

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN M. SHANAHAN

Appeal No. 2004-2334
Application No. 09/888,145

ON BRIEF

Before FRANKFORT, NASE, and BAHR, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 14, all of the claims pending in this application.

As noted in appellant's specification, the present invention relates generally to card games, and more particularly to card games wherein the games are played using predetermined hands of cards that are each printed on a strip of paper and embedded in a fortune cookie. Figures 1 and 2 of the application depict a

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fortune cookie (10) used in the play of such card games wherein at least one strip of paper (12) having one hand unit of cards represented thereon is embedded in a fortune cookie in the conventional manner that traditional fortunes are currently embedded into fortune cookies. Independent claims 1, 6 and 11 are representative of the subject matter on appeal and a copy of those claims can be found in Appendix A of appellant's brief.

The prior art references of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. § 103(a) are:

Reynolds	3,768,813	Oct. 30, 1973
Mueller	3,770,278	Nov. 6, 1973

Claims 1, 3 through 6, 8, 10, 11, 13 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mueller.

Claims 2, 7, 9 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mueller in view of Reynolds.

Rather than reiterate the examiner's statement of the above-noted rejections and the conflicting viewpoints advanced by appellant and the examiner regarding those rejections, we refer to the answer (Paper No. 12, mailed October 1, 2003) for the

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examiner's reasoning in support of the rejections and to the brief (Paper No. 11, filed July 14, 2003) and reply brief (Paper No. 14, filed May 5, 2004) for appellant's views to the contrary.

OPINION

Our evaluation of the obviousness issues raised in this appeal has included a careful assessment of appellant's specification and claims, the applied prior art references, and the respective positions advanced by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

Before addressing the prior art rejections, we note that in the paragraph bridging pages 4 and 5 of the brief appellant has set forth several groupings of the claims to be considered on appeal. However, in the ensuing pages of the brief, appellant has presented arguments directed to both the independent claims on appeal and certain of the dependent claims contained in the various claim groupings mentioned above. See, e.g., arguments on pages 5-7 of the brief. Notwithstanding the inconsistency of appellant's actions in the brief, we are compelled to review the

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claims as argued by appellant and thus direct our attention to all of the claims on appeal that have been separately argued.

Looking to the prior art Mueller patent relied upon by the examiner in the rejection of claims 1, 3 through 6, 8, 10, 11, 13 and 14 under 35 U.S.C. § 103(a), we note that Mueller discloses a cookie game including a plurality of cookies (11) packaged together as a set with a fortune-like strip of paper (12) baked inside each cookie. Each strip of paper contains a segment of a written composition which is interrelated with segments found on the other fortune-like paper strips associated with other cookies in the package. When all the paper strips in the various fortune cookies in the package are properly arranged in a predetermined sequence they recreate the written composition. Each of the paper strips bears a randomly selected letter of the alphabet as an identifying mark and the package contains a separate key (Fig. 4) showing the correct arrangement of the paper strips to recreate the written composition.

Claim 11 on appeal is directed to a "novelty item" comprising,

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at least one strip of paper displaying one hand unit of cards, with each said hand unit comprising one or more cards with each said card bearing the indicia of one suit and one denomination to define a card game hand; and

a fortune cookie containing said strip so that indicia are not visible without breaking said fortune cookie.

Like the examiner, it is apparent to us that the only difference between the novelty item set forth in appellant's claim 11 and one of the fortune cookies shown in the cookie game of Mueller resides in the content of the printed matter carried by the strip of paper in each cookie and the meaning and information conveyed by such printed matter. The appropriate test for determining whether printed matter is entitled to patentable weight is set forth in In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 403 (Fed. Cir. 1983), which states at 217 USPQ 404

[w]here the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. Although the printed matter must be considered, in that situation it may not be entitled to patentable weight . . .

* * *

[w]hat is required is the existence of differences between the appealed claims and the prior art

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sufficient to establish patentability. The bare presence or absence of a specific functional relationship, without further analysis, is not dispositive of obviousness. Rather, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate (emphasis added).

In the present case, the mere arrangement of printed matter (i.e., one hand unit of cards) on a strip of paper to be incorporated into a fortune cookie does not appear to provide any new and unobvious functional relationship between the printed matter and the strip of paper. The only functional relationship that we discern between the above-noted printed matter and the strip of paper in appellant's claimed novelty item is that the paper strip acts to support or carry the printed matter. This, of course, is the exact same relationship that exists between the printed matter and the paper strips in the cookie game of Mueller. The fact that the content or meaning of information conveyed by the printed matter placed on the paper strips in Mueller may be different than that of the printed matter placed on appellant's paper strips does not alter the fact that in each instance the substrate or paper strip merely supports the printed matter thereon. Since we discern no new and unobvious functional relationship between the printed matter and the paper strip of

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appellant's claimed novelty item, we are led to the conclusion that such printed matter is not entitled to patentable weight.

Since, for the reasons stated above, we decline to accord the printed matter of appellant's novelty item any patentable weight, it follows that we will sustain the examiner's rejection of appealed claim 11 under 35 U.S.C. § 103(a). We do so, not because we agree with the examiner's misguided opinion that it would have been obvious at the time the invention was made to print card suit and denomination indicia on the paper strips of Mueller (answer, page 3), a conclusion for which the examiner has no factual basis, but because we find that appellant's item defined in claim 11 lacks novelty with regard to the fortune cookies found in Mueller. As has been made clear by our reviewing Courts on numerous occasions, anticipation or lack of novelty is the ultimate or epitome of obviousness. See, in this regard, In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).

We next look to the examiner's rejection of independent claims 1 and 6 under 35 U.S.C. § 103(a) based on Mueller. These

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claims are directed to a "pre-dealt card game" (claim 1) and a "pre-dealt poker game" (claim 6) comprising at least two separate hand units of cards, wherein each hand unit of cards is displayed on a paper strip at least partially contained inside a fortune cookie. Thus, appellant's game, like the cookie game of Mueller, requires a plurality of fortune cookies, with each cookie containing a strip of paper having game specific indicia printed thereon, i.e., a hand unit of cards in appellant's game and lines of text from a larger written composition in Mueller's game. In this instance, we find that the differences between the game defined in appellant's claims 1 and 6 on appeal and the cookie game of Mueller reside in the content of the printed matter carried by the strip of paper in each fortune cookie and the meaning and information conveyed to a user/player by such printed matter.

As with claim 11 discussed above, we find no new and unobvious functional relationship between the printed matter and the paper strips of appellant's claimed "card game" of claim 1 or "poker game" of claim 6, and thus conclude that the differences engendered by such printed matter are not entitled to patentable weight. Furthermore, like the examiner, we view the differences

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in this case to be akin to those in Ex parte Breslow, 192 USPQ 431 (BPAI 1975), wherein a merits panel of this Board determined that any differences between Breslow's game and the game of the Mitchel reference applied thereagainst resided in the meaning and information conveyed by the printed matter involved and not in any structure *per se*, such that the noted differences in printed matter were not entitled to patentable weight.

Contrary to appellant's views set forth in the brief and reply brief, we do not see that the invention as defined in claims 1 and 6 on appeal provides "a completely different game structure" (reply brief, page 4) than that disclosed in Mueller. Both appellant's game and that of Mueller require a plurality of fortune cookies with each of the cookies containing a strip of paper with game specific information printed thereon. Thus, appellant's game structure is essentially the same as that in Mueller, with the only distinction being provided by the different content of the printed matter carried on the paper strips in appellant's and Mueller's games and by the meaning and information conveyed to a user/player by such printed matter. However, under the test set forth in Gulack, *supra*, we have determined that such differences in the printed matter are not

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entitled to patentable weight. Accordingly, we sustain the examiner's rejection of claims 1 and 6 under 35 U.S.C. § 103(a) based on Mueller, again noting that lack of novelty is the ultimate or epitome of obviousness.

Concerning dependent claims 3 through 5, 8, 10, 13 and 14, we agree with the examiner's rejection of dependent claims 3, 4, 8, 10, 13 and 14 on the same basis as discussed above, but do not agree with the examiner's rejection of claim 5. Claim 5 adds to the structure of the game defined in independent claim 1 that "each fortune cookie includes more than one strip of paper." We do not see that the examiner has specifically dealt with this limitation and we find nothing in Mueller which would have been suggestive to one of ordinary skill in the art of more than one strip of paper in each fortune cookie. Thus, we will sustain the examiner's rejection of claims 3, 4, 8, 10, 13 and 14, but not that of claim 5.

The next rejection for our review is that of claims 2, 7, 9 and 12 under 35 U.S.C. § 103(a) as being unpatentable over Mueller in view of Reynolds. As noted on pages 3-4 of the answer, it is the examiner's view that

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Mueller teaches all limitations of these claims except that it does not teach perforation on strips for separation of cards. Reynolds teaches perforation on strips for card separation. In order to detach cards from the strip, it would have been obvious to use perforation. One of ordinary skill in the art at the time the invention was made would have used perforation for easy separation of cards from the strip.

Like appellant (brief, pages 9-10), we find no teaching, suggestion or incentive for combining the applied references in the manner urged by the examiner; that is, no reason or motivation for attempting to provide perforations of the type claimed by appellant in the paper strips of Mueller's cookie game wherein a segment of a written composition is contained on each of the paper strips. Except for hindsight afforded by first having read appellant's application, the examiner has no factual basis whatsoever for providing the paper strips in Mueller with a hand unit of cards, where each of the cards bears one predetermined suit and denomination, and then further providing a perforation between each of the cards on the paper strip to allow selective separation of each of the cards from the strip. For these reasons, we will not sustain the examiner's rejection of claims 2, 7, 9 and 12.

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To summarize, we have sustained the examiner's rejection of claims 1, 3, 4, 6, 8, 10, 11, 13 and 14 under 35 U.S.C. § 103(a), but not the rejection of claims 2, 5, 7, 9 and 12. Thus, the decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	

CEF/lbg

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RADER, FISHMAN & GRAUER PLLC
39533 WOODWARD AVENUE
SUITE 140
BLOOMFIELD HILLS, MI 48304-0610