

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 29

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. 99-0019  
Reexamination Control No. 90/003,843<sup>1</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. 5,364,105 issued November 15, 1994. U.S. Patent No. 5,364,105 issued from Application No. 08/078,602, filed June 16, 1993. According to the appellant, that application was a continuation of Application No. 07/800,631, filed November 27, 1991, which was a continuation-in-part of Application No. 07/361,276, filed June 5, 1989, which was a division of Application No. 07/214,934, filed July 5, 1988, which was a continuation-in-part of Application No. 07/182,374, filed April 18, 1988. Request for reexamination filed May 25, 1995.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 1 through 36, which are all the claims pending in this proceeding.

We REVERSE.

BACKGROUND

The appellant's invention relates to a method of progressive jackpot twenty-one. 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>2</sup> (Big Field)

Reference made of record by this panel of the Board is:  
Tripoley, "How to Play," Cadaco, Inc., 1968

Claims 1, 3, 6, 19 and 24 stand rejected under 35 U.S.C.  
§ 102(b) as being anticipated by Rules of Poker.

Claims 1 through 9 and 19 through 26 stand rejected under  
35 U.S.C. § 102(b) as being anticipated by Three-In-One.

Claims 1, 3, 14, 19, 21 and 32 stand rejected under  
35 U.S.C. § 102(b) as being anticipated by Big Field.

Claims 1, 3, 10 through 12, 14 through 17, 19, 21, 28  
through 30 and 32 through 35 stand rejected under 35 U.S.C.  
§ 102(b) as being anticipated by Pontoon.

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<sup>2</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 13, 18, 31 and 36 stand rejected under 35 U.S.C. § 103 as being unpatentable over Big Field in view of Pontoon.

Claims 1, 3, 6, 19, 24 and 27 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 (Paper No. 21, mailed March 27, 1998) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 18, filed January 29, 1998), reply brief (Paper No. 22, filed April 27, 1998) and supplemental reply brief (Paper No. 23, filed August 25, 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 claims 1 and 19 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 card game comprising the steps of:  
(a) a player making a first wager to participate in the live casino table card game;  
(b) a player optionally making a second wager to participate in the jackpot component;

- (c) a dealer dealing a hand of playing cards to the player; and
- (d) if the player's hand comprises a predetermined arrangement of cards, the player wins a predetermined percentage of the jackpot if the player has optionally made the second wager.

Claim 19 recites:

- A method of including a jackpot component in a live casino table card game comprising the steps of:
- (a) a player making a first wager to participate in the live casino table card game;
  - (b) a player optionally making a second wager to participate in the jackpot component;
  - (c) a dealer dealing a hand of playing cards to the player; and
  - (d) if the player's hand consists of a predetermined arrangement of cards, the player wins a predetermined percentage of the jackpot if the player has optionally made the second wager.

The appellant argues in the brief (1) that the method steps must be interpreted pursuant to 35 U.S.C. § 112, sixth paragraph, (p. 6); (2) that the prior art does not meet the required order of steps (pp. 12-14); and (3) the meaning of the phrase "live casino table card game" (pp. 14-18).

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 claims 1 and 19, 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 claims 1 and 19, we conclude that claims 1 and 19 require 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 makes "a **first** wager to participate in the live casino table card game" and optionally makes "a **second** wager to participate in the jackpot component" indicates a specific order; and (3) the recitation in step (d) that if the player's **hand** comprises or consists of "a predetermined arrangement of cards, the player wins a predetermined percentage of the jackpot if the player has optionally made the second wager" indicates that this step is preceded by step (b) (i.e., the step of "optionally making a

second wager to participate in the jackpot component") and 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 card game" means a typical casino or cardroom table card game such as poker or Twenty-One.<sup>3</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 claims 1 and 19, we turn to the rejections raised by the examiner.

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<sup>3</sup> While the patent under reexamination only describes the game Twenty-One, it does refer to U.S. Patent No. 4,861,041, which describes the invention as being applied to a typical casino or cardroom table game such as poker or Twenty-One. See column 1, line 12, to column 2, line 9, of U.S. Patent No. 4,861,041.

**Rejections based upon Rules of Poker**

We will not sustain the rejection of claims 1, 3, 6, 19 and 24 under 35 U.S.C. § 102(b) as being anticipated by Rules of Poker. Likewise, we will not sustain the rejection of claims 1, 3, 6, 19, 24 and 27 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 claims 1 and 19 (brief, pp. 8-11 and 24). In that regard, it is our determination that Rules of Poker does not teach or suggest the following elements of claims 1 and 19 for the reasons set forth by the appellant in the brief: (1) including a jackpot component in a live casino table card game; (2) a player optionally making a second wager to participate in the jackpot component; and (3) if the player's hand comprises or consists of a predetermined arrangement of cards, the player wins a predetermined percentage of the jackpot if the player has optionally made the second wager.

**Rejections based upon Big Field**

We will not sustain the rejection of claims 1, 3, 14, 19, 21 and 32 under 35 U.S.C. § 102(b) as being anticipated by Big Field or the rejection of claims 13, 18, 31 and 36 under 35 U.S.C.

§ 103 as unpatentable over Big Field in view of Pontoon.

We agree with the appellant's argument (brief, pp. 18-19 and reply brief, pp. 4-6) 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>4</sup>

#### **Rejection based upon Pontoon**

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<sup>4</sup> In a reexamination proceeding, only patents and printed publications may be utilized in rejections under 35 U.S.C. § 102 or § 103. 35 U.S.C. §§ 301-303.

We will not sustain the rejection of claims 1, 3, 10 through 12, 14 through 17, 19, 21, 28 through 30 and 32 through 35 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 claims 1 and 19 (brief, pp. 20-21 and supplemental reply brief, pp. 1-4). In that regard, it is our determination that Pontoon does not teach or suggest the following element of claim 1 and 19 for the reasons set forth by the appellant in the brief and supplemental reply brief: a player optionally making a **second** wager to participate in the jackpot component after making a **first** wager to participate in the live casino table card 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 table card game (i.e., Black Jack) and the jackpot component (i.e., the bonus payments).

**Rejection based upon Three-In-One**

We will not sustain the rejection of claims 1 through 9 and 19 through 26 under 35 U.S.C. § 102(b) as being anticipated by Three-In-One.

We agree with the appellant's argument (reply brief, pp. 8-9) that the examiner's application of Three-In-One is barred by the holding in In re Portola Packaging, Inc., 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997). The PTO can reject claims during reexamination when the rejection is supported by a combination of prior art previously before the PTO **and** prior art previously not before the PTO, but not if it is supported only by prior art previously considered by the PTO in relation to the same or broader claims. Portola, 110 F.3d at 791, 42 USPQ2d at 1299. In this case, the only applied prior art (i.e., Three-In-One) was previously before the PTO in the prosecution of the application which resulted in the patent being reexamined.

#### **Consideration of Tripoley, "How to Play"**

In the related appeals identified by the appellant (brief, p. 1), the reference to Tripoley, "How to Play," has

been applied under 35 U.S.C. § 103. This reference to Tripoley, "How to Play," will not be applied to the claims under appeal for the following reasons. It is our view that the broadest reasonable definition of the term "optionally" as used in claims 1 and 19, requires that the optional second wager of step (b) occur in the same hand as steps (a), (c) and (d). Tripoley, "How to Play," requires betting on poker, michigan rummy and the pay cards to participate in the next hand. Thus, Tripoley, "How to Play," does not teach or suggest the optional second wager as recited in claims 1 and 19.

#### CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 3, 6, 19 and 24 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 9 and 19 through 26 under 35 U.S.C.

§ 102(b) as being anticipated by Three-In-One is reversed; the decision of the examiner to reject claims 1, 3, 14, 19, 21 and 32 under 35 U.S.C. § 102(b) as being anticipated by Big Field

is reversed; the decision of the examiner to reject claims 1, 3, 10 through 12, 14 through 17, 19, 21, 28 through 30 and 32 through 35 under 35 U.S.C. § 102(b) as being anticipated by Pontoon is reversed; the decision of the examiner to reject claims 13, 18, 31 and 36 under 35 U.S.C. § 103 as being unpatentable over Big Field in view of Pontoon is reversed; and the decision of the examiner to reject claims 1, 3, 6, 19, 24 and 27 under 35 U.S.C. § 103 as being unpatentable over Rules of Poker is reversed.

REVERSED

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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ROBERT E. PURCELL  
1120 LINCOLN STREET  
SUITE 1500  
DENVER, CO 80203

JANAL M. KALIS  
OPPENHEIMER, WOLFF & DONNELLY  
PLAZA VII, SUITE 3400  
45 SOUTH SEVENTH ST.  
MINNEAPOLIS, MN 55402

APPEAL NO. 99-0019 - JUDGE NASE  
REEXAMINATION NO. 90/003,843

APJ NASE

APJ CRAWFORD

APJ FRANKFORT

DECISION: **REVERSED**

Prepared By: Gloria

Henderson

**DRAFT TYPED:** 21 Dec 98

**FINAL TYPED:**

**HEARD: 07 Dec 98**

**THREE JUDGE CONF.**