

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEITH A. BUTLER, II

Appeal No. 2005-1266
Application No. 10/227,755

ON BRIEF

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

DECISION ON APPEAL

Keith A. Butler, II appeals from the final rejection of claims 1 through 8 and 11, all of the claims pending in the application.

THE INVENTION

The invention relates to "a board game for teaching the biblical and natural principles of personal financial wealth" (specification, page 1). Representative claims 1 and 11 read as follows:

Claim 1. A board game comprising:
a plurality of playing pieces, each playing piece being representative of a different player;
a supply of simulated money;
at least one die for randomly determining the movement of said playing pieces;

a game board divided into first, second and third sections, each section having defined spaces indicating an instruction to be executed by the player, each player being required to advance sequentially through said first and second sections and to be on the third section to be eligible to win said game;

a plurality of consequence cards labeled to match spaces on said board, said cards to be randomly drawn by a player which provide instructions to be followed by the player; and

a plurality of stewardship cards, each player utilizing a stewardship card to record their relative position during the game;

whereby the first player who completes their stewardship card is declared the winner.

Claim 11. A method of playing a board game comprising:
providing a game board divided into first, second and third sections, each section having defined spaces indicating an instruction to be executed by the player;

providing a plurality of playing pieces, each playing piece being representative of a different player;

providing a supply of simulated money;

providing a plurality of stewardship cards for each player;

rolling at least one die to randomly determine the movement of said playing pieces;

moving said playing pieces sequentially through said first and second sections and then to said third section to be eligible to win said game;

drawing one of a plurality of consequence cards labeled to match spaces on said game board, said consequence cards providing instructions to be followed by the players;

collecting or dispensing said simulated money according to instructions on said consequence cards and said game board; and

utilizing a stewardship card to record the relative position of the players during the game such that the first player who completes their stewardship card is declared the winner.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Smith	5,071,133	Dec. 10, 1991
Rosi	6,425,582	Jul. 30, 2002

THE REJECTIONS

Claims 1 through 8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Smith.

Claim 11 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Rosi.

Attention is directed to the main and reply briefs (filed March 17, 2004 and July 30, 2004) and the final rejection and answer (mailed December 29, 2003 and June 16, 2004) for the respective positions of the appellant and the examiner regarding the merits of these rejections.

DISCUSSION

I. The 35 U.S.C. § 102(b) rejection of claims 1 through 8 as being anticipated by Smith

The appellant, stating that “[c]laims 1-8 and 11 stand or fall together” (reply brief, page 2), does not separately argue the patentability of any of these claims apart from the others.

Hence, claims 2 through 8 shall stand or fall with representative claim 1 (see In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978)).

Smith discloses a board game designed to teach biblical principles. The game includes a game board 10, a plurality of playing pieces 90 each representative of a different player, a supply of simulated money (see the Abstract; and column 1, lines 26 through 30), at least one die 85 for randomly determining the movement of the playing pieces, a plurality of consequence cards in the form of "sin," "providence," "blessing" and "reward" cards 50, 55, 60 and 65 which are labeled to match spaces on the board and randomly drawn by a player to provide instructions to be followed by the player, and a plurality of stewardship cards in the form of asset and end of life tally sheets (see column 5, line 63, through column 6, line 17) for recording the relative positions of the players during the game. The board 10 (see Figure 1C) includes first, second and third sections respectively embodied by an outer octagonal section, an inner branch section extending between spaces 30 through 35 and a further inner branch section extending between spaces 35 through 45. Each of these sections has defined spaces indicating an instruction to be

executed by a player, and each player must advance sequentially through the first and second sections and be on the third section to be eligible to win the game (see column 6, line 23, through column 10, line 24).

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

The appellant (see pages 4 through 14 in the main brief and pages 4 through 6 in the reply brief) contends that the rejection based on Smith is unsound because Smith does not disclose (1) a supply of simulated money, (2) a game board divided into first, second and third sections with each player being required to advance sequentially through these sections to be eligible to

win, and (3) a plurality of stewardship cards with each player utilizing a card to record his or her relative position during the game whereby the first player to complete a card is declared the winner. Given the fair teachings of Smith and the actual scope of representative claim 1, however, the appellant's position is not persuasive.

To begin with, Smith's disclosure of "play money" (Abstract) which is credited to the players (see, for example, column 1, lines 26 through 30) responds fully to the limitation in claim 1 calling broadly for a supply of simulated money. Notwithstanding the appellant's implication to the contrary (see, for example, pages 6, 13 and 14 in the main brief), claim 1 does not require the supply of simulated money to be in the form of paper.

Furthermore, and as pointed out above, Smith's game board 10 comprises first, second and third sections whereby each player must advance sequentially through the first and second sections and be on the third section to be eligible to win the game as recited in claim 1.

Finally, and as also pointed out above, Smith's asset and end of life tally sheets in effect constitute stewardship cards for recording the relative positions of the players during

the game. Although Smith does not teach that the first player to complete a card is declared the winner as recited in claim 1, the corresponding language in the claim amounts to a functional limitation which sets forth the manner in which the stewardship cards are intended to be used. It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). In other words, the manner or method in which a device is to be utilized is not germane to the issue of patentability of the device itself. In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967). In the present case, the appellant has not cogently explained, and it is not apparent, why Smith's "stewardship" cards are not inherently capable of the use specified in claim 1.

In light of the forgoing, the appellant's argument that the subject matter recited in claim 1 distinguishes over that disclosed by Smith is unconvincing. Therefore, we shall sustain the standing 35 U.S.C. § 102(b) rejection of claim 1, and claims 2 through 8 which stand or fall therewith, as being anticipated by Smith.

II. The 35 U.S.C. § 102(e) rejection of claim 11 as being anticipated by Rosi

Rosi discloses a board game having a gangster motif. The following passage from the reference fairly summarizes the game:

Yet another object of the present invention is to provide a new gangster board game which includes a game board [10] having a plurality of playing spaces [11a, 11b] arranged in a pair of [square] paths including an inner location path [12] and an outer sidewalk path [13]. The playing spaces forming the inner location path are designated location playing spaces and the playing spaces forming the outer sidewalk path are designated sidewalk playing spaces. Each of the location playing spaces is assigned a unique game location and having indicia indicating the unique game location of the respective location playing spaces. Each of the sidewalk playing spaces being having unique playing instructions displayed therein. Each player is assigned a playing piece [15] and corresponding police record sheet [16] to each player, a sum of the play money [17], a contract card [21] and a contract recording sheet [22]. A plurality of sequential player turns are performed comprising rolling a die [18], moving the playing piece of the player a number of sidewalk playing spaces corresponding to the value rolled on the normal die, performing the instructions displayed on the sidewalk space on which the playing piece terminates its move on, performing the instructions of the steps of the contract card of the player, and recording completion of the performed instructions of the steps of the contract card of the player. The first player to complete performance of all of the instructions of all of the steps of their contract card is declared the winner [column 3, lines 30 through 54].

Rosi also teaches that in attempting to complete a contract card, "[t]he contracts will have you moving all over the board in

order to achieve your goal. It is up to your discretion how to move your man around and in which direction [column 7, lines 31 through 34].

Claim 11 recites a method of playing a board game comprising, inter alia, the steps of (1) providing a game board divided into first, second and third sections and (2) moving playing pieces sequentially through the first and second sections and then to the third section to be eligible to win the game. The examiner's finding that "each side of the [Rosi] board is being interpreted as a section of the path" (final rejection, page 2) is reasonable on its face. Consequently, Rosi does meet the first of the above noted steps in claim 11. The examiner's additional determination that "[t]he continuous circling [i.e., square] configuration [of Rosi's path] clearly demonstrates the [claimed] sequential movement of playing pieces" (answer, page 4) is not well taken. As indicated above, Rosi indicates that it is within each player's discretion how and in which direction to move his or her playing piece around the board. This disclosure does not embody a fair teaching of a step of moving playing pieces sequentially through first and second sections and then to a third section to be eligible to win the game as set forth in claim 11.

Thus, as applied by the examiner, Rosi does not disclose, either expressly or inherently, each and every element of the method recited in claim 11. Accordingly, we shall not sustain the standing 35 U.S.C. § 102(e) rejection of claim 11 as being anticipated by Rosi.

SUMMARY

The decision of the examiner to reject claims 1 through 8 and 11 is affirmed with respect to claims 1 through 8 and reversed with respect to claim 11.

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

JOHN P. MCQUADE)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
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