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Commissioner's Decision #1668

Décision du commissaire n° 1668

Date: 2024-05-15

TOPIC: A20 Application for Patent—Double patenting
B00 Claims—Ambiguity or Indefiniteness (incomplete)
J00 Subject Matter of Applications—Meaning of Art
O00 Obviousness

SUJET : A20 Demande de brevet—Double brevet
B00 Revendications—Caractère ambigu or indéfini (incomplet)
J00 Objet des demandes—Signification de la technique
O00 Évidence

Application No. 2558675

Demande n° 2 558 675

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2,558,675, having been rejected under subsection 30(3) of the *Patent Rules* (SOR/96–423) (“former *Rules*”), has subsequently been reviewed in accordance with paragraph 199(3)(c) of the *Patent Rules* (SOR/2019–251) (“*Patent Rules*”). The recommendation of the Patent Appeal Board and the decision of the Commissioner are to refuse the application.

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INTRODUCTION

[1] This recommendation concerns the review of rejected patent application number 2,558,675, which is entitled “COMPUTER GRAPHICS PROCESSING AND SYSTEM FOR DISPLAYING WAGERING INFORMATION FOR DYNAMIC FINANCIAL MARKET INDICATORS” and is owned by CANTOR INDEX LLC (“the Applicant”). The Patent Appeal Board (“the Board”) reviewed the rejected application pursuant to paragraph 199(3)(c) of the *Patent Rules*. As explained below, the Board’s recommendation is that the Commissioner of Patents refuse the application.

BACKGROUND

The application

- [2] Canadian patent application 2,558,675, based on a previously filed Patent Cooperation Treaty application, has a filing date of March 4, 2005, and was laid open to public inspection on October 6, 2005.
- [3] The instant application relates to a method for displaying a betting opportunity. More specifically, the method comprises displaying a market betting line, a high betting line, a low betting line, and two betting icons associated with each of the market betting line, the high betting line, and the low betting line.

Prosecution history

- [4] On October 10, 2017, a Final Action (“FA”) was issued pursuant to subsection 30(3) of the former *Rules*. The FA indicated that the application is defective on the grounds that claims 1 to 21 on file are directed to subject-matter that lies outside the definition of “invention” and do not comply with section 2 of the *Patent Act*, and that claims 1 to 21 on file would have been obvious and do not comply with section 28.3 of the *Patent Act*.

- [5] On April 8, 2019, a response to the FA (“R-FA”) was filed by the Applicant. In the R-FA, the Applicant proposed a new set of claims 1 to 19 (“proposed claim set-1”) and argued that the claims complied with the *Patent Act*.
- [6] Since the subject-matter analysis in the FA was based on an earlier Office Practice, the Examiner reassessed the claimed subject-matter in light of the updated Office Practice in accordance with “Patentable Subject-Matter under the *Patent Act*” (CIPO, November 2020) [PN2020–04] in a Summary of Reasons (“SOR”). As a result, the SOR concluded that the claims on file and proposed claim set-1 were not directed to patentable subject-matter and did not comply with section 2 and subsection 27(8) of the *Patent Act*. Additionally, the SOR considered that proposed claim set-1 did not overcome the obviousness defect in the claims on file. Consequently, the application was forwarded to the Board on March 26, 2021, for review on behalf of the Commissioner of Patents.
- [7] On March 31, 2021, the Board forwarded a copy of the SOR to the Applicant and requested that the Applicant confirm their continued interest in having the application reviewed.
- [8] In a response to the SOR dated January 4, 2022 (“R-SOR”), the Applicant confirmed their continued interest in having the application reviewed. In the R-SOR, the Applicant submitted a second set of proposed claims 1 to 19 (“proposed claim set-2”) in an effort to overcome the defects identified in the SOR.
- [9] In a preliminary review letter dated January 22, 2024 (“PR letter”), the undersigned Panel (“the Panel”) presented its preliminary analysis and rationale, including a notification under 86(9) of the *Patent Rules* and identification of further defects. In summary, the PR letter preliminarily considers that:
- Claims 1 to 21 on file are directed to non-patentable subject-matter and do not comply with section 2 and subsection 27(8) of the *Patent Act*;
 - Claims 1 to 21 on file would not have been obvious and do comply with section 28.3 of the *Patent Act*;

- Claim 1 on file is indefinite and does not comply with subsection 27(4) of the *Patent Act*;
- Claims 2, 3, 12, 13, and 21 on file are not patentably distinct from claims 30 and 35 of Canadian patent 2,661,630C (“the ‘630 patent”) and are therefore defective due to obviousness double-patenting; and
- Proposed claim set-2 contains non-patentable subject-matter and indefiniteness defects, and cannot be considered a “necessary” amendment under subsection 86(11) of the *Patent Rules*.

[10] The PR letter also offered the Applicant the opportunities to make written submissions and attend an oral hearing.

[11] In a letter dated February 1, 2024, the Applicant indicated that they did not wish to proceed with the oral hearing.

[12] No further submission has been received.

THE ISSUES

[13] This review considers the following issues:

- Whether claims 1 to 21 on file are directed to patentable subject-matter and comply with section 2 and subsection 27(8) of the *Patent Act*;
- Whether claims 1 to 21 on file are unobvious, as required by section 28.3 of the *Patent Act*;
- Whether claim 1 on file is definite, as required by subsection 27(4) of the *Patent Act*;
- Whether claims 2, 3, 12, 13, and 21 on file are patentably distinct from claims of the ‘630 patent; and

- Whether proposed claim set-2, which supersedes proposed claim set-1, overcomes defects in the claims on file and constitutes amendments necessary for compliance with the *Patent Act* and *Patent Rules*.

PURPOSIVE CONSTRUCTION

Legal Principles

- [14] Purposive Construction is antecedent to any consideration of validity (*Free World Trust v Électro Santé Inc*, 2000 SCC 66 at para 19 [*Free World Trust*]).
- [15] In accordance with *Free World Trust* 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 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.
- [16] *PN2020–04* notes that all elements in a claim are presumed essential unless such presumption is contrary to the claim language, or it is established otherwise (see also *Free World Trust* at para 57, *Distrimedic Inc v Dispill Inc*, 2013 FC 1043 at para 201).

Analysis

The person skilled in the art and their relevant CGK

- [17] The PR letter adopted the identifications of the skilled person and their CGK from the FA:

Identify the person skilled in the art

The person skilled in the art is considered to be an individual or a team comprising one or more computer scientists and IT professionals who have relevant education and experience in designing, programming and implementing betting or gaming systems as well as investors or brokers familiar with trading markets.

Identify the relevant common general knowledge of that person

The person skilled in the art would be familiar with the knowledge such as sending and receiving data via a server or network, graphical user interface design and implementation, accessing and storing data via a database or memory, and statistical knowledge related to the gaming industry and stock market. Further, general betting knowledge such as how to place a high bet or low bet is also considered to be common general knowledge.

- [18] In the absence of further submissions from the Applicant regarding claim construction, we adopt the above characterizations of the person skilled in the art and the relevant CGK.

The essential elements

- [19] There are 21 claims in the claims on file, including independent claims 1, 2, 12, and 21, and dependent claims 3 to 11 and 13 to 20.

- [20] Claim 2 is representative of the independent claims and reads:

2. An apparatus for displaying a betting opportunity, comprising:

at least one processor; and

a memory that stores instructions which, when executed by the at least one processor, directs the at least one processor to perform a method comprising:

receiving from a first user a first request for wagering information;

based on the first request, causing a first graphic interface screen to be displayed at a first graphic interface, the first graphic interface comprising:

a first market betting line having a displayed value that corresponds to a current market value of a financial market indicator at a first time;

a first high betting line having a displayed value corresponding to an amount above the current market value of the financial market indicator at the first time, the displayed value of the first high betting line indicating a value that is a basis for a bet;

a first low betting line having a displayed value corresponding to an amount below the current market value of the financial market indicator at the first time, the displayed value of the first low betting line indicating a value that is a basis for a bet;

in which each of the market, high, and low betting lines are spatially arranged on the interface screen based at least on the respective values of each of the lines such that the market line, high line, and low line are arranged sequentially in order of increasing value from a bottom of the interface screen to a top of the interface screen;

for each of the first market, first high, and first low betting lines, a first and second icon associated with the respective betting line; the first and second icons for each first betting line being displayed simultaneously on the interface screen;

in which the first icon associated with each betting line is selectable for submitting an up bet request for wagering that, at a designated time after the first time, the financial market indicator will have a value that is greater than the displayed value of the respective betting line, and in which the second icon associated with each betting line is selectable for submitting a down bet request for wagering that, at the designated time, the financial market indicator will have a value that is less than the displayed value of the respective betting line; and

respective first betting odds associated with each of the first and second icons for each of the betting lines; and

receiving a first bet from the first user, in which the act of receiving the first bet comprises receiving a selection of one of the first and second icons associated with one of the betting lines, the first bet having the odds associated with the respective selected icon.

- [21] Independent claims 1, 12, and 21 on file recite an apparatus, a method, and a computer-readable medium storing instructions, respectively. Each of these claims shares similar features with claim 2. Additionally, claim 1 on file recites the features of a second user utilizing the graphic interface to place bets, receiving updated market information and refreshing the graphic interface screen accordingly, and transmitting the outcomes of the bets. The dependent claims define further limitations regarding the method and apparatus for displaying a betting opportunity.
- [22] As explained in the PR letter, according to *PN2020-04*, in “carrying out this identification of essential and non-essential elements, all elements set out in a claim are presumed essential, unless it is established otherwise or is contrary to the language used in the claim.” Considering the whole of the specification, we consider that the skilled person would understand that there is no use of language in the claims indicating that any of the elements are optional or otherwise non-essential. Therefore, we presume that all claimed elements are essential.

PATENTABLE SUBJECT-MATTER

Legal Principles

- [23] Any patentable invention must fall within the definition set out in section 2 of the *Patent Act*, including falling within one of the categories defined therein:

“*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.

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

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

[25] *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.

[26] The determination of the actual invention is a relevant and necessary question in assessing patentable subject-matter (*Canada (Attorney General) v Amazon.com Inc*, 2011 FCA 328 at para 42 [*Amazon*]). As stated by the Federal Court of Appeal in *Canada (Attorney General) v Benjamin Moore & Co*, 2023 FCA 168 at para 68 [*Benjamin Moore*], this determination is in line with that Court’s statement in *Schlumberger Canada Ltd v Commissioner of Patents*, [1982] 1 FC 845 (CA) [*Schlumberger*] that a patentable subject-matter assessment involves determining what according to the application has been discovered. The actual invention is identified in the context of the new discovery or knowledge and must ultimately satisfy the “physicality requirement” that is implicit in the definition of “invention” (*Amazon* at paras 65 and 66).

[27] *Amazon* at para 44 tells us that “a patent claim may be expressed in language that is deliberately or inadvertently deceptive” and that what appears on its face

to be an “art” or “process” may in fact be a claim to an unpatentable mathematical formula, as was the case in *Schlumberger*.

[28] This sentiment is expressed in the position of the *Amazon* Court that the presence of a practical application may not, in some cases, be sufficient to satisfy the physicality requirement, which requires something with physical existence, or something that manifests a discernible effect or change (*Amazon* at paras 66 and 69). To illustrate this point, *Amazon* referred to *Schlumberger*, where the claims “were not saved by the fact that they contemplated the use of a physical tool, a computer, to give the novel mathematical formula a practical application” (*Amazon* at para 69).

[29] The patentable subject-matter concerns regarding the well-known use of a computer to process an algorithm, illustrated by *Schlumberger*, are expressed in the factors set out in *PN2020–04* that may be considered when reviewing computer-implemented inventions, namely:

- 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, unpatentable subject-matter and prohibited by subsection 27(8) of the *Patent Act*;
- a computer programmed to merely process an abstract algorithm in a well-known manner without more will not make it patentable subject-matter; and
- if processing an algorithm improves the functionality of the computer, then the computer and the algorithm would together form a single actual invention that would be patentable.

[30] The above factors and the general concerns around the well-known use of a computer to process new abstract algorithms can be seen to involve considerations of novelty or ingenuity. Canadian law does not prohibit considerations of the novelty or ingenuity of elements of a claim in considering patentable subject-matter and finds support in situations like that of

Schlumberger where a known tool, a computer, is used to give an abstract mathematical formula a practical application (*Benjamin Moore* at paras 69 to 70, referring to *Amazon*). These considerations assist in the determination of the discovery or new knowledge, the method of its application and the actual invention (*Benjamin Moore* at para 89) that is ultimately measured against the physicality requirement.

- [31] As noted in *Benjamin Moore* at para 94 (and similarly expressed in *Amazon* at para 61), the physicality requirement will not likely be satisfied without something more than only a well-known instrument, such as a computer, being used to implement an abstract method. The factors set out above from *PN2020-04* assist in determining whether something more is present.

Analysis

- [32] The PR letter explained why we preliminarily determined that claims 1 to 21 on file are directed to non-patentable subject-matter.

Regarding the features in the claims on file, the R-SOR (pages 3 to 4) stated:

- (1) “The claims of the present application are directed towards an improved operation of a computer system in such a manner so as to improve processing efficiency when the computer system is operated to provide a betting opportunity.” The Applicant further indicated that the processing efficiency is improved because “a personalized user profile improves a user’s access time to their account” and “a computer system operates by removing unnecessary data entry by the user thereby increasing data processing efficiency.”
- (2) The methods described in the claims are “methods of operating a computer system” and thus “any requirements for physicality are met.”

We first address the argument that “any requirements for physicality are met” because a computer system is utilized.

In order to determine whether the claims on file define patentable subject-matter, it is necessary to identify the actual invention. For the claims on file, it is our preliminary view that the actual invention is limited to abstract rules regarding how betting information is presented.

Although we preliminarily consider all the claimed elements, including the computer elements, as essential, the mere fact that these elements are essential elements does not necessarily mean that the claimed invention is directed to patentable subject-matter. In our preliminary view, the computer elements are not considered to be part of the actual invention.

Throughout the specification, the instant application only recites a generic computer system with conventional input, output, storage, communications, and data processing components. As stated in *Benjamin Moore*, “if the only new knowledge lies in the method itself, it is the method that must be patentable subject matter. If, however, the new knowledge is simply the use of a well-known instrument (a book or a computer) to implement this method, then it will likely not fall under the definition found at section 2 without something more to meet the requirement described at paragraph 66 of *Amazon*” (para 94). For the instant application, the computer elements as claimed are merely being used to make the kind of generic calculations and data processing operations they are known to make (see *Schlumberger*). There is nothing in the specification to suggest that the computer elements are used for any purpose beyond well-known generic data processing operations. Therefore, it is our preliminary view that the “new knowledge” or “discovery” does not include the computer implementation, and the claimed computer elements do not form part of the actual invention.

We now address the argument on “improved operation of a computer system” due to the usage of personalized user profiles and removal of “unnecessary data entry by the user.”

Regarding personalized user profiles, in our preliminary view, the skilled person would understand that these were well-known business practice at the relevant date. The implementation of these profiles would not improve

the functioning of the conventional computer system the instant application utilizes. Further, the claims on file do not mention this feature, which excludes it from the actual invention.

Regarding the utilization of a graphic interface to place bets and the statement that it may “remove unnecessary data entry by the user,” the skilled person would understand that utilizing a graphic interface to accept user input does not “go beyond the normal interactions of a computer program with a system.” The specification only recites that the icons are “selectable” without teaching or suggesting any new or unconventional means of accepting user inputs from the graphic interface. The means of accepting user input, as part of the conventional computer system used in the claims, does not operate beyond known data input means, and is not part of the “new knowledge” or “discovery” of the claimed subject-matter.

We note that claims 1, 3, 4, and 13 on file also recite the feature of refreshing the graphic interface based on updated market information. The description indicates that betting information may be updated daily or “several times per day” based on updated market information in order to “provide new betting opportunities” (pages 9, 10, and 29). In our preliminary view, the refreshing feature is still directed to how betting information is displayed to users. It does not lead to any improvement of the computer system and does not add something more to meet the requirement described at paragraph 66 of *Amazon*.

In light of the above, our preliminary view is that none of the claimed features indicates any improvement of the computer system. As stated in *Benjamin Moore*, utilizing well-known computer elements to implement an abstract method without something more would not satisfy the physicality requirement. It is our preliminary view that the actual invention of the claims on file is directed to an abstract method of betting information presentation.

Since the actual invention is limited to an abstract method of betting information presentation, it is our preliminary view that the claimed subject-matter is not directed to “something with physical existence, or something

that manifests a discernible effect or change” (*Amazon*, para 66). Accordingly, we preliminarily conclude that claims 1 to 21 on file are directed to non-patentable subject-matter and do not comply with section 2 of the *Patent Act*. Furthermore, since the abstract data operations and rules are akin to a “mere scientific principle or abstract theorem,” claims 1 to 21 on file are also prohibited under subsection 27(8) of the *Patent Act*.

[33] The Applicant did not dispute or comment on this analysis. We conclude that claims 1 to 21 on file do not comply with section 2 and subsection 27(8) of the *Patent Act*.

OBVIOUSNESS

Legal Principles

[34] Section 28.3 of the *Patent Act* requires claimed subject matter to not be obvious:

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 before the one-year period immediately preceding the filing date or, if the claim date is before that period, before the claim 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.

[35] In *Apotex Inc v Sanofi–Synthelabo Canada Inc*, 2008 SCC 61 at para 67, the Supreme Court of Canada stated that it is useful in an obviousness inquiry to follow 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

[36] The PR letter explained why we preliminarily considered that claims 1 to 21 on file would not have been obvious to the skilled person.

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

(b) Identify the relevant CGK of that person

The person skilled in the art and their relevant CGK have been identified above under “Purposive construction.”

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

As previously explained, all claimed elements are presumed to be essential for this review. Therefore, we take into account all elements of the claims as representing their inventive concepts for the consideration of obviousness.

(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

The following documents were referenced in the FA and the SOR:

D1:	US 6,527,270 B2	Maksymec et al.	March 4, 2003
D2:	US 6,126,270 B2	Friedman	October 3, 2000
D3:	US 6,296,251	Webb	October 2, 2001

In addition, we consider the following document relevant. It was cited previously in the International Search report.

D4:	US 2001/0032169 A1	Sireau	October 18, 2001
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D1 discloses a wagering system in which the payment on either side of a centre point increases as the amount of win or loss diverges from the centre point. D2 is directed to a method of wagering on multiple sporting events that involve multiple teams. D3 is directed to a modified Blackjack game with a variable payoff scale. D4 is directed to a betting system that facilitates betting on a financial market.

We preliminarily consider D4 as the closest prior art. We have also considered D1 to D3.

D4 discloses the following:

- Betting on a financial market, such as betting on a stock index (abstract, paragraphs [0004], [0005]);
- Spread bet, which pays out a sum proportional to the market fluctuation (paragraph [0004]);

- Digital option, which pays out an agreed amount of money if a certain stock index rises to a certain level by a certain time (paragraph [0005]);
- The betting system comprises a central processing machine and user terminals connected to the central processing machine via networks (Fig. 1, paragraphs [0041] to [0045]);
- Users are able to place bets on the financial market using a user terminal via a graphic interface, which comprises “a number of menus or the like through which the user may navigate to glean information or select bet parameters” (paragraphs [0050], [0090] to [0092]);
- Betting parameters include “the amount that the user wishes to bet or the amount that the user wishes to win; or one or more barrier or target levels (relating to market performance) which set a threshold for the financial market parameter being monitored” (paragraph [0050]);
- Receiving updated market information concerning financial market indicators and determine valid betting parameters according to the current market condition (paragraph [0054]).
- Making up/down bets that bet on whether a given market will be above or below a given level (paragraph [0063]);
- Determine betting prices based on current market condition and certain formula (paragraphs [0073] to [0089]).

In our preliminary view, the differences between D4 and the inventive concepts of the independent claims are the specific betting information presentation arrangement including a market line, a high betting line above the market line, a low betting line below the market line, and a separate set of an up bet icon and a down bet icon associated with each of the three lines, respectively.

The FA (pages 8 to 9) stated that D1 discloses all claimed features of independent claim 1 with the exception of “receiving from a second user a

second request for wagering information and based on the second request, causing and displaying at a second graphic interface and so forth as recited in claim 1.” More specifically, the FA argued that D1 taught the display arrangement above in Fig. 1, Fig. 2, column 7, lines 28 to 30, and column 9, lines 52 to column 10, line 4.

We preliminarily disagree. First, Fig. 1, and Fig. 2 are payout graphs/charts; the lines on Fig. 1 indicate payout multiplier values, not betting lines. Second, although column 7 of D1 mentions that the betting system can be used to bet on the stock market, nowhere in D1 discloses the specific betting data presentation as recited in the claims on file.

We note that none of D2 and D3 discloses the claimed betting lines, icons, and their display arrangements.

(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?

As discussed above in step (3), none of D1 to D4 discloses or suggests the features of displaying a market line, a high betting line above the market line, a low betting line below the market line, and a separate set of an up bet icon and a down bet icon associated with each of the market line, the high betting line, and the low betting line.

Further, in our preliminary view, there is nothing in the CGK that would teach or suggest the claimed graphic presentation of betting lines and icons.

Therefore, we preliminarily conclude that claims 1, 2, 12, and 21 would not have been obvious in view of the cited prior art and the relevant CGK, considered separately or in combination, and are therefore compliant with section 28.3 of the Patent Act. Since claims 3 to 11 and 13 to 20 are dependent upon claims 1, 2, and 12, it follows that these claims are also unobvious and comply with section 28.3 of the Patent Act.

[37] In the absence of further submissions from the Applicant, we conclude that claims 1 to 21 on file comply with section 28.3 of the *Patent Act*.

INDEFINITENESS

Legal Principles

[38] Subsection 27(4) of the *Patent Act* requires claims to define subject-matter distinctly and explicitly:

The specification must end with a claim or claims defining distinctly and in explicit terms the subject-matter of the invention for which an exclusive privilege or property is claimed.

[39] In *Minerals Separation North American Corp v Noranda Mines Ltd*, [1947] Ex CR 306, 12 CPR 99, at page 146, the Court emphasized both the obligation of an applicant to make clear in the claims the ambit of the monopoly sought and the requirement that the terms used in the claims be clear and precise:

By his claims the inventor puts fences around the fields of his monopoly and warns the public against trespassing on his property. His fences must be clearly placed in order to give the necessary warning and he must not fence in any property that is not his own. The terms of a claim must be free from avoidable ambiguity or obscurity and must not be flexible; they must be clear and precise so that the public will be able to know not only where it must not trespass but also where it may safely go.

Analysis

[40] The PR letter preliminarily considered that claim 1 on file is indefinite.

We are of the preliminary view that claim 1 on file is indefinite and does not comply with subsection 27(4) of the *Patent Act*, since the term “the second time” (page 35, line 9) lacks an antecedent.

[41] In the absence of further submissions from the Applicant, we conclude that claim 1 on file does not comply with subsection 27(4) of the *Patent Act*.

DOUBLE-PATENTING

Legal Principles

[42] There are no express provisions in the *Patent Act* dealing with double-patenting. However, the Supreme Court of Canada has indicated that the statutory basis for double-patenting is subsection 36(1) of the *Patent Act* which indicates, in the singular, that “a patent shall be granted for one invention only” (*Whirlpool*, at para 63). The courts have also considered double-patenting to be a proper basis for the Commissioner of Patents to refuse an application: *Bayer Schering Pharma Aktiengesellschaft v Canada (Attorney General)*, 2010 FCA 275; aff’g 2009 FC 1249.

[43] In *Whirlpool*, the Supreme Court noted that there are two branches to the test for double-patenting. The first is “same-invention” double-patenting, which occurs when the claims of a first and second patent, both of which are owned by the same party, are “identical” or “conterminous” to one another. The second branch is known as “obviousness double-patenting.” This is a “more flexible and less literal test” than same-invention double-patenting, which prohibits the issuance of the second patent unless its claims are “patentably distinct” and exhibit “novelty or ingenuity” over those of the first patent (*Whirlpool*, paras 66 and 67).

[44] Obviousness double-patenting is assessed from the perspective of the person of skill in the art, taking into account that person’s CGK. The analysis compares the claims in the application to the claims of the issued patent and any other prior art is only relevant insofar as it contributes to the CGK of the skilled person (*Mylan Pharmaceuticals ULC v Eli Lilly Canada Inc*, 2016 FCA 119 at paras 28 and 29).

Analysis

[45] The PR letter explained why we preliminarily considered that claims 2, 3, 12, 13, and 21 on file are defective due to obviousness double-patenting:

The following document is considered relevant in our double patenting analysis:

D5: CA 2,661,630 C Amaitis et al. February 28, 2008

In our preliminary view, claims 2, 12, and 21 on file are not patentably distinct from claim 30 of D5. All these claims recite a computerized method or apparatus for displaying a betting opportunity, the display comprising a market betting line, a high betting line, and a low betting line. They also recite receiving a bet from a user by selecting a graphic object associated with one of the betting lines.

The main difference between the claimed features of claims 2, 12, and 21 on file and claim 30 of D5 is that the claims on file recite two icons associated with each of the betting lines for submitting an up bet and a down bet, while claim 30 of D5 recites “a plurality of graphic objects selectable for submitting at least one of an up bet request and a down bet request” for each of the betting lines. In our preliminary view, after construing both claims purposively considering the whole specifications, the skilled person would understand that these features are not patentably distinct from each other. The terms “graphic icons” and “graphic objects” both refer to graphic symbols on a graphic interface for user selection, and have the same meaning.

It is also our preliminary view that claims 3 and 13 on file are not patentably distinct from claim 35 of D5. These claims recite refreshing displayed betting parameters based on updated market information.

For the reasons above, we preliminarily conclude that claims 2, 3, 12, 13, and 21 are not patentably distinct from claims 30 and 35 of D5, respectively, and are therefore defective due to obviousness double-patenting.

[46] In the absence of further submissions from the Applicant, we conclude that claims 2, 3, 12, 13, and 21 on file are defective due to obviousness double-patenting.

PROPOSED CLAIM SET-2

[47] The PR letter explained why we preliminarily considered that proposed claim set-2 does not constitute amendments necessary for compliance with the *Patent Act* and *Patent Rules*.

Compared with the claims on file, proposed claim set-2 includes the following additional features in the independent claims:

- (a) a money card insertion device configured to receive a given money card through which a given bet is placed;
- (b) an indication from the money card insertion device of insertion of a money card to place the first bet;
- (c) a first spread betting line and a second spread betting line, wherein the first and second spread betting lines branch from the first market betting line such that the first spread betting line branches in an upwardly direction from the first market betting line and the second spread betting line branches in a downwardly direction from the first market betting line;
- (d) the first high betting line and the first low betting line are spaced apart from the first and second spread betting lines; in which respective positions of the plurality of betting lines are movable in response to a change to a real-time value of market price during the first betting session;
- (e) a third spread betting line and a fourth spread betting line, wherein the third and fourth spread betting lines branch from the second market betting line such that the third spread betting line branches in an upwardly direction from the second market betting line and the fourth spread betting line branches in a downwardly direction from the second market betting line.

Patentable subject-matter

Regarding proposed claim set-2, the R-PR (page 4) argued that:

- (1) [The amended claims provide] “a graphical user interface at a network computing device which may improve the usability, efficiency and dynamic real-time operation of an electronic wagering system, and recite features that are not well understood, routine, or conventional.”
- (2) The money card insertion in claim 1 is “a required physical device that could not be abstract.”

Regarding the computer elements in the claims, as explained above, it is our preliminary view that the instant application does not teach or suggest anything beyond a generic computer system, including its graphic interface and network interface. If there were any claimed features that are “not well understood, routine, or conventional,” they would be directed to the display arrangement, not to the computer system.

Regarding the money card insertion device for accepting payment from credit cards or debit cards, it is considered a well-known input means at the relevant date. In our preliminary view, it does not add something more to meet the requirement described at paragraph 66 of *Amazon*. As stated in *Benjamin Moore*, “If, however, the new knowledge is simply the use of a well-known instrument (a book or a computer) to implement this method, then it will likely not fall under the definition found at section 2 without something more to meet the requirement described at paragraph 66 of *Amazon*” (para 94)”. It is our preliminary view that the money card insertion device is not part of the actual invention.

New features (c) to (e) are mostly directed to how spread betting lines are presented in a graphic interface. In our preliminary view, these are directed to additional limitations to the abstract method of displaying betting information.

In addition, feature (d) recites that the betting lines are “movable in response to a change to a real-time value of market price.” In our preliminary view, the skilled person would understand that receiving market

information through conventional network technologies and displaying the received information on a conventional graphic interface in expected manners do not result in any improvement of the computer system. This feature still pertains to displaying betting information, rather than an improvement of the graphic interface. Consequently, it is our preliminary view that this feature would not add something more to meet the physicality requirement.

In light of the above, we preliminarily conclude that the actual invention of the proposed claim set-2 is still directed to an abstract method of presenting betting information. Therefore, the proposed claims are directed to non-patentable subject-matter and do not comply with section 2 of the *Patent Act*. Furthermore, since the abstract rules are akin to a “mere scientific principle or abstract theorem,” these claims are also prohibited under subsection 27(8) of the *Patent Act*.

Obviousness

Since the identified differences between the inventive concept of claims on file and the state of the art are still present in all claims of proposed claim set-2, we preliminarily consider that proposed claim set-2 would not have been obvious and complies with section 28.3 of the *Patent Act*, for the reasons stated above.

Indefiniteness

In the proposed claim 1, the term “the second time” (page 36, line 6) lacks an antecedent. We preliminarily conclude that the proposed claim 1 does not comply with subsection 27(4) of the *Patent Act*.

Double-patenting

In our preliminary view, the claims of D5 and the CGK do not teach or suggest the features in differences (c) and (e), which are present in all independent claims of the proposed claims.

Therefore, we preliminarily conclude that claims 1 to 19 of proposed claim set-2 are patentably distinct from claims of D5.

[48] The Applicant did not dispute or comment on this analysis. We conclude that proposed claim set-2 contains non-patentable subject-matter and indefiniteness defects and cannot be considered a “necessary” amendment under subsection 86(11) of the *Patent Rules*.

CONCLUSIONS AND RECOMMENDATION OF THE BOARD

[49] In view of the above, we are of the view that:

- Claims 1 to 21 on file are directed to non-patentable subject-matter and do not comply with section 2 and subsection 27(8) of the *Patent Act*;
- Claims 1 to 21 on file would not have been obvious to the skilled person and comply with section 28.3 of the *Patent Act*;
- Claim 1 on file is indefinite and does not comply with subsection 27(4) of the *Patent Act*;
- Claims 2, 3, 12, 13, and 21 on file are not patentably distinct from claims 30 and 35 of the '630 patent and are therefore defective due to obviousness double-patenting; and
- Proposed claim set-2 contains non-patentable subject-matter and indefiniteness defects, and cannot be considered a “necessary” amendment under subsection 86(11) of the *Patent Rules*.

[50] Accordingly, we recommend that the application be refused on the grounds that claims 1 to 21 on file do not comply with section 2 and subsection 27(8) of the *Patent Act*, that claim 1 on file does not comply with subsection 27(4) of the *Patent Act*, and that claims 2, 3, 12, 13, and 21 on file are defective due to obviousness double-patenting.

Liang Ji

Member

Alison Canteenwalla

Member

Howard Sandler

Member

DECISION OF THE COMMISSIONER

[51] I concur with the conclusions and recommendation of the Board that the application be refused on the grounds that:

- Claims 1 to 21 on file are directed to non-patentable subject-matter and do not comply with section 2 and subsection 27(8) of the *Patent Act*;
- Claim 1 on file is indefinite and does not comply with subsection 27(4) of the *Patent Act*; and
- Claims 2, 3, 12, 13, and 21 on file are not patentably distinct from claims 30 and 35 of the '630 patent and are defective due to obviousness double-patenting.

[52] Accordingly, I refuse to grant a patent for this application in accordance with section 40 of the *Patent Act*. Under section 41 of the *Patent Act*, the Applicant has six months to appeal my decision to the Federal Court of Canada.

Konstantinos Georgaras

Commissioner of Patents

Dated at Gatineau, Quebec

this 15th day of May, 2024.