BL O/243/05

9th September 2005

PATENTS ACT 1977

APPLICANT Shuffle Master, Inc.

ISSUE Whether patent application number GB0420053.1 is excluded by section 1(2)

HEARING OFFICER H Jones

DECISION

1 Patent application GB0420053.1, entitled "Poker game with required dealer discard", was filed in the name of Shuffle Master Inc. on 9th September 2004. The application claims priority from US patent application US10658865 filed on 9th September 2003.

2 The application relates to a method of playing a poker-type card game or video game equivalent, with much of the description setting out the specific rules for dealing the cards and for placing wagers. In response to a request for preliminary examination and search filed on 9th September 2004, the examiner informed the applicant that he considered it unlikely that the specification disclosed anything of a patentable nature that could be searched. In his letter dated 17th December 2004, the examiner offered the applicant the option of either withdrawing the application with a refund of the search fee, issuing a search report under section 17(5)(b) stating that a search would not serve a useful purpose or having the matter decided at a hearing.

3 The applicant requested that the matter be dealt with at a hearing. The examiner subsequently set out his objection more fully in an examination report under section 18(3) dated 24th February 2005. This report was issued despite the fact that no formal request for examination had been made by the applicant, which follows practice set out in the Assistant Comptroller's decision in *Rohde and Schwartz's Application* [1980] RPC 155 where it was held that objections could be raised under section 18(3) at any time, notwithstanding the fact that an application has not been referred to the examiner under section 18(1). In his report, the examiner argued that the invention disclosed in the application relates to a scheme, rule or method for playing a game excluded from patentability under section 1(2)(c) and that the application should therefore be refused.

4 The matter came before me to decide at a hearing on 12th April 2005 at which the applicant was represented by Mr Paul Bowman and Ms Louise Hall of Lloyd Wise.

5 Shortly before issuing a decision on this matter, Peter Prescott QC, sitting as a deputy judge of the High Court, handed down judgment in *CFPH LLC's Application* [2005] EWHC 1589 Pat which raised questions regarding the UK Patent Office's practice in

dealing with applications considered to relate to excluded matter as defined by section 1(2). A key argument raised in *CFPH LLC's Application* was that UK Patent Office practice in the field of excluded subject matter was different to that of the European Patent Office (EPO), despite the requirement under section 130(7) that section 1(2) should have, as nearly as practicable, the same effect as Article 52 of the European Patent Convention EPC. However, despite the different approaches taken by the EPO and the UK Patent Office, Mr Prescott said that, in his judgment, the two approaches would usually lead to the same results on the same set of facts if properly applied.

6 In response to Mr Prescott's judgment in *CFPH LLC's Application*, the UK Patent Office issued a practice notice dated 29th July 2005 announcing an immediate change in the way that it examines applications for patentability. This change in practice brings it more in line with the approach adopted by the EPO but is not considered to materially affect the scope of what is patentable. In view of this change in practice, I invited the applicant to submit further arguments regarding the patentability of its invention.

7 In its further submission, the applicant points to Mr Prescott's comments at paragraph 38 of his judgment which I repeat below:

> "As another example, take a game. You cannot patent the rules of a game, as such; but I believe (though I do not have to decide it) that the scope of the exclusion stops there. It has always been Patent Office practice to grant patents for novel board games supplied together with a printed set of rules. It does no harm and encourages the industry to devise new games that may give pleasure to millions. For example the board game Monopoly was patented. It is a superficial answer to say, "Yes, but that is because it is a set of concrete objects". To which I reply: "You could patent the set even if the objects themselves were not new", as in a novel game played with stones on a chessboard. In those cases it is the new rules that afford the unifying novelty and the inventive step. I can think of no reason why it should be the policy of the law to deny adequate patent protection to those who come up with new and entertaining games. The practical effect of the exclusion is merely to confine the monopoly to what which will be made and supplied commercially."

8 The applicant submits that the present application falls squarely within Mr Prescott's interpretation of patent law and, also, that at least some of the claims are directed to apparatus for playing a game according to rules set out in the description in accordance with the Official Ruling 1926(A) (annexed as an appendix to 43 RPC). The applicant argues that the invention involves technical means and should, if following the European Patent Office approach, be assessed for novelty, inventive step and patentability at the same time. The applicant submits that it would be appropriate at this stage to remit the application for search and to consider patentability when examining for novelty and inventive step. On this point, however, I also note Mr Prescott's comments at paragraph 96 of his judgment where he says:

> "In order to identify what is the advance in the art that is said to be new and nonobvious the Patent Office may rely on prior art searches. But in my judgment it is not invariably bound to do so. It will often be possible to take judicial notice of what was already known. Patent Office examiners are appointed because they

have a professional scientific or technical training. They are entitled to make use of their specialist knowledge. Of course the letter of objection will state the examiner's understanding of the technical facts in that regard, and thus the applicant will have the opportunity to refute it in case there has been a mistake."

9 As Mr Prescott says, it will not always be necessary to carry out a search in order to determine the advance made by a particular invention, because there may already exist evidence of the prior art in the form of the examiner's expert knowledge and in what is acknowledged in the applicant's specification. I do not believe that a necessary consequence of following the EPO approach is to defer consideration of patentability until a prior art search has been conducted. If unambiguous evidence of the prior art is available even before a search has been carried out, then it is right, following the reasoning in *Rohde and Schwartz's Application,* that the examiner is able to refuse the application at the earliest opportunity.

10 Turning to the applicant's point about the patentability of games and the relevance of the Official Ruling 1926(A), I would note that Mr Prescott's view (obiter) was in relation to board games and not, as is the case in the current application, to card games. Indeed, the Official Ruling 1926(A) is also set out in similar terms, making specific reference to playing pieces moved on a board in accordance with directions. The relevance of the Official Ruling 1926(A) was raised in the Hearing Officer's decision in *Shoppalotto.com's Application* (BL O/064/05), which is now the subject of an appeal before the High Court. In fact, the appeal was heard before Mr Justice Pumfrey on 22nd June 2005 and judgment was reserved at that time.

11 Given the similarity between the issues raised by the applicant and to those raised in *Shoppalotto.com's Application*, it would be inappropriate for me to decide the issue of whether the invention is patentable before judgment is handed down by the Court. It would also be unfair to the applicant. In view of the fact that publication of this application is now long overdue, it seems to me entirely appropriate to refer the case back to the examiner for completion of a search report and to arrange for publication of the application. As to the issue of whether the invention relates to subject matter excluded under section 1(2), I will put that matter on hold until the Shoppalotto judgment has been handed down and the applicant has requested substantive examination of the application: if, at such time, the examiner still considers the invention to be excluded under section 1(2), the applicant will be given further opportunity to submit arguments, either orally or in writing, before a decision is issued on the matter.

Conclusion

12 I have decided that the application should be allowed to proceed to search and early publication, and that the matter of patentability be deferred until substantive examination of the application when further guidance on the patentability of games will have been handed down by the Court.

H JONES
Deputy Director acting for the Comptroller