

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte D & D Gaming Patents Inc.

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Appeal No. 98-0614  
Reexamination Control No. 90/003,184<sup>1</sup>  
Reexamination Control No. 90/003,865<sup>2</sup>

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HEARD: December 7, 1998

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Before FRANKFORT, NASE, and CRAWFORD, Administrative Patent Judges.

NASE, Administrative Patent Judge.

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<sup>1</sup> Reexamination for U.S. Patent No. 4,861,041, issued August 29, 1989. U.S. Patent No.4,861,041 issued from Application No. 07/214,934, filed July 5, 1988. According to the appellant, that application was a continuation-in-part of Application No. 07/182,374, filed April 18, 1988, now U.S. Patent No. 4,836,553. Request for reexamination filed September 2, 1993.

<sup>2</sup> Reexamination for U.S. Patent No. 4,861,041, issued August 29, 1989. Request for reexamination filed June 20, 1995. The reexamination proceeding was merged with the above-noted reexamination proceeding on April 24, 1996.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 4, 6, 8, 10 and 14. Claims 5, 7, 9, 11 through 13 and 15 through 19 have been confirmed.

We AFFIRM-IN-PART, however, for reasons explained infra, we denominate the affirmance part of this decision a new ground of rejection under 37 CFR § 1.196(b). In addition, we enter another new ground of rejection pursuant to 37 CFR § 1.196(b).

BACKGROUND

The appellant's invention relates to a method of progressive jackpot gaming. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced in the opinion section below.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Scarne, John "Chapter 2 Draw Poker and Chapter 3 Stud Poker"  
Scarne's Encyclopedia of Games, Harper & Row (1973) pp. 6-53  
(Rules of Poker)

Scarne, John "Chapter 16 Banking Card Games" Scarne's Encyclopedia of Games, Harper & Row (1973) p. 286 (Pontoon)

Scarne, John "Chapter 20 Miscellaneous Card Games" Scarne's Encyclopedia of Games, Harper & Row (1973) p. 381 (Three-In-One)

Big Field Rules and Directions<sup>3</sup> (Big Field)

Reference made of record by this panel of the Board is:

Tripoley, "How to Play," Cadaco, Inc., 1968 (Tripoley)

Claims 1, 2, 4, 6, 8 and 10 stand rejected under 35 U.S.C.

§ 102(b) as being anticipated by Rules of Poker.

Claims 1 through 4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Three-In-One.

Claims 1 and 14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Big Field.

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<sup>3</sup> A declaration of Jim Kilby dated May 9, 1995, was utilized by the examiner as averring the date of this publication as circa September 1984.

Claims 1, 2 and 14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Pontoon.

Claims 6, 8 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Three-In-One.

Claims 1, 2, 4, 6, 8 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Rules of Poker.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (mailed January 6, 1998) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (filed November 17, 1997), reply brief (filed February 9, 1998) and supplemental reply brief (filed August 29, 1998) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Before addressing the examiner's rejections based upon prior art, it is an essential prerequisite that the claimed subject matter be fully understood. Analysis of whether a claim is patentable over the prior art under 35 U.S.C. §§ 102 and 103 begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. See Smithkline Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988). Accordingly, we will initially direct our attention to appellant's claim 1 to derive an understanding of the scope and content thereof.

Claim 1 recites:

A method of including a jackpot component in a live casino table game comprising the steps of:  
(a) a player wagering a first gaming token to participate in the live casino game,  
(b) a player wagering a second gaming token to participate in the jackpot component,  
(c) a dealer dealing a hand of playing cards to the player,  
(d) if the player's hand comprises a predetermined arrangement of cards, the player wins a preselected amount of the jackpot.

The appellant argues in the brief (1) that the method steps must be interpreted pursuant to 35 U.S.C. § 112, sixth paragraph, (pp. 3-5); (2) that the prior art does not meet the required order of steps (pp. 11-13); and (3) the meaning of the phrase "live casino table game" (pp. 13--17).

35 U.S.C. § 112, sixth paragraph, in effect provides that an element in a combination method or process claim may be recited as a step for performing a specified function without the recital of acts in support of the function. Being drafted with the permissive "may," the statute does not require that steps in a method claim be drafted in step-plus-function form but rather allows for that form. A step for accomplishing a particular function in a process claim may be claimed without

invoking section 112, paragraph 6. Thus, it is inappropriate to construe every process claim containing steps described by an "ing" verb, such as wagering, winning, etc. into a step-plus-function limitation. See O.I. Corp. v. Tekmar Co., 115 F.3d 1576, 1583, 42 USPQ2d 1777, 1782 (Fed. Cir. 1997).

Applying the rationale set forth in O.I. Corp. to the steps recited in claim 1, we conclude that the recited steps are not step-plus-function limitations subject to the requirements of 35 U.S.C. § 112, sixth paragraph. In that regard, as in O.I. Corp. the claimed steps of wagering, dealing and winning are not individually associated in the claims with functions performed by the steps of wagering, dealing or winning.

As stated in Ex parte Jackman, 44 USPQ 171, 173 (Bd. App. 1938):

[i]t has frequently been held in connection with claims of this type [method claims] that there is no presumption of any definite sequence unless the claims are so limited as to require it.

Applying the above-noted principle set forth in Jackman to the steps recited in claim 1, we conclude that claim 1 requires the specific sequence of steps to be performed in the order indicated. We reach this conclusion based upon the following factors: (1) a sequence of steps is indicated by the appellant's use of (a), (b), (c) and (d); (2) the recitations that a player wagers "a **first** gaming token to participate in the live casino game" and wagers "a **second** gaming token to participate in the jackpot component" indicates a specific order; and (3) the recitation in step (d) that "if the player's **hand** comprises a predetermined arrangement of cards, the player wins a preselected amount of the jackpot" indicates that this step is preceded by step (c) (i.e., the step of "dealing a hand of playing cards to the player").

It is axiomatic that claims in reexamination proceedings are to be given their broadest reasonable interpretation consistent with the specification. In re Yamamoto, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984). When so read, the meaning of the phrase "live casino table game" means a

typical casino or cardroom table game such as poker or Twenty-One.<sup>4</sup> We note, however, that the claimed method does not require the steps to be performed in a casino.

With these understandings of the subject matter recited in claim 1, we turn to the rejections raised by the examiner.

#### **Rejections based upon Rules of Poker**

We will not sustain the rejection of claims 1, 2, 4, 6, 8 and 10 under 35 U.S.C. § 102(b) as being anticipated by or under 35 U.S.C. § 103 as unpatentable over Rules of Poker.

We agree with the appellant's arguments that Rules of Poker does not anticipate or render obvious the subject matter of claim 1 (brief, pp. 5-9 and 25). In that regard, it is our determination that Rules of Poker does not teach or suggest the following elements of claim 1 for the reasons set forth by the appellant in the brief: (1) including a jackpot component in a live casino table game; (2) a player wagering a second

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<sup>4</sup> See column 1, line 12, to column 2, line 9, of U.S. Patent No. 4,861,041.

gaming token to participate in the jackpot component; and (3) if the player's hand comprises a predetermined arrangement of cards, the player wins a preselected amount of the jackpot.

### **Rejections based upon Big Field**

We will not sustain the rejection of claims 1 and 14 under 35 U.S.C. § 102(b) as being anticipated by Big Field.

We agree with the appellant's argument (brief, pp. 18-19 and reply brief, pp. 3-5) that Big Field is not prior art. In that regard, it is our determination that clearly Big Field was printed/published on or after September 1991 for the reasons outlined by the appellant. In addition, the declaration of Jim Kilby dated May 9, 1995, does not establish a date of printing/publication of Big Field prior to September 1991. While the declaration of Jim Kilby may establish that the game of "big field" existed in 1984, it fails to establish that the publication Big Field, relied upon by the examiner, existed prior to the critical date (i.e., July 5, 1988).<sup>5</sup>

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<sup>5</sup> In a reexamination proceeding, only patents and printed publications may be utilized in rejections under 35 U.S.C. §

**Rejections based upon Pontoon**

We will not sustain the rejection of claims 1, 2 and 14 under 35 U.S.C. § 102(b) as being anticipated by Pontoon.

We agree with the appellant's arguments that Pontoon does not anticipate the subject matter of claim 1 (brief, p. 14 and supplemental reply brief, p. 1-4). In that regard, it is our determination that Pontoon does not teach or suggest the following element of claim 1 for the reasons set forth by the appellant in the brief and supplemental reply brief: a player wagering a **second** gaming token to participate in the jackpot component after wagering a **first** gaming token to participate in the live casino game. In Pontoon, a single wager (i.e., the initial bet, the doubling of the bet, or the redoubling of the bet) permits the player to participate in both the live casino game (i.e., Black Jack) and the jackpot component (i.e., the bonus payments).

**Rejections based upon Three-In-One**

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102 or § 103. 35 U.S.C. §§ 301-303.

We sustain the rejection of claims 1 through 4 under 35 U.S.C. § 102(b) as being anticipated by Three-In-One. We sustain the rejection of claims 8 and 10 under 35 U.S.C. § 103 as being unpatentable over Three-In-One, but not the rejection of claim 6.

The teachings of Three-In-One are set forth on pages 10-11 of the brief.

*The anticipation issues*

We agree with the appellant's argument (brief, pp. 11-13) that the examiner's rationale in applying Three-In-One with regard to claim 1 (answer, pp. 7-8) does not provide correspondence with the subject matter of claim 1 since the examiner's interpretation of the claim ignored the required order of steps. However, it is our determination that Three-In-One does anticipate<sup>6</sup> claim 1 since the required order of

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<sup>6</sup> A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987).

steps is present in Three-In-One for the reasons set forth below.

Three-In-One discloses a card game in which a hand has three stages.<sup>7</sup> Three-In-One also discloses that the initial hand is followed by subsequent hands (having the same three stages) until the game breaks up. Three-In-One teaches that when the game breaks up and there are still chips (i.e., gaming tokens) left in any of the layouts, a round of cold hands in poker is dealt with the winner taking all the chips on the board. Thus, the Three-In-One card game encompasses multiple hands.

Claim 1 reads on Three-In-One as follows:

A method of including a jackpot component (stage one of Three-In-One) in a live casino table game (stage 2 of Three-In-One since poker is a live casino game) comprising the steps of:

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<sup>7</sup> The three stages are as follows: the first stage is collecting on the sequence card(s), the second stage is a round of closed poker, and the third stage is a game of Michigan.

(a) a player wagering a first gaming token to participate in the live casino game (in stage two of the first hand of Three-In-One the player must put a chip in the pot),

(b) a player wagering a second gaming token to participate in the jackpot component (at the start of the second hand of Three-In-One the player must ante a total of six chips on the layout, one chip next to the ace, jack and ten, two chips next to the king-queen combination, and one chip next to the sequence of seven, eight and nine),

(c) a dealer dealing a hand of playing cards to the player (the dealer deals the second hand to the player),

(d) if the player's hand comprises a predetermined arrangement of cards, the player wins a preselected amount of the jackpot (in stage one of the second hand of Three-In-One if the player's hand contains any of the predetermined arrangement of cards set out on the layout (e.g., the king-queen combination), the player wins all the chips associated therewith).

The appellant's argument (brief, pp. 13-17) that Three-In-One is not a casino game is unpersuasive since it is not commensurate in scope with the claimed invention. In that regard, the claims only require that a jackpot component be included in a live casino table game. The claims do not require the method to be performed in a casino. Since poker is a live casino table game, stage 1 of Three-In-One adds a jackpot component to a live casino table game.

The appellant's argument (brief, pp. 17-18) with regard to claim 4 is unpersuasive for the following reasons. Claim 4 recites that "the live casino game is five card stud poker." It is our determination that "five card stud poker" reads on<sup>8</sup> the round of closed poker utilizing five cards taught by stage two of Three-In-One.

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<sup>8</sup> The law of anticipation does not require that the reference teach what the appellant is claiming, but only that the claims on appeal "read on" something disclosed in the reference (see Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984)).

*The obviousness issues*

The examiner determined (answer, pp. 12-13) that

it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the second stage of the Three-In-One game to be any known poker variation, including those set forth in the instant claims [claims 6, 8 and 10], in order to provide an interesting variation to the Three-In-One game.

The appellant argues (brief, pp. 24-25) that while the claimed poker variants are *per se* conventional, the addition to them of a jackpot component as recited in parent claim 1 would not have been obvious. We agree with respect to claim 6 but disagree with respect to claims 8 and 10.

Initially we note that while there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or prior art specifically suggest making the combination (see B.F. Goodrich Co. v. Aircraft Braking Systems Corp., 72 F.3d 1577, 1583, 37 USPQ2d 1314, 1319 (Fed. Cir. 1996) and In re Nilssen, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988)). Rather, the test for obviousness is

what the teachings of the applied prior art would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Moreover, in evaluating a reference it is proper to take into account not only the specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). Additionally, we observe that an artisan must be presumed to know something about the art apart from what the references disclose (see In re Jacoby, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962)) and the conclusion of obviousness may be made from "common knowledge and common sense" of the person of ordinary skill in the art (see In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)).

In applying the above-noted guidance, we reach the conclusion that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the second stage of Three-In-one by either (1) playing the

round of five card closed poker as lo-ball poker (claim 10) to thereby allow the worst hand to win the pot rather than the best hand; or (2) playing the round of closed poker using seven cards (claim 8) instead of five since each player would have at least seven cards.

However, with respect to claim 6, we see no suggestion from either the applied prior art or the knowledge of one skilled in the art that would have suggested replacing the stud poker of Three-In-One with draw poker. Accordingly, the decision of the examiner to reject claim 6 under 35 U.S.C. § 103 as being unpatentable over Three-In-One is reversed.

#### CONSIDERATION OF EVIDENCE OF NONOBVIOUSNESS

Having arrived at the conclusion that the teachings of the prior art are sufficient to establish a prima facie case of obviousness, we recognize that the evidence of nonobviousness submitted by the appellant must be considered en route to a determination of obviousness/nonobviousness under 35 U.S.C.

§ 103. See Stratoflex Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). Accordingly, we consider anew the issue of obviousness under 35 U.S.C. § 103, carefully evaluating therewith the objective evidence of nonobviousness supplied by the appellant. See In re Oetiker, 977 F.2d 1443, 1445-46, 24 USPQ2d 1443, 1444-45 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984).

In this case the appellant has directed our attention to the evidence of nonobviousness as set forth on pages 26-28 of the brief. We do not believe that the evidence establishes copying of the subject matter of claims 8 and 10 or commercial success of the invention recited in claims 8 and 10.

With regard to copying, the evidence fails to establish that the subject matter of either claim 8 or claim 10 was copied. We note additionally that more than the mere fact of copying is necessary to make that action significant because copying may be attributable to other factors such as a lack of concern for patent property or contempt for the patentee's ability to enforce the patent. See Cable Elec. Prods, Inc. v.

Genmark, Inc., 770 F.2d 1015, 1028, 226 USPQ 881, 889 (Fed. Cir. 1985). Alleged copying is not persuasive of nonobviousness when the copy is not identical to the claimed product, and the other manufacturer had not expended great effort to develop its own solution. See Pentec, Inc. v. Graphic Controls Corp., 776 F.2d 309, 317, 227 USPQ 766, 771 (Fed. Cir. 1985). See also Vandenberg v. Dairy Equip. Co., 740 F.2d 1560, 1567, 224 USPQ 195, 199 (Fed. Cir. 1984)(evidence of copying not found persuasive of nonobviousness) and Panduit Corp. v. Dennison Mfg. Co., 774 F.2d 1082, 1099, 227 USPQ 337, 348-49 (Fed. Cir. 1985), vacated on other grounds, 475 U.S. 809, 229 USPQ 478 (1986), on remand, 1 USPQ2d 1593 (Fed. Cir. 1987)(evidence of copying found persuasive of nonobviousness where admitted infringer failed to satisfactorily produce a solution after ten years of effort and expense).

With regard to commercial success, the evidence does not provide any data concerning the market share of the subject matter of claims 8 and 10. Although the evidence certainly indicates that many dollars have been generated in revenue, it

provides no indication of whether this represents a substantial quantity in this market. Our reviewing court has noted in the past that evidence related solely to the number of units sold provides a very weak showing of commercial success, if any. See In re Huang, 100 F.3d 135, 137, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996); Cable Elec. Prods., Inc. v. Genmark, Inc., 770 F.2d 1015, 1026-27, 226 USPQ 881, 888 (Fed. Cir. 1985) (finding that sales of 5 million units represent a minimal showing of commercial success because "[w]ithout further economic evidence . . . it would be improper to infer that the reported sales represent a substantial share of any definable market"); see also In re Baxter Travenol Lab., 952 F.2d 388, 392, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991) ("[I]nformation solely on numbers of units sold is insufficient to establish commercial success."); Kansas Jack, Inc. v. Kuhn, 719 F.2d 1144, 1151, 219 USPQ 857, 861 (Fed. Cir. 1983) (determination of obviousness not erroneous where evidence of commercial success consisted solely of number of units sold and where no evidence of nexus). On the basis of the limited information provided, we

conclude that the appellant has failed to establish commercial success.

Even assuming that the appellant had sufficiently demonstrated commercial success, that success is relevant in the obviousness context only if it is established that the sales were a direct result of the unique characteristics of the claimed invention, as opposed to other economic and commercial factors unrelated to the quality of the claimed subject matter. See Cable Elec., 770 F.2d at 1027, 226 USPQ at 888. In other words, a nexus is required between the sales and the merits of the claimed invention. In proceedings before the Patent and Trademark Office, an appellant must show that the claimed features were responsible for the commercial success of an article if the evidence of nonobviousness is to be accorded substantial weight. Merely showing that there was commercial success of an article which embodied the invention is not sufficient. See Ex parte Remark, 15 USPQ2d 1498, 1502-03 (Bd. Pat. App. & Inter. 1990). Compare Demaco Corp. v. F. Von Langsdorff Licensing Ltd., 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir.), cert. denied, 488 U.S. 956 (1988). See also Pentec, Inc. v. Graphic Controls Corp., 776 F.2d 309, 227

USPQ 766 (Fed. Cir. 1985) (commercial success may have been attributable to extensive advertising and position as a market leader before the introduction of the patented product); In re Fielder, 471 F.2d 640, 176 USPQ 300 (CCPA 1973) (success of invention could be due to recent changes in related technology or consumer demand; here success of claimed voting ballot could be due to the contemporary drive toward greater use of automated data processing techniques).

The appellant has failed to submit any factual evidence that would demonstrate the required nexus between the claimed invention and the evidence of commercial success. In sum, the appellant simply has not carried his burden to establish that a nexus existed between any commercial success and the novel features claimed in the application (i.e., claims 8 and 10).

In the final analysis, evidence of nonobviousness, although being a factor that certainly must be considered, is not necessarily controlling. See Newell Companies, Inc. v. Kenney Manufacturing Co., 864 F.2d 757, 768, 9 USPQ2d 1417, 1426 (Fed. Cir. 1988).

In view of the foregoing, we are satisfied that when all the evidence and arguments are considered, the evidence of nonobviousness fails to outweigh the evidence of obviousness as in Richardson-Vicks Inc. v. Upjohn Co., 122 F.3d 1476, 44 USPQ2d 1181 (Fed. Cir. 1997) and EWP Corp. v. Reliance Universal, Inc., 755 F.2d 898, 225 USPQ 20 (Fed. Cir. 1985). Accordingly, we sustain the rejections of claims 8 and 10 under 35 U.S.C. § 103 as being unpatentable over Three-In-One.

New grounds of rejection

I. In view of the fact that our rationale for affirming the rejections based on Three-In-One under 35 U.S.C. §§ 102 and 103 is different from that applied by the examiner, we denominate the affirmance of those rejections a new ground of rejection under

37 CFR § 1.196(b).

II. Claims 1 through 4, 8 and 10 are rejected under 35 U.S.C.

§ 103 as being unpatentable over Tripoley.

Claim 1 reads on Tripoley as follows:

A method of including a jackpot component (pay cards of Tripoley) in a live casino table game (poker of Tripoley since poker is a live casino game) comprising the steps of:

(a) a player wagering a first gaming token to participate in the live casino game (each player at the start of each hand in Tripoley must put a chip in the pot),

(b) a player wagering a second gaming token to participate in the jackpot component (each player at the start of each hand in Tripoley must put one chip next to each of the ace, king, queen, jack, ten, the king-queen combination, and the sequence of eight, nine and ten (i.e., the pay cards of Tripoley)),

(c) a dealer dealing a hand of playing cards to the player (the dealer deals the hand to the player),

(d) if the player's hand comprises a predetermined arrangement of cards, the player wins a preselected amount<sup>9</sup> of the jackpot (in the hearts portion (i.e., pay

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<sup>9</sup> In accordance with the appellant's disclosure, the claimed "preselected amount" is readable on 100%. See for example claims 5, 7, 9, 11, 13 and 15.

cards) of Tripoley if the player's hand contains any of the predetermined arrangement of cards (i.e., the ace, king, queen, jack, ten, the king-queen combination, or the sequence of eight, nine and ten), the player wins all the chips associated therewith).

Based on our analysis and review of Tripoley and claims 1 through 4, it is our opinion that the only difference<sup>10</sup> is the limitation that the player wagers a second gaming token to participate in the jackpot component after having wagered a first gaming token to participate in the live casino game. Tripoley only teaches that the wagering to participate in the jackpot component (i.e, hearts/pay cards) and the live casino game (i.e., poker) takes place prior to dealing the hand. Thus, Tripoley is silent as to the relative order of betting.

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<sup>10</sup> After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

With regard to this difference, we reach the conclusion that it would have been prima facie obvious<sup>11</sup> to one of ordinary skill in the art at the time the invention was made to bet the chip for poker prior to betting the chips for hearts/pay cards since the order of betting (placing each players chips in the respective area (e.g., pot, kitty, etc.)) would have been recognized by one of ordinary skill in the art as being a matter of choice for the player.

With regard to claims 8 and 10, we reach the conclusion that it would have been further prima facie obvious to one of ordinary skill in the art at the time the invention was made to modify the poker played in Tripoley to be either (1) lo-ball poker (claim 10) to thereby allow the worst hand to win the pot rather than the best hand; or (2) seven card stud poker (claim 8) instead of five card stud poker when each

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<sup>11</sup> The conclusion of obviousness may be made from "common knowledge and common sense" of the person of ordinary skill in the art (see In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)). Moreover, skill is presumed on the part of those practicing in the art. See In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

player has at least seven cards (i.e., seven or less players).

Having arrived at the conclusion that the teachings of the prior art are sufficient to establish a prima facie case of obviousness, we consider anew the issue of obviousness under 35 U.S.C. § 103, carefully evaluating therewith the objective evidence of nonobviousness supplied by the appellant discussed supra. For the reasons set forth previously, we are satisfied that when all the evidence and arguments are considered, the evidence of nonobviousness fails to outweigh the evidence of obviousness.

#### CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2, 4, 6, 8 and 10 under 35 U.S.C. § 102(b) as being anticipated by Rules of Poker is reversed; the decision of the examiner to reject claims 1 through 4 under 35 U.S.C. § 102(b) as being anticipated by Three-In-One is affirmed, however, for reasons explained supra, we have denominated this affirmance a

new ground of rejection under 37 CFR § 1.196(b); the decision of the examiner to reject claims 1 and 14 under 35 U.S.C. § 102(b) as being anticipated by Big Field is reversed; the decision of the examiner to reject claims 1, 2 and 14 under 35 U.S.C.

§ 102(b) as being anticipated by Pontoon is reversed; the decision of the examiner to reject claim 6 under 35 U.S.C. § 103 as being unpatentable over Three-In-One is reversed; the decision of the examiner to reject claims 8 and 10 under 35 U.S.C. § 103 as being unpatentable over Three-In-One is affirmed, however, for reasons explained supra, we have denominated this affirmance a new ground of rejection under 37 CFR § 1.196(b); and the decision of the examiner to reject claims 1, 2, 4, 6, 8 and 10 under 35 U.S.C. § 103 as being unpatentable over Rules of Poker is reversed. In addition, a new ground of rejection of claims 1 through 4, 8 and 10 under 35 U.S.C. § 103 have been added pursuant to provisions of 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final

rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART; 37 CFR § 1.196(b)

CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JEFFREY V. NASE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
MURRIEL E. CRAWFORD	)	
Administrative Patent Judge	)	

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Application No. 90/003,184 & 90/003,865

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APPEAL NO. 98-0614 - JUDGE NASE  
APPLICATION NO. 90/003,184 &  
90/003,865

APJ NASE

APJ CRAWFORD

APJ FRANKFORT

DECISION: **AFFIRMED-IN-PART,**  
**37 CFR § 1.196(b)**

Prepared By: Gloria

Henderson

**DRAFT TYPED:** 21 Dec 98

**FINAL TYPED:**

**HEARD: 07 Dec 98**

**THREE JUDGE CONF.**