

## **PATENTS ACT 1977**

### **IN THE MATTER OF Patent Application 9424224.5 in the name of Christopher Vivian Tucker**

## **DECISION**

### **Background**

1. This application, which relates to three-dimensional chess games using a plurality of conventional 8x8 chess boards and standard sets of chess pieces, was filed on 30 November 1994 and was published as GB2298144 on 28 August 1996. The request for examination was filed on 3 February 1997, and the first examination report under Section 18(3) issued on 17 December 1997.

2. In the report, the examiner objected that the claims were not clear, but identified three possible alleged inventive concepts from the description. The examiner contended that all three concepts were not patentable, two for lack of novelty and the third in that it fell within the specific exclusion in Section 1(2)(c) of the Patents Act, and cited nine prior publications.

3. Following a response from the applicant in the form of arguments in a letter, the examiner, in a further examination report issued 9 July 1998, conceded that there was some inventive matter disclosed in the application, namely apparatus for playing three-dimensional chess comprising two or more superposed eight by eight chess boards and four or more distinguishable standard sets of sixteen chess pieces. However, he rejected the applicant's contention that his embodiment comprising plural superposed chess boards and two standard sets of chess pieces was novel and inventive, citing the disclosures in GB2237213 ("Taylor"), GB1283840 ("Clarke") and GB601062 ("Beatty").

4. In his response, again in the form of arguments in a letter, received 5 November 1998, the applicant contended that his game, comprising plural superposed chess boards and two

standard sets of chess pieces, was distinguished from the cited documents by virtue of the starting positions of the pieces in his game. In a further examination report issued 18 November, following further discussions with the applicant by telephone, the examiner restated his objections to the applicant's contention in greater detail, specifically suggesting that the apparatus as proposed by the applicant did not involve an inventive step having regard to the disclosures in Clarke and Taylor and also the disclosures in US5193813 ("Goff"), US5031917 ("Greene"), and the book "The Encyclopedia of Chess Variants" by DB Pritchard, (hereafter referred to as "Maack I"). The examiner also suggested that if the applicant continued to disagree with the objection then the matter should be settled by a senior officer either following a hearing at which the applicant could put his case, or merely on the papers.

5. The applicant responded in a letter received 29 January 1999, requesting that the matter be referred to a senior officer. In a letter dated 11 February 1999, the examiner invited the applicant to indicate whether he wished to attend a hearing or wanted the matter to be decided on the papers. No response was received to this letter nor to several telephone messages, so the examiner sent a further letter on 1 March 1999, informing the applicant that the matter would be decided on the papers on or shortly after 22 March 1999, following which a reasoned decision would issue. Again, no response has been forthcoming, so I now come to decide the matter on the papers.

### **The issue**

6. Section 1(1) of the Patents Act states:

*A patent may be granted only for an invention in respect of which the following conditions are satisfied, that is to say -*

*(a) the invention is new;*

*(b) it involves an inventive step;*

- (c) *it is capable of industrial application;*
- (d) *the grant of a patent for it is not excluded by subsections (2) and (3) below;*

*and references in this Act to a patentable invention shall be construed accordingly.*

7. I also need to have regard to Section 1(2) of the Act, which reads:

*It is hereby declared that the following (among other things) are not inventions for the purposes of this Act, that is to say, anything which consists of -*

- (a) *a discovery, scientific theory or mathematical method;*
- (b) *a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever;*
- (c) *a scheme, rule or method for performing a mental act, playing a game or doing business, or a program for a computer;*
- (d) *the presentation of information;*

*but the foregoing provision shall prevent anything from being treated as an invention for the purposes of this Act only to the extent that a patent or application for a patent relates to that thing as such;*

I will also need to consider Section 3 of the Act, which reads:

*An invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the state of the art*

*by virtue only of section 2(2) above (and disregarding section 2(3) above).*

8. The issue I have to decide is whether a claim to a particular form of 3-D chess proposed by the applicant is allowable. The circumstances are somewhat unusual in that there is not a precise expression of the claim either in the specification or in the letters sent by the applicant contesting the objections raised by the examiner. However, the nature of the claim that the applicant would like to incorporate in his specification is fairly clear from those letters. Basically, the claim would specify a plurality of superposed 8x8 chess boards and two distinguishable sets of 16 standard chess pieces, in which the pieces are arranged at the start of a game in the conventional opposed manner on any of the boards other than the lowermost one.

9. Before I turn to the matter of inventive step, which was the issue raised by the examiner and disputed by the applicant, I should consider briefly whether the invention at issue, as far as it can be determined in the absence of a precise statement of claim, is an invention within the terms of Section 1(2)(c) of the Act. That sub-section excludes from patent protection, schemes, rules or methods for performing a mental act, playing a game or doing business, or a program for a computer. As a general rule, it is held that this exclusion may extend also to apparatus, if in substance what is claimed is no more than an excluded method. However, this extension to apparatus does not apply in the case of games following Official Ruling 1926(A) (*See* Appendix to 43RPC). Although this ruling, (which held that claims to apparatus for playing a game and comprising one or more playing pieces and a board marked in a particular manner, the playing piece or pieces being moved in accordance with specified directions, were patentable provided all other requirements were met), was issued under the 1907 Patents Act, a similar approach to determining patentability is adopted under the current Act.

10. It follows from that Official Ruling, therefore, that claims to apparatus comprising chess boards and pieces are intrinsically patentable. Accordingly, I decide that a claim along the lines envisaged in the applicant's letters received on 5 November 1998 and 29 January 1999 does not fall within the exclusion in Section 1(2)(c) of the Act.

11. Returning thus to the examiner's objection of lack of inventive step, the applicant acknowledges that in Taylor, there is disclosed apparatus comprising a plurality of superposed 8x8 chess boards and two distinguishable sets of 16 standard chess pieces. However, the only mention of a starting line-up refers to the pieces being located on the lowermost board. In Clarke, the apparatus again comprises a plurality (eight) of superposed 8x8 chess boards and two distinguishable sets of 16 standard chess pieces. In Clarke, however, the pieces are arranged over all eight boards at the start of a game. In Beatty, there is disclosed apparatus comprising three or more superposed 8x8 chess boards, and two distinguishable sets of 16 standard chess pieces, but there is no mention of the starting line-up.

12. Taylor is clearly the nearest relevant prior art. The applicant's proposed claim is distinguished from the disclosure in Taylor only in that Taylor specifies that the standard starting layout is located on the lowermost board, whilst the applicant proposes a standard starting layout on any board other than the lowermost. Considering the effect of this difference on the nature of the game, it is clear that when the pieces start on an intermediate board, they have a greater choice of initial moves, in that as well as the standard moves in the horizontal plane of the board, they can also move - in crude terms - up or down. Starting on the lowermost board, their initial moves, other than in the plane of the board, can only be up. In this sense, starting on the uppermost board is essentially the same as starting on the lowermost board, as again, initial movement out of the plane of the board can only be in one direction.

13. In the present case the person skilled in the art, referred to in Section 3 of the Act must be a person who is knowledgeable in the playing of chess, and more particularly, three-dimensional chess. I find it hard to believe that such a person, being familiar with the game as described in Taylor, and also with those described in Clarke (in which the pieces are distributed over all eight boards at the start of the game) and Greene (in which one set of pieces are arranged on the lowermost board and one on the uppermost board) would require to exercise inventive ingenuity to adopt a starting position for such a game where the pieces were located on a level other than the lowermost one. Such a person would recognise that to do so would vary the nature of the game to some extent, but I am of the view that that person

would still regard it as an obvious change to make.

14. Therefore I determine that claims based on the proposals in the aforesaid letters from the applicant for apparatus comprising a plurality of superposed 8x8 chessboards and two distinguishable standard sets of 16 chess pieces characterised in that the pieces are arranged in the standard opposed starting positions on any board other than the lowermost one are not allowable.

15. I am aware that the examiner has indicated to the applicant at least one valid claim that could be introduced, thus I give the applicant a period of one month from the date of this decision in which to put forward amendments to meet with the objections raised in the report issued with a covering letter on 9 July 1998. I would remind the applicant that the period for putting this case in order expires on 30 May 1999.

### **Appeal**

16. As this is a substantive matter, any appeal must be lodged within six weeks of the date of this decision.

Dated this 26th day of March 1999

**GM ROGERS**

Deputy Director, acting for the Comptroller

**PATENT OFFICE**