Exhibit H

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

OIPE
APR 24 2008
PATENT & TRADEMARK OFFICE

Doc Code: AP.PRE.REQ

Customized Form PTO/SB/33 (07-05)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Application #	10/893,534
Confirmation #	2395
Filing Date	July 19, 2004
First Inventor	PRYOR
Art Unit	3711
Examiner	Mendiratta, Vishu K.
Docket #	P06410US02/DEJ

Applicant requests review of the final rejection in the above-identified application.

No amendments are being filed with this request.

This request is being filed with a NOTICE OF APPEAL.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the Attorney of Record.

Date: April 24, 2008

By: Name: Douglas E. Jackson
Registration No.: 28,518

STITES & HARBISON PLLC ◆ 1199 North Fairfax St. ◆ Suite 900 ◆ Alexandria, VA 22314
TEL: 703-739-4900 ◆ FAX: 703-739-9577 ◆ CUSTOMER NO. 00881

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

APR 2 4 2008
PATENT & TRADEMARK OFFICE

REMARKS AND ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

In the outstanding final Office Action, the examiner has again refused to consider important functional limitations in the claims, asserting that such "only represent intended use". However, such functional limitations are part of a "means or step plus function" limitation, so that such limitations do not represent "intended use" but are used to functionally define the invention are specifically authorized by 35 USC § 112, 6th paragraph. Therefore, when such limitations are properly considered, the present claims are all not anticipated or made obvious over the applied art and hence are in condition for allowance.

What is claimed in both amended independent claims 9 and 21 is an invention where a board game is played. A computer is used to analyze an output of a TV camera viewing the board game, and to recognize a relative position of at least one of the markers with respect to information on the board. Then, when the marker is moved to a new position during the play of the game, the computer recognizes the new position of the marker. As a result of the newly recognized position, the computer also is then used to automatically generate a sensory output, associated with the new position of the marker, which is designed (intended) to be perceived by the person(s) playing the game.

Independent claims 9 and 21 are (initially) rejected under 35 USC § 102 as being anticipated by the Hedges patent. In particular, the examiner has stated (see final Office Action of January 24, 2008, pages 4-5), when describing the prior art Hedges patent and in response to applicant's arguments and claim changes:

> As explained in previous office action all casinos are equipped with cameras that constantly monitor in real time all movements of every casino activity on every table including identifying all game pieces and their positions. Cameras placed in strategic locations constantly record all casino movements that are monitored. Newly added limitations do not further add any structure to the claimed apparatus. With reference to "generating sensation" such limitations are personal reactions and not part of apparatus.
>
> Newly added limitations in a computer means phrase only represent intended use "for analyzing", "for recognizing", etc. do not specifically

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

claim structure that would limit the apparatus claimed. (Emphasis not added.)

By making this last statement, the examiner has in effect refused to give any patentable weight to the "function" part of the computer "means". Such is contrary to 35 USC § 112, 6th ¶, as well as various sections of the MPEP and long established case law. As well appreciated, § 112, 6th ¶ specifically authorizes the use of "means or step plus function" limitations in a claim. And when such limitations are used, it would be absurd to then ignore the "function" portion as "only representing intended use" as the examiner has done with the present claims.

With a proper appreciation that the "function" part of every means/step plus function limitation in a claim must not be ignored, it will be appreciated that independent apparatus claim 9 and independent method claim 21 both clearly and particularly differentiate from the prior art apparatus and method of the Hedges patent (and the other cited references, the Levy patent and the Karmakar patent, which have similar disclosures) where casino games, or any such live game, are (merely) monitored[1] by a TV camera and the output of the TV camera recorded to a suitable computer. In particular, it is claimed that the apparatus of the present invention includes a computer means for performing the following specific functions (and likewise the method recites a computer performing the noted steps and functions):

a) analyzing the output of said TV camera and recognizing from the analysis a relative position of said marker with respect to the information on said board,

b) analyzing and then recognizing, after a movement of said marker during the play of the game which is viewed by said TV camera, a new position of said marker with respect to the information on said board, and

c) automatically generating, after the new position of said marker is recognized, a sensory output designed to be capable of being perceived by the person, said sensory output being different from a view of said board and marker thereon and being associated with the recognized new position of said marker with respect to the information on said board.

---

[1] One convenient dictionary definition of "monitor" being: "keep under surveillance".

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

No such analyzing[2] and recognizing[3] by a computer takes place in the situation described by the examiner of a casino which monitors activity with TV cameras as in the Hedges patent, the Levy patent and the Karmakar patent. In particular, such a monitoring system does not "analyze" the TV camera output in order to "recognize" a relative position of a marker and a new position of the marker with respect to the information on the board. The actions of "analyzing" and "recognizing" together are definitionally different from the action to "display" or even to "monitor", as would be readily recognized by those of ordinary skill in computer vision which is the standard which should be applied. Further, and significantly, such a prior art monitoring system does not generate a "sensory output" after the new position is "recognized", where the sensory output is different from a view of the board or game. Rather, the monitoring system of the Hedges patent (and the Levy patent and the Karmakar patent) described by the examiner merely displays, without any analysis or recognition, whatever is within the field of view of the TV camera.

The examiner also particularly noted that the term "generating sensation" was a "personal reaction" and hence did not limit the claimed apparatus. Even if this were true, it is irrelevant as this is not what is now claimed. What is now claimed is a computer means "for automatically generating … a sensory output designed to be capable of being perceived by a person". It is thus made clear that it is the computer means which functions to generate this "output", and this generated output (e.g., an emitted sound or image shown in a video display) is not an intended use, but a feature of the claimed apparatus.

Admittedly, the phrase "designed to be capable of being perceived by the person" is an intended use, but even if this phrase were omitted[4] there still remains the positive functional limitation of the "means" limitation which must not be ignored. And it will further be appreciated that each of the prior art monitoring systems obviously does not generate any such "output", as they are incapable of recognizing the need to

---

[2] One convenient dictionary definition of "analyze" being: "an investigation of the component parts of a whole and their relations in making up the whole".

[3] One convenient dictionary definition of "recognize" being: "be fully aware or cognizant of", which is obviously more than using a TV camera to record the activities of a board game under surveillance.

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.