Citation: Novomatic AG (Re), 2021 CACP52
Commissioner's Decision #1605
Décision du Commissaire n^{o}1605
Date: 2021-12-14

TOPIC:	J-00	Meaning of Art
	J-10	Computer Programs
	J-30	Games
	J-50	Mere Plan
SUJET:	J-00	Signification de la technique
	J-10	Programmes d'ordinateur
	J-30	Jeux
	J-50	Simple plan

Application No. : 2,823,991

Demande nº 2 823 991

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2,823,991, having been rejected under subsection 30(3) of the *Patent Rules*, as they read immediately before October 30, 2019 (former *Patent Rules*), consequently has been reviewed in accordance with paragraph 199(3)(c) of the *Patent Rules* (SOR/2019-251). The recommendation of the Patent Appeal Board and the decision of the Commissioner are to refuse the application.

Agent for the Applicant:

BORDEN LADNER GERVAIS LLP
World Exchange Plaza
100 Queen Street, Suite 1300
Ottawa, ON K1P 1J9

INTRODUCTION

[1] This recommendation concerns the review of rejected patent application number 2,823,991, which is entitled “Gaming Machine, System and Method for Playing a Feature Game.” The patent application is owned by Novomatic AG (the Applicant). The Patent Appeal Board (the Board) has reviewed the rejected application pursuant to paragraph 199(3)(c) of the *Patent Rules*. The outstanding defect to be addressed in this review is whether the claims define patentable subject matter. As explained below, my recommendation is to refuse the application.

BACKGROUND

The Application

[2] The instant application, based on a previously filed Patent Cooperation Treaty application, is considered to have been filed in Canada on January 24, 2012 and was laid open to the public on August 2, 2012.

[3] The instant application relates to games played on gaming machines. More specifically, it relates to a machine, system, and method for playing a feature game that allows a multiplier for increasing the payout of the bet.

Prosecution History

[4] On July 3, 2018, a Final Action (FA) was written pursuant to subsection 30(4) of the former *Patent Rules*. The FA explained that the application was defective on the ground that claims 1-19 (claims on file) were directed to non-statutory subject matter and therefore do not comply with section 2 of the *Patent Act.*

[5] In a January 3, 2019 response to the FA (RFA), the Applicant submitted arguments for the allowance of the claims on file. The Applicant also submitted a set of proposed claims (proposed claims).

[6] As the Examiner considered the application still did not comply with the *Patent Act* and *Patent Rules*, the application was forwarded to the Board for review pursuant to subsection 30(6) of the former *Patent Rules*, along with an explanation outlined in a Summary of Reasons (SOR) for maintaining the rejection of the application.

[7] In a letter dated April 29, 2019, the Board forwarded a copy of the SOR to the Applicant. On July 10, 2019, in its response to the SOR, the Applicant indicated a continued interest in having the Board review the application.

[8] The undersigned was assigned to review the application under paragraph 199(3)(c) of the former *Patent Rules* and to make a recommendation to the Commissioner as to its disposition. In a Preliminary Review (PR) letter dated September 14, 2021, I set out my preliminary analysis and rationale as to why, based on the written record, the subject matter of the claims on file is unpatentable, both falling outside section 2 of the *Patent Act* and prohibited by subsection 27(8) of the *Patent Act*. The PR letter offered the Applicant the opportunities to attend an oral hearing and to make further submissions.

[9] The Applicant did not respond to the PR letter.

ISSUE

[10] The issue to be addressed by this review is whether the subject matter of the claims on file is prohibited under subsection 27(8) of the *Patent Act* and the subject matter of the claims on file is not patentable subject matter and falls outside the definition of “invention” in section 2 of the *Patent Act*.

[11] I also consider the proposed claims.

LEGAL PRINCIPLES AND PATENT OFFICE PRACTICE

Purposive Construction

[12] In accordance with *Free World Trust v Électro Santé Inc*, 2000 SCC 66 and *Whirlpool Corp v Camco Inc*, 2000 SCC 67, purposive construction is performed from the point of view of the person skilled in the art in light of the relevant common general knowledge (CGK), considering the whole of the disclosure including the specification and drawings. In addition to interpreting the meaning of the terms of a claim, purposive construction distinguishes the essential elements of the claim from the non-essential elements. Whether or not an element is essential depends on the intent expressed in or inferred from the claim, and on whether it would have been obvious to the skilled person that a variant has a material effect upon the way the invention works.

[13] "Patentable subject matter under the *Patent Act*" (CIPO, November 2020) [*PN2020–04*] also discusses the application of these principles, pointing out that all elements set out in a claim are presumed essential unless it is established otherwise or such presumption is contrary to the claim language.

Patentable Subject Matter

[14] The definition of invention is set out in section 2 of the *Patent Act*:

> ***invention*** means any new and useful art, process, machine, manufacture or composition of matter, or any new and useful improvement in any art, process, machine, manufacture or composition of matter.

[15] Subsection 27(8) of the *Patent Act* also prescribes that:

> No patent shall be granted for any mere scientific principle or abstract theorem.

[16] *PN2020-04* describes the Patent Office's approach to determining if a claim is patentable subject matter:

> To be both patentable subject-matter and not be prohibited under subsection 27(8) of the *Patent Act*, the subject-matter defined by a claim must be limited to or narrower than an actual invention that either has physical existence or manifests a discernible physical effect or change and that relates to the manual or productive arts, meaning those arts involving or concerned with applied and industrial sciences as distinguished in particular from the fine arts or works of art that are inventive only in an artistic or aesthetic sense.

[17] In *Schlumberger Canada Ltd v Commissioner of Patents*, [1982] 1 FC 845 (CA) [*Schlumberger*], the court concluded that, although computers were necessary for the invention to be put into practice, the computer did not form part of "what has been discovered" and thus was not relevant in determining whether the claimed invention was patentable subject matter; the computer was merely being used to make the kind of calculations it was invented to make.

[18] *PN2020–04* further describes the Patent Office's approach to determining if a computer-related invention is patentable subject matter. For example, the mere fact that a computer is among the essential elements of the claimed invention does not necessarily mean that the claimed invention is patentable subject matter. An algorithm itself is abstract and unpatentable subject matter. A computer

programmed to merely process the algorithm in a well-known manner without solving any problem in the functioning of the computer will not make it patentable subject matter because the computer and the algorithm do not form part of a single actual invention that solves a problem related to the manual or productive arts. On the other hand, if processing the algorithm improves the functionality of the computer, then the computer and the algorithm would together form a single actual invention that solves a problem related to the manual or productive arts and the subject matter defined by the claim would be patentable.

ANALYSIS

[19] I note that since the Applicant did not respond to the PR Letter, the preliminary views presented in the PR Letter are considered to not be disputed. My recommendation below therefore provides an overview of my analysis and rationale presented in the PR Letter.

Purposive Construction

The Skilled Person and the Relevant CGK

[20] As for the identification of the skilled person, in the PR letter it was stated:

> [t]he FA at page 2 characterized the skilled person as:
>
> > [t]he skilled person or persons may consist of information technology engineers familiar with the design of gaming machines connected through a data network.

[21] As for the identification of the CGK, in the PR letter I stated:

> The FA at page 2 characterized the skilled person as:
>
> > The skilled person or persons may consist of information technology engineers familiar with the design of gaming machines connected through a data network.
> >
> > …
> >
> > I [also] preliminarily identify the relevant CGK as including:
> >
> > > the knowledge that gaming machines use an array of symbols for both primary and bonus game play, and that the game play can be triggered by a particular event and through the use of scatter symbols;

> the design, implementation, operation and maintenance of gaming machines, controllers, servers, networks and software; and
>
> the design, implementation, operation and maintenance of computer systems, networks and software, including:
>
> > general purpose and special purpose computers, computing devices, input and output devices, processors, and user interfaces;
> >
> > computer hardware and computer programming techniques; and
> >
> > computer network and internet technologies and protocols.
>
> I base this identification on the definition of the skilled person previously presented. It is supported by the application's description of what is typical in the field (paras [0004]-[0005]) and by the amount of detail in the present application concerning the implementation of the proposed system for playing a feature game that allows a multiplier for increasing the payout of the bet. The level of detail suggests that such implementation must be within the grasp of the skilled person and thus not in need of further explanation.

[22] I adopt these characterizations in this review.

The Essential Elements of the Claims

[23] The instant application includes 19 claims on file. Claim 1 is directed to a gaming machine for playing a feature game that allows a multiplier for increasing the payout of the bet by a set amount and termination of the feature game. Claim 7 is directed to a system for gaming with an upper and lower display with the feature game of claim 1 and claim 13 is directed to a method of playing the feature game of claim 1. Dependent claims 2-6, 8-12, and 14-19 recite refinements of the independent claim steps and define additional features of the gaming system. I consider independent claim 1 as representative of the invention:

> 1. A gaming machine comprising:
>
> a housing;
>
> a game display, and a game controller arranged to control images displayed on the game display, the game controller being arranged to play a game in normal game play mode wherein a plurality of symbols are randomly selected from a predetermined set of symbols and displayed on the game display;

> the game controller initiates a feature game mode if a scatter symbol is displayed, the feature game mode being characterized in that the game controller is programmed to:
>
> > determine a set of feature game symbols, the set of feature games symbols containing at least one switchable symbol that has a first state and a second state, wherein the at least one switchable symbol in the second state is highlighted by illumination, the switchable symbol enables a multiplier after being randomly selected in the first state;
> >
> > the set of feature games symbols containing at least one switching symbol, that switches the switchable symbol between the first state and the second state, but enables the multiplier to persist during normal game play mode, the switching symbol being a symbol other than the switchable symbol;
> >
> > randomly select one symbol from the set of feature game symbols; and
> >
> > determine whether the randomly selected feature game symbol is the at least one switchable symbol in the second state and when the at least one switchable symbol is in the second state, feature game play mode terminates.

[24] In the PR Letter, I considered all the computer-implemented method steps identified in the representative claim 1 to be essential, including the computer-implemented components that are used for carrying out these method steps as recited in the system claims:

> Considering the representative claim 1, and the whole of the specification, the person skilled in the art would understand that there is no use of language indicating that any of the steps in each claim are optional, a preferred embodiment or one of a list of alternatives. Nor is there any indication on the record that would lead to a determination of any claimed elements being non-essential. Therefore, in my preliminary view, all the gaming machine components and the steps carried out by the gaming machine identified in the representative claim 1 are considered to be essential. The gaming machine method steps as recited in the corresponding method claims and the system components recited in the system claims are also considered essential.
>
> Dependent claims 3-6, 8-12, and 14-19 recite further data display options and data calculations. These features are considered essential. Claims 2 and 7 recite the use of an upper and a lower display, this feature is also considered essential.

[25] I maintain this identification of the essential elements in this recommendation.

Patentable Subject Matter

[26] As stated in the PR Letter:

> According to representative claim 1 and the specification, it appears that the invention is directed to game play that comprises randomly selecting a plurality of symbols in normal game play mode, initiating a feature game mode when a scatter symbol is displayed, the feature game mode containing feature game symbols containing a switchable symbol that is able to be in two states, the switchable symbol enabling a multiplier when randomly selected in the first state, a switching symbol that can change the state of the switchable symbol to a second state which terminates the feature game play mode.
>
> In my preliminary view, all these essential steps of representative claim 1 cooperate together to form a system for a feature game that allows a multiplier for increasing the payout of the bet by a set amount and termination of the feature game. Together, these steps represent the computer implementation of an abstract idea, theorem, or scheme for playing a game of symbols.
>
> I also note that at pages 10-11 of the RFA, the Applicant stated that
>
> > As previously submitted, the problem of how to provide better and more interesting gaming machine games and features, while at the same time making the gaming experience user-friendly to enable a player to readily understand the various gaming features, is addressed by the claimed solution which requires, as part of a combination with the specific technological and game features defined by the claims, the use of a switchable symbol having a first and a second state, wherein when in the second state the switchable symbol is highlighted by illumination. Technical details of how such feature is accomplished are taught in the description including at least para. 0074, and in various embodiments, the technical details of how the switchable symbol illumination is achieved depends on the nature of the display used, and again the description provides detail in this regard, at least at para's 0021, 0025, 0028 & 0049. Thus, the claimed solution employs technical features directed specifically to address the problem both of how to provide better and more interesting gaming machine games and features, and at the same to make the gaming experience user-friendly to enable a player to readily understand the various gaming features.
>
> According to *PN2020-04*, "[i]f a computer is merely used in a well-known manner, the use of the computer will not be sufficient to render the disembodied idea, scientific principle or abstract theorem patentable subject-matter and outside the prohibition under subsection 27(8) of the *Patent Act*."
>
> As explained in *Canada (Attorney General) v Amazon.com, Inc*, 2011 FCA 328 (paras 61–63, 66, 69), a computer cannot be used to give an abstract idea a practical application satisfying the physicality requirement implicit in the definition of

> invention in section 2 of the *Patent Act* simply by programming the idea into the computer by means of an algorithm. This is the situation in *Schlumberger* at 205–206, where the computer was merely being used to make the kind of calculations it was invented to make.
>
> In my view, this is the situation for representative claim 1, where the abstract theorem is implemented on the computer, but the computer is merely used in a well known manner, does not form a single actual invention with the abstract theorem and thus does not render the theorem patentable subject matter. The computer is merely being used to make the kind of calculations and data manipulation that it was invented to make. The gaming machine referenced in the application is considered a well known computer, it is performing it's intended calculations and data manipulation. The paragraphs referenced in the RFA ([0021], [0025], [0028], [0049]) describe well-known gaming machines and their related hardware capabilities. Paragraph [0074] describes the rules of the game and their resulting displays that are programmed into the gaming machine for the claimed invention. There is no new hardware in the claimed invention.
>
> In my view, the computer is also merely being used to make the kind of calculations and data manipulation that it was invented to make for dependent claims 3-6, 8-12, and 14-19 which recite further data display options and calculations.
>
> Claims 2 and 7 present the use of an upper and a lower display. This feature is also considered to be a part of a well-known computer and it is being used in it's intended manner.
>
> Accordingly, the abstract scheme for playing a feature game that allows a multiplier for increasing the payout of the bet has no physical existence itself and does not manifest a physical effect or change. Nor does the use of the computer in this case cause it to meet the physicality requirement. Thus, in my preliminary view, the subject matter of representative claim 1, representing claims 1-19, is prohibited under subsection 27(8) of the *Patent Act* and the subject matter of representative claim 1, representing claims 1-19, is not patentable subject matter as it falls outside the definition of "invention" in section 2 of the *Patent Act*.

[27] I maintain my view that the subject matter of claims 1-19 is prohibited under subsection 27(8) of the *Patent Act* and the subject matter of claims 1-19 is not directed to patentable subject matter as it falls outside the definition of "invention" in section 2 of the *Patent Act*.

Proposed Claims

[28] As stated above, the Applicant submitted in the RFA, proposed claims 1-18 in an attempt to overcome the defect identified in the FA. From the claims on file, the

proposed claims were amended to include the display of a rotatable graphic on the first display and related features. Original claims 13-19 were cancelled. New claims 13-18 were added as dependent claims.

[29] As in the PR letter, I maintain that the essential elements of representative claim 1 are all the features of the claim:

> Similar to the claims on file, I consider independent proposed claim 1 as representative of the proposed claims. It is directed to a gaming machine comprising a feature game that allows a multiplier for increasing the payout of the bet by a set amount and termination of the feature game. Proposed claim 7 is directed to the system of claim 1. The amendments were made in relation to the claims on file and they are underlined in the claim presentation below:
>
> 1. A gaming machine comprising:
>
> a housing;
>
> a game display comprising a first display and a second display; and
>
> a game controller arranged to control images displayed on the game display, the game controller being arranged to play a game in a normal game play mode wherein a plurality of symbols are randomly selected from a predetermined set of symbols and displayed on the game display, the game controller being arranged to initiate a feature game mode if a scatter symbol is displayed, the feature game mode being characterized in that the game controller is programmed to:
>
> determine a set of feature game symbols, the set of feature game symbols containing at least one switchable symbol that has a first state and a second state, wherein the at least one switchable symbol in the second state is highlighted by illumination, the switchable symbol enables a multiplier after being randomly selected in the first state, the set of feature game symbols further containing at least one switching symbol, that switches the switchable symbol between the first state and the second state, but enables the multiplier to persist during normal game play mode, the switching symbol being a symbol other than the switchable symbol;
>
> display on the first display a rotatable graphic comprising the set of feature game symbols and a pointer to point at one of the feature game symbols, and to display on the second display a portion of a landscape, wherein at least some of the set of feature game symbols are displayed on the second display, and wherein the portion of the landscape corresponds to a view in a direction indicated by the pointer;

> randomly select one symbol from the set of feature game symbols, comprising, in the first display, rotating a portion of the rotatable graphic to cause the pointer to point at the selected feature game symbol while, in the second display, panning the portion of the landscape laterally responsive to the rotating of the portion of the rotatable graphic; and
>
> determine whether the randomly selected feature game symbol is the at least one switchable symbol in the second state and when the at least one switchable symbol is in the second state, feature game play mode terminates.

In view of the amendments made in the representative proposed claim 1, and the whole of the specification, the person skilled in the art would understand that there is no use of language indicating that any of the steps in each claim are optional, a preferred embodiment or one of a list of alternatives. Nor is there any indication in the record before us that would lead to a determination of any claimed elements being non-essential. Therefore, in my preliminary view, all the computer-implemented method steps identified in the representative proposed claim 1 are considered to be essential, including the computer-implemented components that are used for carrying out these method steps as recited in the corresponding proposed system claims.

Dependent claims 2-6 and 8-18 recite further data display options and data calculations. These features are considered essential.

[30] Regarding patentable subject matter of the proposed claims, as stated in the PR letter,

> With the amendments made in the representative proposed claim 1, and in view of the whole of the specification, it appears that the invention is unchanged and is directed to playing a feature game that allows a multiplier for increasing the payout of the bet by a set amount and termination of the feature game. As stated above, the amendments add in the feature of two displays or display areas and rotating graphics on the displays.
>
> In my preliminary view, similar to the claims on file, the essential steps of representative proposed claim 1 cooperate together to form a system for playing a feature game that allows a multiplier for increasing the payout of the bet by a set amount and termination of the feature game. Together, these steps represent the computer implementation of an abstract idea, theorem, or scheme for playing a game of symbols.
>
> In my preliminary view, the proposed claimed features are to be used on existing and widely available gaming machines. In my view, representative proposed claim 1 is an abstract theorem that is implemented on the computer, but the computer is merely used in a well known manner, does not form a single actual invention with

> the abstract theorem and thus does not render the theorem patentable subject matter. The computer is merely being used to make the kind of calculations it was invented to make, manipulate data the way it was intended, as well as display those manipulations and calculations.
>
> In my view, the gaming machine is merely being used to make the kind of calculations and data manipulation that it was invented to make for dependent claims 2-6 and 8-18.
>
> Accordingly, the abstract scheme for playing a feature game that allows a multiplier for increasing the payout of the bet has no physical existence itself and does not manifest a physical effect or change. Nor does the use of the computer in this case cause it to meet the physicality requirement. Thus, in my preliminary view, the actual invention of representative proposed claim 1, representing proposed claims 1-18, is prohibited under subsection 27(8) of the *Patent Act* and the subject matter of representative proposed claim 1, representing proposed claims 1-18, is not patentable subject matter as it falls outside the definition of “invention” in section 2 of the *Patent Act*.

[31] I maintain this analysis in this recommendation. Accordingly, I consider that the subject matter of proposed claims 1-18 is prohibited under subsection 27(8) of the *Patent Act* and the subject matter of claims 1-18 is not directed to patentable subject matter as it falls outside the definition of “invention” in section 2 of the *Patent Act*. It follows that the proposed claims are not considered a necessary amendment under subsection 86(11) of the *Patent Rules*.

RECOMMENDATION OF THE BOARD

[32] In view of the above, I recommend that the application be refused on the basis that the subject matter of the claims on file is prohibited under subsection 27(8) of the *Patent Act* and the subject matter of the claims on file is not patentable subject matter as it falls outside the definition of “invention” in section 2 of the *Patent Act.*

Mara Gravelle

Member

DECISION OF THE COMMISSIONER

[33] I concur with the findings of the Board and its recommendation to refuse the application on the basis that the claims on file are prohibited under subsection 27(8) of the *Patent Act* and the subject matter of the claims on file is not patentable subject matter as it falls outside the definition of “invention” in section 2 of the *Patent Act*.

[34] Accordingly, I refuse to grant a patent for this application. Under section 41 of the *Patent Act,* the Applicant has six months to appeal my decision to the Federal Court of Canada.

Virginie Ethier
Assistant Commissioner of Patents

Dated at Gatineau, Quebec

this 14th, day of December, 2021