

Commissioner's Decision No. 1480

Décision du commissaire n° 1480

TOPICS: 000 Obviousness

SUJETS: 000 Évidence

Application No. 2 464 537

Demande n° 2 464 537

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2 464 537, having been rejected under subsection 30(3) of the *Patent Rules* (SOR/96-423), has consequently been reviewed in accordance with paragraph 30(6)(c) of the *Patent Rules*. The recommendation of the Board and the decision of the Commissioner are to allow the application.

Agent for the Applicant

SMART & BIGGAR

1000 De La Gauchetière Street West
Suite 3300
Montreal, Quebec
H3B 4W5

INTRODUCTION

[1] This recommendation concerns the review of rejected Canadian patent application number 2 464 537 which is entitled “A player insert for a gaming machine, a gaming system and a method of operating a gaming system” and is owned by GTECH GERMANY GMBH (the Applicant). A review of the rejected application has been conducted by the Patent Appeal Board (the Board) pursuant to paragraph 30(6)(c) of the *Patent Rules*. As explained in more detail below, our recommendation to the Commissioner of Patents is to allow the application.

BACKGROUND

The Application

[2] The application, with claimed priority date of April 17, 2003, was filed on April 15, 2004 and was laid open to the public on October 17, 2004.

[3] The application relates to a player tracking module for a gaming machine, also known as a player insert, and concerns the displays for such a module as well as a biometric sensor behind one of the displays.

Prosecution History

[4] On August 3, 2016, a Final Action (FA) was written pursuant to subsection 30(4) of the *Patent Rules*. The FA stated that the instant application was defective on the ground that all of the 30 claims on file were obvious and therefore did not comply with section 28.3 of the *Patent Act*.

[5] In a February 1, 2017 response to the FA (RFA), the Applicant proposed amended claims (the proposed claims) as well as amendments to the title and description. The Applicant also submitted arguments in favor of the non-obviousness of the claims on file as well as arguments in support of the proposed claims.

- [6] The Examiner considered the application not to comply with the *Patent Act* and *Patent Rules* despite the arguments and proposed amendments submitted with the RFA. Therefore, pursuant to paragraph 30(6)(c) of the *Patent Rules*, the application was forwarded to the Board for review on March 30, 2017 along with an explanation outlined in a Summary of Reasons (SOR). The SOR set out the position that the claims on file were still considered to be defective due to obviousness. The SOR further explained that the amendments proposed in the RFA did not overcome this defect.
- [7] In a letter dated April 3, 2017, the Board forwarded to the Applicant a copy of the SOR and offered the Applicant the opportunity to either indicate continued interest in having the application reviewed or to withdraw the application. The Applicant did not respond.
- [8] The present panel (the Panel) was formed to review the instant application under paragraph 30(6)(c) of the *Patent Rules*.

ISSUE

- [9] The issue to be addressed by the present review is whether claims 1 to 30 on file would have been obvious.
- [10] If the claims on file are considered defective, we may turn to the proposed claims 1 to 31 and consider whether they constitute amendments necessary for compliance with the *Patent Act* and *Patent Rules*.

LEGAL PRINCIPLES AND OFFICE PRACTICE

Purposive construction

- [11] In accordance with *Free World Trust v Électro Santé Inc*, 2000 SCC 66 [*Free World Trust*], essential elements are identified through a purposive construction of the claims done by considering the whole of the disclosure, including the specification and drawings

(see also *Whirlpool v Camco*, 2000 SCC 67 at paras 49(f) and (g) and 52). In accordance with the *Manual of Patent Office Practice* (CIPO) at §13.05, revised June 2015 [*MOPOP*], the first step of purposive claim construction is to identify the skilled person and his or her relevant common general knowledge (CGK). The next step is to identify the problem addressed by the inventors and the solution put forth in the application. Essential elements can then be identified as those required to achieve the disclosed solution as claimed.

Obviousness

[12] The *Patent Act* requires that the subject matter of a claim not be obvious to a person skilled in the art. Section 28.3 of the *Patent Act* provides:

28.3 The subject matter defined by a claim in an application for a patent in Canada must be subject matter that would not have been obvious on the claim date to a person skilled in the art or science to which it pertains, having regard to

- (a) information disclosed more than one year before the filing date by the applicant, or by a person who obtained knowledge, directly or indirectly, from the applicant in such a manner that the information became available to the public in Canada or elsewhere; and
- (b) information disclosed before the claim date by a person not mentioned in paragraph (a) in such a manner that the information became available to the public in Canada or elsewhere.

[13] In *Apotex Inc v Sanofi-Synthelabo Canada Inc*, 2008 SCC 61 at paragraph 67 [*Sanofi*], the Supreme Court of Canada stated that it is useful in an obviousness inquiry to use the following four-step approach:

- (1) (a) Identify the notional “person skilled in the art”;
- (b) Identify the relevant common general knowledge of that person;
- (2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;
- (3) Identify what, if any, differences exist between the matter cited as forming part of the “state of the art” and the inventive concept of the claim or the claim as construed;
- (4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

ANALYSIS

Purposive Construction

[14] In the present case, there was no issue with respect to whether or not any of the features of the claims are non-essential. We consider all features of the claims as being essential elements. The Panel construes “biometric sensor” to include a camera or fingerprint sensor, as these were the examples given in the description at page 4. Further, this construction is consistent with the fact that dependent claim 6 specifies the biometric sensor as a camera.

Obviousness

[15] We analyze claim 1, the sole independent claim, according to *Sanofi*.

(1)(a) Identify the notional “person skilled in the art”

[16] The FA defined the person skilled in the art (PSA) as a person or team consisting of gaming machine designers familiar with the design of hardware terminals and corresponding software functions of such a gaming machine, working in collaboration with computer scientists or other computer-related technologists. The Applicant, in the RFA, did not dispute this definition and we adopt it for this review.

(1)(b) Identify the relevant common general knowledge of that person

[17] The FA identified the relevant common general knowledge (CGK) of the PSA:

The skilled person has knowledge of the gaming features deployed in the gaming industry such as the casino environment and networked gaming etc., including programming, communication protocols and user interfaces. The skilled person is also familiar with general purpose computer hardware and general purpose computer programming techniques.

[18] In the RFA, the Applicant did not dispute this identification of the CGK and we adopt it for this review.

(2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it

[19] The FA stated the inventive concept of claim 1 as:

A player tracking module for a gaming machine comprising the following features:

- 1) An electronically controllable screen operable in a first state in which it is transparent and in a second state in which it is adapted to function as a display;
- 2) a controller coupled to said screen and configured to control it to display images, when it is in the second state;
- 3) a separate display provided behind the said screen and visible to a player, when said screen is in the first state; and
- 4) a biometric sensor disposed behind said screen and adapted to read biometric data of a player through said screen, when said screen is in the first state.

[20] In the RFA, the Applicant did not dispute this identification of the inventive concept of claim 1.

[21] While we generally agree with the above identification of the inventive concept of the FA, in our view, an additional element of claim 1 forms part of the inventive concept:

- The separate display is under common control with the electronically controllable screen.

(3) Identify what if any differences exist between the matter cited as forming part of the “state of the art” and the inventive concept of the claim or the claim as construed

[22] The FA and SOR cited the following prior art:

D1:	US20030054878	Benoy et al	March 20, 2003
D2:	WO99/32945	Basturk et al	July 1, 1999
D3:	US20020173354	Winans et al	November 21, 2002
D4:	JPH8080364	Niiyama et al	March 26, 1996
D5:	EP0493893	Gitlin et al	July 8, 1992
D6:	US4400725	Tanigaki	August 23, 1983
D7:	EP0385128	Skow	September 5, 1990

[23] D1 discloses a player tracking module having a display and biometric sensor. D2 concerns a watch face having an electronic display with a transparent state overlaid over mechanical watch dials. D3 concerns the use of electro-luminescent displays for a gaming. D4 discloses a gaming machine having a liquid crystal display panel over the reels, the display panel having a selectively applied transparent state. D5-D7 disclose the use of cameras behind display screens for videoconferencing.

[24] The Examiner applied D1 and D4 in the FA and also considered D5-D7 in the SOR. The Panel also considered D2 and D3.

[25] D1 appears to be the closest prior art. With reference to the inventive concept above, D1 discloses:

- a player tracking module for a gaming machine (D1 para 0015 and Fig. 4B);
- an electronically controllable screen operable in a first state in which it is transparent and in a second state in which it is adapted to function as a display (D1 para 0093 discloses a display screen on a player tracking module: i.e. a display with one state, but does not disclose a transparent state);
- a controller coupled to said screen and configured to control it to display images, when it is in the second state (implicit in D1 para 0093); and
- a biometric sensor disposed behind said screen and adapted to read biometric data of a player through said screen, when said screen is in the first state (D1 para 0100 and Figure 4B disclose a camera as biometric sensor in a player tracking module but do not disclose an ability to read through the screen).

[26] The differences between the inventive concept and D1 are therefore:

- the electronically controllable screen having another state in which it is transparent;
- a separate display provided behind the said screen and visible to a player, when said screen is in the first state;
- the separate display is under common control with the electronically controllable screen; and

- the biometric sensor disposed behind said screen and adapted to read biometric data of a player through said screen, when said screen is in the first state.

(4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

- [27] In an analogous art (a gaming machine, but not a player tracking module within such a gaming machine), D4 discloses a screen having transparent and opaque states (abstract). D4 mentions an example of the screen becoming opaque (abstract) or displaying crossed lines (depicted in Fig. 8). D4 further discloses a separate display behind the screen essentially only viewable when the screen is in the transparent state (abstract; Fig. 8). In the device of D4, the separate display is the mechanical readout reels of the gaming machine and is not electronically controlled in common with the screen.
- [28] In our view, the dual displays of D4 combined with the player tracking module of D1 do not lead directly and without difficulty to the inventive concept of instant claim 1. It would not have been obvious to the PSA to modify a player tracking module, as in D1, to include a separate display behind the screen and apply a transparent mode of such primary display, as in D4, to the player tracking module wherein gaming reels, visible through the screen of D4 in the transparent state, are substituted by a separate electronic display when in the transparent state. Further, the mechanical gaming reels of D4 do not appear to be under common electronic control with the primary display of D4. Also, D1 depicts a camera at the surface of the front panel, not behind an electronic screen. D4 is silent regarding a biometric sensor and its placement.
- [29] D5-D7, in the art of videoconferencing, disclose the placement of a camera behind an electronic screen and use of the camera when the screen is in a transparent state. In all of D5-D7, however, the transparent and display states are rapidly alternated so as to provide the appearance of continuous display and continuous use of the camera to a user when videoconferencing. These rapidly multiplexed states are not closely analogous to the switching of states in the instant invention. In the instant invention, there is a distinct

perceived state wherein a user sees the primary display screen to view one image, and another distinct state wherein the user sees the secondary display, under common electronic control with the primary screen. Further, in the instant invention, a biometric sensor operates under the state switching conditions.

[30] In our view, it would not be obvious to the PSA to use the transparent state of the screen of D4 to reveal a coordinated secondary display behind the screen and to simultaneously enable a biometric sensor to be placed behind the screen as disclosed by D5-D7 without the rapid multiplexing. The inventive concept involves a synergistic use of the transparent state under common electronic control to both reveal a separate display and at the same time to enable operation of a biometric sensor. This does not follow directly from a combination of the applied prior art and the CGK.

[31] We did not find anything in D2 or D3 which would obviously lead the PSA from D1 to the instant invention.

[32] Dependent claims 2-30 on file are considered to have been non-obvious as they share at least the inventive concept of claim 1.

CONCLUSIONS

[33] We have determined that the subject matter defined by claims 1-30 on file would not have been obvious to the PSA. Thus, in our view, these claims comply with section 28.3 of the *Patent Act*.

RECOMMENDATION OF THE BOARD

[34] For the reasons set out above, we are of the view that the rejection is not justified on the basis of the defect indicated in the Final Action notice and we have reasonable grounds to believe that the instant application complies with the *Patent Act* and the *Patent Rules*. We recommend that the Applicant be notified in accordance with subsection 30(6.2) of the *Patent Rules* that the rejection of the instant application is withdrawn and that the instant application has been found allowable.

[35] As we consider the application on file to be allowable, we have neither reviewed the proposed claims nor the proposed amendments to the title and description. We note that these proposed amendments are considered not to have been made.

Howard Sandler
Member

Nenad Jevtic
Member

Stephen MacNeil
Member

DECISION

[36] I concur with the findings and the recommendation of the Board. In accordance with subsection 30(6.2) of the *Patent Rules*, I hereby notify the Applicant that the rejection of the instant application is withdrawn, the instant application has been found allowable and I will direct my officials to issue a Notice of Allowance in due course.

Johanne Bélisle
Commissioner of Patents

Dated at Gatineau, Quebec,

this 18th day of March, 2019