

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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ROBYN SHALIT

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Appeal No. 2006-0811  
Application No. 10/323,510

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ON BRIEF

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Before FRANKFORT, OWENS, and BAHR, *Administrative Patent Judges*.  
OWENS, *Administrative Patent Judge*.

*DECISION ON APPEAL*

This appeal is from a rejection of claims 1-25, which are all of the pending claims.

*THE INVENTION*

The appellant claims a board game and a method for playing the game. Claims 1 and 16 are illustrative:

1. A game comprising:
  - a. a plurality of game pieces having game piece indicia thereon; and
  - b. at least one game board having game board indicia thereon corresponding to at least one of said game piece indicia, said at least one game board having a tracing area comprising a symbol educationally corresponding to said game board indicia.

16. A method of playing a game including a plurality of game pieces having game piece indicia thereon, and at least one game board having game board indicia thereon which corresponds to at least of some of said game indicia, said method comprising:

- a. selecting a game piece from said plurality of game pieces;
- b. selecting a game board;
- c. checking to determine if a match exists between said game piece indicia on said selected game piece and said game board indicia; and
- d. if a match is found to exist, tracing within a tracing area on said game board something that corresponds to said indicia.

*THE REFERENCES*

Corday	4,226,420	Oct. 7, 1980
Hankins	4,306,868	Dec. 22, 1981
McAllister	4,952,153	Aug. 28, 1990
Adkison	5,626,477	May 6, 1997

Diagram Group, "The Way to Play" (Bingo) 274-75 (Paddington Press, date stamped Mar. 15, 1976).

*THE REJECTIONS*

The claims stand rejected as follows: claims 1-4, 9-11, 14 and 15 under 35 U.S.C. § 102(b) as anticipated by Adkison; claims 1, 11 and 16 under 35 U.S.C. § 102(b) as anticipated by Bingo; claims 5, 6, 12 and 13 under 35 U.S.C. § 103 as obvious over Adkison in view of Hankins; claim 7 under 35 U.S.C. § 103 as obvious over Adkison in view of McAllister; claim 8 under 35 U.S.C. § 103 as obvious over Adkison in view of Corday; claims 21, 24 and 25 under 35 U.S.C. § 103 as obvious over Bingo

in view of Hankins; and claims 17-23 under 35 U.S.C. § 103 as obvious over Bingo in view of Adkison.

*OPINION*

The rejections of claims 1-4, 9-11, 14 and 15 under 35 U.S.C. § 102(b) over Adkison, claims 6 and 13 under 35 U.S.C. § 103 over Adkison in view of Hankins, claim 7 under 35 U.S.C. § 103 over Adkison in view of McAllister, and claim 8 under 35 U.S.C. § 103 over Adkison in view of Corday, are affirmed. The rejections of claims 1, 11 and 16 under 35 U.S.C. § 102(b) over Bingo, claims 5 and 12 under 35 U.S.C. § 103 over Adkison in view of Hankins, claims 21, 24 and 25 under 35 U.S.C. § 103 over Bingo in view of Hankins, and claims 17-23 under 35 U.S.C. § 103 over Bingo in view of Adkison, are reversed.

We address the claims separately to the extent justified by the appellant's arguments. See 37 CFR § 41.37(c) (1) (vii) (2004).<sup>1</sup>

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<sup>1</sup>Although additional references are applied to claims 7 and 8, the appellant does not provide a substantive argument as to the separate patentability of those claims (brief, page 12).

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*Rejection of claims 1-4, 9-11, 14 and 15  
under 35 U.S.C. § 102(b) over Adkison*

Adkison discloses a game comprising 1) cards which each have thereon a picture, the name of what is pictured, and the capital and small letter with which the name of what is pictured begins (figure 7), and 2) a game board having rectangular sections, each having one of the cards' picture, name and letters (figure 6).

The appellant argues that Adkison does not disclose a tracing area (brief, pages 7-9). The picture, word and letters in each rectangular section of Adkison's game board are capable of functioning as a tracing area. To the extent that a "tracing area" must be shaped to provide guidance, we note that the picture, word and letters on Adkison's board are shaped to provide guidance in that small child could readily trace the shape of the letters, the outline of the picture and the individual letters of the word appearing in each square of the game board by using either a finger or a stylus.

We therefore are not convinced of reversible error in the examiner's rejection of claims 1-4, 9-11, 14 and 15 under 35 U.S.C. § 102(b) over Adkison.

*Rejection of claims 1, 11 and 16  
under 35 U.S.C. § 102(b) over Bingo*

The examiner argues that Bingo discloses "selecting a bingo ball from a plurality of balls, selecting a came [sic, game] card, checking to determine if a match exists, and in that case the area corresponding to that number is either filled with a crayon or marked as being a matched number" (answer, page 4). Bingo discloses, in the commercial session embodiment, writing the called numbers in boxes in one of three rows on a card (page 274). The boxes into which the numbers are written are blank, and the numbers are merely written into the boxes. There is no tracing area "comprising a symbol educationally corresponding to said game board indicia" as required by claim 1, or step of tracing as required by claim 16. Consequently, the examiner has not established a prima facie case of anticipation over Bingo of the game claimed in the appellant's claims 1 and 11 or the method claimed in the appellant's claim 16.

*Rejection of claims 5, 6, 12 and 13 under 35 U.S.C. § 103  
over Adkison in view of Hankins*

Claims 5 and 12 require that the tracing area comprises an erasable surface.<sup>2</sup>

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<sup>2</sup>Those claims erroneously recite "drawing area" instead of "tracing area".

Hankins discloses an instructional and recreational apparatus having a plurality of writing surfaces, one of which is a chalk board (33) having an eraser supporter (34) (col. 3, lines 1-4).

The examiner argues that it would have been obvious to one of ordinary skill in the art to make Adkison's board erasable for repeated use to save money (answer, page 5). Adkison does not write on his board but, rather, places blocks or cards on the board (col. 1, line 35 - col. 2, line 20). Hence, the benefit argued by the examiner is not relevant to Adkison's board. The examiner, therefore, has not established a prima facie case of obviousness of the game claimed in the appellant's claims 5 and 12.

As for claims 6 and 13, the appellant argues that Hankins' storage compartment (21) is not a game piece retainer (brief, pages 11-12 and 14-15). That storage compartment (col. 2, lines 16-17; figure 1) corresponds to the appellant's game piece retainer because it has an exterior surface (i.e., its walls) and a game piece holder (i.e., the floor of the opening between the walls) that is adjacent to the exterior surface and is capable of holding a game piece thereon at a position such that the game piece is visible from above to game players. As argued by the

examiner (answer, page 5), including such a storage compartment with Adkison's board would have provided a place to store Adkison's blocks and cards. The appellants argue that the retainer serves a valuable educational function (brief, page 12). Such an educational function is not required by claims 6 and 13. For these reasons we are not convinced of reversible error in the examiner's rejection of claims 6 and 13.

*Rejection of claims 21, 24 and 25 over  
Bingo in view of Hankins, and  
claims 17-23 over Bingo in view of Adkison*

As indicated above, the rejection of claim 16 under 35 U.S.C. § 102(b) over Bingo is reversed. Claims 17-25 depend directly or indirectly from claim 16, and the examiner does not rely upon Hankins or Adkison for any disclosure that remedies the deficiency in Bingo as to claim 16. Thus, the examiner has not established a prima facie case of obviousness of the methods claimed in claims 17-25.<sup>3</sup>

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<sup>3</sup> The examiner and the appellant should address whether

*DECISION*

The rejections of claims 1-4, 9-11, 14 and 15 under 35 U.S.C. § 102(b) over Adkison, claims 6 and 13 under 35 U.S.C. § 103 over Adkison in view of Hankins, claim 7 under 35 U.S.C. § 103 over Adkison in view of McAllister, and claim 8 under 35 U.S.C. § 103 over Adkison in view of Corday, are affirmed. The rejections of claims 1, 11 and 16 under 35 U.S.C. § 102(b) over Bingo, claims 5 and 12 under 35 U.S.C. § 103 over Adkison in view of Hankins, claims 21, 24 and 25 under 35 U.S.C. § 103 over Bingo in view of Hankins, and claims 17-23 under 35 U.S.C. § 103 over Bingo in view of Adkison, are reversed.

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there is adequate antecedent basis for "said step of drawing in a drawing area" in claim 17, "the step of drawing" in claim 24, and "said drawing area on said game board" in claim 25.

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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	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
TERRY J. OWENS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

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