

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ERNEST W. MOODY and MICHAEL W. WOOD

Appeal No. 2002-0949
Application No. 09/514,860

ON BRIEF

Before COHEN, ABRAMS and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-8, which are all of the claims pending in this application.

BACKGROUND

The appellants' invention relates to electronic video poker games. Claim 1 is illustrative of the invention and reads as follows:

1. A method of playing a card game comprising:
 - a) dealing a first hand comprising an initial five cards all face up;
 - b) selecting none, one or more of the face up cards from the first hand as cards to be held;
 - c) discarding from the first hand the cards that were not selected to be held and replacing each of those cards with a face up card;
 - d) determining the poker hand ranking of the resulting cards of the first hand
 - e) redisplaying the initial five cards as a second hand;
 - f) selecting none, one or more of the face up cards of the redisplayed cards as cards to be held;
 - g) discarding from the second hand the cards that were not selected to be held and replacing each of those cards with a face up card;
 - h) determining the poker hand ranking of the resulting cards of the second hand.

The examiner relied upon the following prior art references in rejecting the appealed claims:

Kadlic

5,816,915

Oct. 6, 1998

Hachquet

6,050,568

Apr. 18, 2000
(filed Jun. 30, 1998)

The following rejections are before us for review.

Claims 1, 2, 5 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hachquet.

Claims 3, 4, 7 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hachquet in view of Kadlic.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 10) for the examiner's complete reasoning in support of the rejections and to the brief (Paper No. 9) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied Hachquet and Kadlic patents, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Each of appellants' independent claims 1 and 5 recites a method comprising steps of dealing a first hand of initial cards, selecting cards to be held, discarding from the first hand cards that were not selected to be held and replacing those cards, determining the poker hand ranking of the resulting cards of the first hand, redisplaying the initial cards as a second hand, selecting cards of the redisplayed cards to be held,

discarding and replacing cards not selected to be held and determining the poker ranking of the resulting cards of the second hand. Appellants' use of the terminology "redisplaying the initial five [or pre-established number of] cards as a second hand" makes it clear that the step of displaying and the first series of steps of selecting, discarding and replacing and determining must occur prior to the step of "redisplaying" and the second series of steps of selecting, discarding and replacing and determining.¹

As clearly illustrated in Figure 1, Hachquet discloses a method of playing video poker in which two identical five card hands 12, 14 are displayed simultaneously. Each of the hands 12, 14 is then played, ranked and awarded individually (column 2, lines 36-37; column 3, lines 56-58).

While the examiner has rejected claims 1 and 5 under 35 U.S.C. § 103 as being unpatentable over Hachquet, rather than under 35 U.S.C. § 102 as being anticipated by Hachquet, thereby indicating that the examiner has recognized a difference between Hachquet's disclosed method and the claimed subject matter, the examiner has not expressly identified any difference between Hachquet and the claimed subject matter, proposed a modification to Hachquet to arrive at the claimed invention or explained the motivation for such modification, as required for an obviousness determination under

¹ We note that this interpretation is also consistent with appellants' underlying disclosure (specification, page 9, line 15, to page 12, line 25).

35 U.S.C. § 103.² See Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). Instead, the examiner states that “[t]he playing of two hands at the same time but independently is considered to be the same as playing both hands one at a time” (answer, page 3). We do not agree. While the examiner may not be impressed with this difference, it cannot reasonably be disputed that there is a difference between displaying the two identical hands simultaneously for play, as taught by Hachquet, and displaying and playing a first hand of cards and then subsequently redisplaying the same cards as a second hand and playing the second hand, as called for in appellants’ claims 1 and 5.

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

Inasmuch as we find a difference between the method taught by Hachquet and the method recited in each of claims 1 and 5 and the examiner has not offered any explanation as to why it would have been obvious to one of ordinary skill in the art to

² The required contents of a rejection under 35 U.S.C. § 103 are set forth in § 706.02(j) of the Manual of Patent Examining Procedure (MPEP).

modify the Hachquet method to arrive at the claimed method, we cannot sustain the examiner's rejection of independent claims 1 and 5, or claims 2 and 6 which depend therefrom, as being unpatentable over Hachquet.

As for the examiner's rejection of claims 3, 4, 7 and 8, which require the same steps discussed supra with respect to claims 1 and 5, as being unpatentable over Hachquet in view of Kadlic, Kadlic's teaching of displaying four or more poker hands for play on a video poker machine does nothing to cure the above-noted deficiency of Hachquet. It follows that we also shall not sustain this rejection.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-8 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN
Administrative Patent Judge

NEAL E. ABRAMS
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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