

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL J. MATSKO and LEW P. NYCZ

Appeal No. 2004-0121
Application No. 09/507,368

ON BRIEF

Before GARRIS, OWENS, and NAPPI, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-31 which are all of the claims in the application.

The subject matter on appeal relates to a promotion method and apparatus which involve establishing a first game situation by computer, generating a number of first results by the computer, generating a number of second results by the computer

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using the first game situation and the first results as inputs, generating a second game situation by the computer using the second results as input, and determining whether to issue an award to the user using the second results as input only if the first game situation is a previous game situation from a previous play of the game by the user. This appealed subject matter is adequately illustrated by independent method claim 1 which reads as follows:

1. A promotion method comprising the steps of:
 - (a) executing a game by a computer within a retail establishment;
 - (b) identifying the user by the computer;
 - (c) establishing a first game situation for a user by the computer;
 - (d) generating a number of first results by the computer;
 - (e) generating a number of second results by the computer using the first game situation and the first results as inputs;
 - (f) generating a second game situation by the computer using the second results as input; and
 - (g) determining whether to issue an award to the user using the second results as input only if the first game situation is a previous game situation from a previous play of the game by the shopper [sic, user].

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results as input, and determining whether to issue an award using the second results as input only if the first game situation is a previous game situation from a previous play of the game by the user.

The examiner has properly indicated that the methods of Eggleston and the appellants share common goals and concepts. For example, patentee's incentive program may involve the consumer's historical participation therein (see lines 16-18 in column 13) or a combination of single incentive program types to build a combined incentive program (e.g., see the sentence bridging columns 31 and 32) or the successive completion of a series of programs over a period of time (see lines 11-16 in column 35). These concepts are at least similar to those upon which the here claimed invention is based. Nevertheless, the examiner has not identified and we do not independently find any disclosure in the Eggleston patent of the above discussed and here claimed combination of features (e.g., see steps (e), (f) and (g) in appealed claim 1).

Under these circumstances, it is our determination that the examiner has failed to carry his burden of establishing a prima facie case of anticipation. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). We cannot sustain,

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therefore, the examiner's section 102 rejection of all appealed claims as being anticipated by Eggleston.

The decision of the examiner is reversed.

Bradley R. Garris)	
Administrative Patent Judge)	
)	
)	
Terry J. Owens)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
Robert Nappi)	
Administrative Patent Judge)	

BRG:tdl

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