

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARTIN ERLICHMAN

Appeal No. 2003-0322
Application No. 09/569,476

ON BRIEF

Before KRASS, FLEMING and SAADAT, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1, 12 and 23. Appellant canceled claims 34-36 in the reply brief and does not appeal the rejection of any other claim.

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The invention is directed to solving an interactive puzzle and providing a score. The invention is best illustrated by reference to representative independent claim 1, reproduced as follows:

1. A method of providing to a user and scoring a puzzle, the method comprising:
 - providing at least one portion of a representation of a puzzle object having at least one actual solution;
 - automatically and without requiring user input, successively providing over a period of time each of a plurality of portions of the representation of the puzzle object having at least one actual solution;
 - receiving at a first time an attempted solution describing the puzzle object; and
 - providing a score responsive to at least one selected from the at least one actual solution corresponding to the attempted solution and the first time.

The examiner relies on the following references:

Jacobs	5,860,653	Jan. 19, 1999
Walker et al. (Walker)	5,921,864	Jul. 13, 1999

Claims 1, 12 and 23 stand rejected under 35 U.S.C. §103 as unpatentable over Walker in view of Jacobs.

Reference is made to the briefs and answer for the respective positions of appellant and the examiner.

OPINION

In rejecting claims under 35 U.S.C. §103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teachings, suggestions or implications in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with

argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR 1.192 (a)].

It is the examiner's position that Walker discloses the instant claimed invention but for "automatically and without requiring user input, successively providing over a period of time each of a plurality of portions of the representation of the puzzle object having at least one actual solution." The examiner turns to Jacobs for a teaching of an anagram puzzle using a set of symbols and contends that Jacobs' teaching of a hint, in the way of a free letter, is a teaching of the claimed "automatically and without requiring user input..." (Answer, page 4).

The examiner concludes that it would have been obvious "to incorporate the hint feature of Jacobs in Walker's electronic word game puzzle. Doing so gives a player a jump-start to solving the puzzle as quickly as possible without providing an initial guess at a letter or picture (piece of puzzle)" (Paper No. 8-pages 3-4).

We will not sustain the rejection of claims 1, 12 and 23 under 35 U.S.C. §103 as, in our view, the examiner has not established a prima facie case of obviousness.

First, we are unconvinced that the examiner has a valid reason for combining the references. There does not seem to be a need in Walker for the “hint” in Jacobs which the examiner wants to incorporate. Even so, if a “hint” was to be incorporated into Walker, there is no indication why the artisan would have found it obvious to have that “hint” successively provided over a period of time, until the puzzle is solved, “automatically and without requiring user input,” as required by the instant claims.

Even if there were some legitimate reason for combining the teachings of the applied references, it is our view that the instant claimed subject matter would still not result. This is because the “hint” in Jacobs is only provided in response to some user input, i.e., a player strikes a plunger to begin his/her turn (column 9, lines 42-46). Contrary to the examiner’s assertions, the “hint” of a free letter in the anagram game of Jacobs is not performed “automatically and without requiring user input, successively providing over a period of time each of a plurality of portions of the representation of the puzzle object having at least one actual solution.”

The solution of the puzzle in Jacobs will not progress until and unless a player strikes the plunger, thus, the “hint” provided for by Jacobs is not “automatic.” To the extent that the “hint” of a free letter may be considered “automatic,” in that the computer

provides for this “hint,” this function is not performed “without requiring user input” because it requires some action by the player, viz., the striking of a plunger. Moreover, to whatever extent Jacobs may be considered to show an automatic procedure of providing a “hint” without requiring user input (and we do not believe that Jacobs does show this), this “hint” is clearly not performed “successively providing over a period of time each of a plurality of portions of the representation of the puzzle object...,” as required by the instant claims.

As shown by example in the instant disclosure, a puzzle object is in the shape of the State of California. Pieces of this puzzle, or portions of the shape, are depicted automatically, without input from the user, once a certain website and/or game is activated, and the portions are successively provide automatically until such time as the puzzle is solved, with higher scores awarded for solving the puzzle earlier, when there are fewer portions displayed. It is this to which the claim language, “automatically and without requiring user input, successively providing over a period of time each of a plurality of portions of the representation of the puzzle object having at least one actual solution,” refers. We find nothing in Jacobs which acts in this manner. The “hint” of a free letter in Jacobs clearly does not operate “automatically and without requiring user input, successively providing over a period of time each of a plurality of portions of the representation of the puzzle object having at least one actual solution.”

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Accordingly, the examiner's decision rejecting claims 1, 12 and 23 under
35 U.S.C. §103 is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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MAHSHID D. SAADAT)	
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