;
randomly select a quantity of game code symbols (810) from said pool of symbols wherein said quantity of game code symbols (810) equals a quantity of the fixed bonus game symbols;
displaying a respective one (805) of the selected bonus code symbols (830) and a respective one of the selected game code symbols (810) adjacent to one another;
prior to each play of each of said multiple electronic gaming machines assigning each of the electronic gaming machines to a different one of the game code symbols (810) and randomly determining (320) a direction (835) of movement for selection of each of said game code symbols (810) and indicating the direction (835) of movement at each of the game code symbols (810);
responsive to play of one of said multiple electronic gaming machines, adjust (330) at least one game code symbol (830) in said randomly determined direction (835) of movement;
compare respective adjusted game code symbols (810) to corresponding code symbols (805);
lock (570) game code symbols (810) matching said corresponding bonus code symbols (805); and
responsive to each of said game code symbols matching a corresponding one of said bonus code symbols, trigger

an award to players playing one of said networked multiple electronic gaming machines.

- VI. Claim 1 of the **2nd Auxiliary Request** has the same wording as claim 1 of the 1st Auxiliary Request and, in addition, comprises the following feature, added to the penultimate paragraph:

"for each locked game code symbol, responsive to play assign an electronic gaming machine to an unlocked game code symbol".

- VII. Claim 1 of the **3rd Auxiliary Request** has the same wording as claim 1 of the 1st Auxiliary Request and, in addition, comprises the following feature, added to the penultimate paragraph:

"and the electronic gaming machine which was driving the locked game code symbol is switched or re-assigned to drive a different unlocked game code symbol".

- VIII. The appellant's main argument was that, contrary to the assertion of the examining division, the features distinguishing the independent claims of the Main and 1st Auxiliary Requests from D1 solved technical problems and conferred, thus, novelty and inventive step to the claimed subject-matter.

Regarding the admissibility of the 2nd and 3rd Auxiliary Requests, the appellant argued that the added feature was in claim 2 of the requests underlying the decision under appeal and was neither disclosed nor suggested by D1.

Reasons for the Decision

1. Main Request

The Main request corresponds to the request underlying the decision under appeal.

1.1 Closest prior art

1.1.1 The appellant did not contest the selection of document D1 as closest prior art. It remained also uncontested that D1 disclosed all the features relating the technical infrastructure of the claimed gaming system.

D1 discloses (see decision under appeal, page 2, point 9), thus, a gaming system (see Figures 2, 3 and 9) comprising multiple electronic gaming machines (10a-10d in Figure 3) each configured to play a game and including at least a display (12 in Figure 2, 30 in Figure 3, 132 in Figure 9) and an interface capable of accepting instructions from a player to initiate a game (14, 17, 18 in Figure 2). It further comprises a memory (20) capable of storing a plurality of software instructions (see also paragraphs [0036] and [0037]) and a random number generator capable of randomly generating game outcomes (see paragraphs [0036] and [0042]; the CPU (16) plays the role of the random number generator). The processor (CPU (16)) controls the display, the interface and the random number generator (see for example Figure 2). A controller (36 in Figure 3) is in communication with each of said multiple electronic gaming machines (see Figure 3) and is configured to randomly select fixed bonus symbols from a pool of symbols (see paragraphs [0050] and [0051]; the controller determines the Monopoly-like game).

1.1.2 Regarding the game played in the system of D1, the board notes the following:

The players of the community play together a game based on the known board game of MONOPOLY (see Figure 6 and paragraph [0044]). One or all the players get to select a (respective) token that will be moved around the MONOPOLY board (paragraphs [0045] and [0082]- [0083]). The players make wagers (side bets) on the position(s) the token(s) will land when they move (paragraphs [0047]- [0049] and [0061]) or other types of wagers (paragraph [0063]). The controller generates a random selection of an integer movement value defining the steps the token is to make on the MONOPOLY board (paragraph [0051]). A comparison is made between the position the token landed (an "event" for the system) and the wagers placed by the players (paragraph [0054]). Payout to the players is calculated by a payout system according to wagers placed (paragraph [0056]) or according to other rules (paragraph [0061]).

1.1.3 It is uncontestable that the game played by the players' community in D1 is different from the one in the claimed gaming system. The Board notes, however, that the main concepts of the two games are similar:

- (i) the outcome of the game is based on randomly generated events;
- (ii) the controller compares the randomly generated events to predetermined conditions and looks for matches;
- (iii) the players have the opportunity to make individual wagers;
- (iv) the payout of the awards to the players is determined by the system based on predetermined criteria.

1.2 Difference and technical problem

1.2.1 The features distinguishing the gaming system of claim 1 of the Main Request from the one in D1 are (see also page 3, first half of page 3 of the impugned decision):

- randomly select a quantity of game code symbols from said pool of symbols wherein said quantity of game code symbols equals a quantity of fixed bonus game symbols;
- prior to each play of each of said multiple electronic gaming machines, randomly determine a direction of movement for selection of each of said game code symbols;
- responsive to play of one of said multiple electronic gaming machines, adjust at least one game code symbol in said randomly determined direction of movement;
- compare respective adjusted game code symbols to corresponding bonus code symbols;
- lock game code symbols matching said bonus code symbols;
- and responsive to each of said game code symbols matching a corresponding one of said bonus code symbols, trigger an award to players playing one of said networking multiple electronic gaming machines.

1.2.2 Although the appellant did not contest the analysis of the disclosure of D1 and the identified distinguishing features in the impugned decision, there was disagreement on how these features were to be assessed.

The examining division was of the opinion that no technical problem was being solved by these features because they referred to a scheme for playing games.

Hence, they provided no technical contribution over the prior art and therefore the subject-matter of claim 1 did not involve an inventive step (page 3, penultimate paragraph of the decision under appeal).

In the statement setting out the grounds of the appeal, the appellant argued that the distinguishing features were addressing two technical problems (see the paragraph bridging pages 1 and 2 of the statement of the grounds of the appeal):

- (a) Providing and implementing a gaming system and method by which the payout of a jackpot to one or more players is randomly and automatically controlled (i.e. without any players' interaction) wherein players are enabled to build a playing community by playing the designated gaming machines.
- (b) How to optimize time control of payouts in gaming sequence having multiple random inputs.

1.2.3 Following the analysis of the disclosure of D1 (see point 1.1 above), the board considers that the first technical problem identified by the appellant (see point 1.2.2 (a) above) is solved by the gaming system of D1. See also points 1.2.10 and 1.2.11 below for the aspect of players playing together rather than against each other.

The players are enabled to build a playing community, since they all play together the MONOPOLY-like game. The payout to the players is randomly and automatically controlled (i.e. without any interaction by the players), since the various events are randomly generated (the advancement of the token) and the awards

for each player are automatically calculated by the payout system of the game based on the players' bets and predetermined rules.

- 1.2.4 Regarding the second technical problem identified by the appellant (point 1.2.2 (b)), the board finds first of all that it is not clear from the application what is meant by the expression "to optimize the time control of payouts". The board understands that such an expression would indicate that the system has control of when the payouts to the players are actually executed, but it cannot derive from the content of the application what is meant by optimizing such a payout with respect to time (control).

Secondly, in the gaming system of D1 the system has control of how and when the payout to the players is to be executed, as well (see for example paragraph [0056]).

- 1.2.5 During the oral proceedings the appellant explained that optimizing "the time control of the payouts" was to be understood as setting the timing of paying out of the awards in a way that players' engagement was maximised. The awards should not be paid out quickly, because the players would simply take them and leave without playing further. At the same time, players should not wait too long for the payout because they would be bored and lose interest in the game. In addition, the amount of the jackpot to be won by the players should appear to be worth it for the players to try to win it but it should also leave some margin for profit for the owner/operator of the gaming system.

- 1.2.6 The board pointed out to the appellant that there were no features of the gaming system of claim 1 that

appeared to address such a problem and there was no relevant mention of it in the description. The appellant was not able to identify any such features or any related passage in the description, either.

1.2.7 The board concludes, thus, that the second technical problem identified by the appellant is either solved by the system of D1, or is not appropriately formulated as a technical problem to be solved by the identified distinguishing features of claim 1.

1.2.8 Hence, a new objective technical problem to be solved by the features distinguishing the gaming system of claim 1 from the one in D1 needs to be formulated.

In this context, it must be noted that only those distinguishing features can be taken into account that are of a technical nature.

In the board's view, features a) and b) as listed in point 1.2.2 above merely reflect the rules of the game that is played by the players' community in the claimed gaming system. As it can be seen from the description (see paragraphs [0027] to [0029]), the steps that the controller in claim 1 is configured to execute correspond to the series of actions that are needed in order to play the specific game. In other words, the above features correspond to the rules for playing the specific lotto-like game of the claimed gaming system.

1.2.9 In the context of claim 1 features a) and b) are not considered as rules of playing games as such in the sense of Article 52(2)(c) and (3) EPC at least because they are executed by a controller connected to multiple electronic gaming machines, and are considered to have technical character.

The aim of these features is, however, to implement a set of rules of playing a game, which (the rules) themselves are not considered to have any technical character.

The technical problem to be solved could thus be formulated as how the skilled person (a software programmer expert in gaming systems in the present case) would implement the rules for playing the specific game of claim 1 into the gaming system of D1.

- 1.2.10 During the oral proceedings before the board the appellant argued that the board's approach in defining the technical problem to be solved did not take into account any innovation achieved within the game itself.

There was a fundamental difference between the game played by the community in the claimed system and the one in D1. While in D1 the players were playing against each other, in the community game of the claimed system they were playing together, i.e. they were cooperating in order to achieve a common goal, which was to match the predetermined bonus code symbols and win the jack pot.

The skilled person was not a computer programmer but a games' developer, someone who created/designed new games. Such a skilled person would not have found it obvious to arrive at the gaming system of claim 1 when starting from D1.

- 1.2.11 The board does not agree with the appellant on this argument. Whether players compete with each other or cooperate in order to achieve a certain outcome is defined by the rules of the game played. As already

stated above, rules for playing games as such are not considered inventions in the sense of the EPC (Article 52(2)(c) and (3) EPC). Consequently, someone who creates/designs new games (i.e. creates new rules for playing games) cannot be considered a skilled person within the meaning of Article 56 EPC. In the same way, devising new game rules cannot be regarded as a technical problem within the context of the EPC. Whether players play together or against each other can only be considered to the extent that the technical implementation of this rule is different.

1.2.12 The board remains thus with the definition of the technical problem to be solved as stated in points 1.2.8 and 1.2.9 above.

1.3 Solution and Obviousness

1.3.1 The application does not describe or suggest any particular way of implementing the distinguishing features of the claimed gaming system. There are no particular technical considerations related to the implementation of these features apparent, either. The board concludes, therefore that the implementation of the distinguishing features is a matter of straightforward software programming of the gaming system, which lies within the skilled person's common general knowledge.

1.3.2 Hence, the skilled person starting from the gaming system of D1 (which has the same technical features as the one of the claim 1) would implement the rules of the specific lotto-like game played by the gaming system of claim 1 in an obvious manner and using only his common general knowledge.

1.3.3 The conclusion of the board is, therefore, that the subject-matter of claim 1 of the Main Request does not involve an inventive step in the sense of Article 56 EPC.

2. (1st) Auxiliary Request

2.1 In claim 1 of the (1st) Auxiliary Request the following features have been added (see point V above):

- (i) displaying a respective one (805) of the selected bonus code symbols (830) and a respective one of the selected game code symbols (810) adjacent to one another;
- (ii) assigning each of the electronic gaming machines to a different one of the game code symbols (810); and
- (iii) indicating the direction (835) of movement at each of the game code symbols (810)

(see also page 3 of the statement of grounds of appeal, bottom half of the page).

The appellant argued that the first of these features allowed the players to determine easily and quickly the correspondence between the respective game code symbols and bonus code symbols. This allowed the players to determine easily and quickly the correspondence between the game code symbols and the bonus code symbols. Such a feature was neither disclosed nor suggested in D1 so that the subject-matter of claim 1 of the (1st) Auxiliary request involved an inventive step (see last page of the statement of the grounds of appeal). No arguments were presented in relation to the

other added features (ii) and (iii).

2.2 The board notes that, contrary to the appellant's assertion, such a feature is suggested in D1. As it can be seen in Figures 7 and 8 of D1, randomly selected numbers that correspond to the movement of the token (in the form of dice), the token itself as well as the wagers placed on each property are all displayed adjacent to one another, so that each player can easily and quickly determine the evolution of the game and whether they "won" any awards.

2.3 Any difference in the displayed information between the gaming system of claim 1 and D1 is dictated by the difference in the game played (lotto vs MONOPOLY), i.e. by the game rules.

2.4 As with the Main Request, in the absence of any implementation details in the application, the board considers that modifying the images displayed in the gaming system of D1 in order to correspond to the specific game played in the system of claim 1 is something the skilled person would do in an obvious manner and using only common general knowledge.

2.5 The board concludes, thus, that the subject-matter of claim 1 of the (1st) Auxiliary Request does not involve an inventive step, either.

3. 2nd and 3rd Auxiliary Requests - Admissibility

3.1 These requests were filed for the first time during the oral proceedings before the board.

3.2 The 2nd and 3rd Auxiliary Requests are, therefore, amendments to the appellant's case (Article 12(2) Rules

of Procedure of the Boards of Appeal - RPBA) and are to be admitted into the proceedings at the discretion of the board (Article 13(1) RPBA).

3.3 An established criterion in the board's exercise of discretion in such a case is the *prima facie* allowability of any newly filed amended claims. Claims are clearly allowable if the board can quickly ascertain that they do not give rise to new objections and overcome all outstanding objections and their patentability could be assessed without giving any rise to any difficulty or delay (see *Case Law of the Boards of Appeal of the European Patent Office, 9th Edition 2019, V.A.4.12.2*).

3.4 The board notes at first that there is a contradiction between the feature added in claim 1 of the 2nd Auxiliary request and the rest of the application.

According to claim 1, "for **each** locked game code symbol" (emphasis by the board) the corresponding gaming machine is reassigned to an unlocked game code symbol. According to the description and Figures, however, this is not the case as it can be seen in Figures 6b and 6c, for example. The game code symbols of PLAYER 1 and PLAYER 4 are locked (because they have matched the respective bonus code symbols) but only one of the gaming machines (PLAYER 4) is re-assigned to an unlocked game code symbol, the one of PLAYER 2 (see also paragraph [0035] of the application as published). Hence, according to the application this re-assignment of gaming machines to an unlocked game code symbol does not occur for "each locked game code symbol" as claim 1 defines.

This contradiction raises doubts as to whether the

claimed scope of protection is supported by the description and whether claim 1 of the 2nd Auxiliary Request complies with the requirements of Article 84 EPC.

- 3.5 Moreover, the board sees the provision that a player (whose game code symbol is locked) can continue playing (by being re-assigned to another, unlocked game code symbol) as part of the rules of the game played.

The appellant argued that this feature had the effect of keeping the player engaged in the game. The board does not consider keeping the players engaged in the game to be a technical problem that is to be solved by technical features. It is rather a game-related problem that is addressed by the game rules.

Hence, the additional feature of claim 1 of the 2nd Auxiliary Request is regarded as an additional game rule that is to be implemented by the skilled person and it cannot be seen as a basis for an inventive step in the sense of Article 56 EPC.

The subject-matter of claim 1 of the 2nd Auxiliary Request therefore does not appear to involve any inventive step for the same reasons as the Main and the 1st Auxiliary Requests.

- 3.6 The feature added in claim 1 of the 3rd Auxiliary request (when compared to claim 1 of the 1st Auxiliary Request) is in essence the same with the one added in claim of the 2nd Auxiliary request albeit in a different wording.

- 3.7 The board notes that the use of the definite article "the" in "**the electronic gaming machine** which was

driving the locked game code is switched or re-assigned to drive a different unlocked game code symbol"

(emphasis by the board) implies that each gaming machine driving a locked game code symbol is re-assigned to an unlocked game code symbol.

- 3.8 The same observations regarding claim 1 of the 2nd Auxiliary request (see points 3.4 and 3.5 above) apply, therefore, to claim 1 of the 3rd Auxiliary Request, as well.
- 3.9 Since the claims of the newly filed Auxiliary Requests do not prima facie appear to overcome the outstanding objections under Article 52(1) and 56 EPC and, in addition, they give rise to new objections under Article 84 EPC, the board, exercising its discretion according to Article 13(1) RPBA, decided not to admit the 2nd and 3rd Auxiliary Requests into the proceedings.
4. Since none of the requests on file is allowable, the appeal must fail.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



S. Sánchez Chiquero

G. Eliasson

Decision electronically authenticated