

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTOPHER JANNEY

Appeal No. 2006-1533
Application No. 10/607,472
Technology Center 3700

Decided: March 16, 2007

Before TERRY J. OWENS, MURRIEL E. CRAWFORD, and JENNIFER D. BAHR, *Administrative Patent Judges*.

TERRY J. OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

The Appellant appeals from a rejection of claims 1, 3, 4, 7-12 and 15-21, which are all of the pending claims.

THE INVENTION

The Appellant claims a color card game. Claim 1 is illustrative:

1. A color card game comprising:
a plurality of color cards each displaying a unique color, each unique color comprising a unique mixture of a hue and an intensity,
wherein each color card further displays a hue indicia

identifying the hue of each color card and an intensity indicia
identifying the intensity of each color card; and
a chromatic wheel displaying all the unique colors displayed on the
color cards in a chromatic order in which the color cards are to
be aggregated.

THE REFERENCES

Brandt	US 1,568,206	Jan. 5, 1926
Howard	US 1,738,902	Dec. 10, 1929
Napolitano	US 5,362,061	Nov. 8, 1994

THE REJECTIONS

The claims stand rejected as follows: claims 1, 3 and 4 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Napolitano; claims 1, 3 and 4 under 35 U.S.C. § 103 as obvious over Napolitano in view of Brandt; and claims 7-12 and 15-21 under 35 U.S.C. § 103 as obvious over Napolitano in view of Brandt and Howard.

OPINION

We affirm the aforementioned rejections.

Rejection over Napolitano

Napolitano discloses a board game comprising a chance device (14) having a printed circular area (16) divided into eight pie-shaped sections, each colored one of the eight basic colors (col. 2, ll. 15-16 and 36-38). Near the border of each side of a game board (2) are two square areas (20), each colored with a different one of the eight basic colors (col. 2, ll. 41-43). A user places on top of each colored area a plurality of matching color cards (22) (col. 2, ll. 43-46).

The Appellant argues that each of Napolitano's cards does not have a unique color and intensity (Br. 8 and 17-19). The Appellant's broadest claims do not require each card to have a unique color and intensity. Those claims merely require a plurality of color cards each having a unique color, hue and intensity. That claim requirement is met by any two to eight of Napolitano's cards having a different color and its corresponding hue and intensity. Regardless, the color of the Appellant's cards is nonfunctional descriptive material, i.e., it does not have any new and unobvious functional relationship with its substrate. *See In re Gulack*, 703 F.2d 1381, 1386, 217 USPQ 401, 404 (Fed. Cir. 1983). The color, therefore, does not patentably distinguish the cards over cards having other indicia such as a different color. Likewise, contrary to the Appellant's argument (Br. 8), the colors and their arrangement in the Appellant's chromatic wheel do not patentably distinguish the chromatic wheel over the Napolitano game board's circular area having pie-shaped, colored sections (col. 2, ll. 41-43).

The Appellant argues, in reliance upon *Gulack*, that the Appellant's colors enable the cards to be aggregated in a particular order (Br. 12-13). If that were a patentable distinction, then a piece of paper having a floor plan thereon would be patentable over a similar piece of paper having music thereon because it would enable a building to be built rather than a song to be played. Actually, the indicia would not render one piece of paper patentable over the other. Likewise, the Appellant's colors do not render the Appellant's cards and chromatic wheel patentable over Napolitano's cards and game board's circular area with pie shaped sections having different colors.

The Appellant argues that in *Gulack* the only difference between Gulack’s rings and the rings in the Witcoff reference was that the digits on Gulack’s rings were printed in a particular order such that rings could be aggregated to form an endless loop,¹ and that “Gulack’s rings were held to be patentable because the numbering formed a functional relationship with the rings by forming a loop” (Br. 12).

The court in *Gulack* considered the bands of Gulack and Witcoff to be similar in that they both supported data. *See Gulack*, 703 F.2d at 1386, 217 USPQ at 405. The difference, in the court’s view, was that Witcoff’s “data items are independent, bearing no direct relation to the other data entries on Witcoff’s band”, *id.*, whereas Gulack’s data had “an endless sequence of digits – each digit residing in a unique position with respect to every other digit in an endless loop”. *Gulack*, 703 F.2d at 1386-87, 217 USPQ at 405. Thus, the patentable distinction was the relation of Gulack’s digits to other digits, i.e., the algorithm used to generate the digits, not the relation of the digits to the band. Although the court stated that “the digits exploit the endless nature of the band”, *Gulack*, 703 F.2d at 1387, 217 USPQ at 405, as pointed out in the dissent, “at oral argument the Appellant conceded that the same result his invention accomplishes also could be accomplished by placing the numbers in a continuous series upon a cube or other shape, or even by writing them in a circle upon a flat surface.” *Id.* Hence, as stated in the dissent, “[t]he precise nature of the object on which the numbers are placed is thus of little importance.” *Id.* Thus, the Appellant’s argument that “Gulack’s rings were held to be patentable because the numbering formed a

¹ Actually, there was no aggregation of rings to form an endless loop. The numbers formed a loop on each ring. *See Gulack*, 703 F.2d at 1382, 217

functional relationship with the rings by forming a loop” (Br. 12) is not availing to the Appellant because the numbers could have formed a loop on any substrate.

Unlike *Gulack*, the Appellant in the present case does not have a new algorithm. Like the Appellant’s color cards and chromatic wheel, Napolitano’s color cards have the capability of being aggregated according to colors on the circular area with pie-shaped sections (col. 2, ll. 36-38). The Appellant argues that Napolitano does not disclose that type of aggregation (Br. 12 and 17; Reply Br. 8), but that argument is not persuasive because the Appellant is claiming a game device, not a method of playing a game. The claims require color cards that can be aggregated according to a chromatic order of colors on a chromatic wheel, and Napolitano’s color cards and circular area with pie-shaped sections (col. 2, ll. 36-38) have that capability. Because the Appellant’s specification does not provide a limiting definition of “chromatic order”, any order of colors in Napolitano’s pie-shaped sections reasonably can be considered a chromatic order.²

The Appellant argues that in *In re Levin*, 107 F.2d 30 (Fed. Cir. 1997), the Federal Circuit applied *Gulack* to printed color materials under 35 U.S.C. § 101 (Br. 13). That argument is irrelevant to the present rejections under 35 U.S.C. §§ 102(b) and 103.

The Appellant relies (Br. 14) upon the statement by the court in *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004) that

USPQ at 402.

² The Appellant’s argument that Napolitano’s “sections are arranged in a random-order to enable the required ‘chance’ functionality” (Br. 19) is not well taken because it is the spinning of the spinner (18) that enables the chance functionality (col. 3, ll. 61-63), not the arrangement of the colors.

“[i]n Gulack, the printed matter would not achieve its educational purposes without the band, and the band without the printed matter would similarly be unable to produce the desired result.” Actually, as pointed out above, Gulack’s printed matter would achieve its educational purposes on any substrate. The Appellant argues that “the cards of the present invention would not achieve their purpose of aggregation without the inclusion of unique coloring and the coloring would not achieve its purpose without the cards” (Br. 14). That argument is not persuasive because without the coloring the Appellant’s cards still would function as cards, and without the cards the Appellant’s colors could be aggregated on any other substrate.

The Appellant argues that Napolitano’s cards do not have hue and intensity indicia (Br. 18-19). Like the colors, the indicia are nonfunctional descriptive material and, therefore, do not patentably distinguish the claimed invention over Napolitano. Without the indicia, the cards would still function as cards, and without the cards, the indicia could be placed on any other substrate.

For the above reasons we are not convinced of reversible error in the Examiner’s rejection over Napolitano.³

Rejection over Napolitano in view of Brandt

Brandt discloses playing cards having numerals and blank circular and triangular portions that distinguish indices for people who are color blind (p. 2, ll. 6-10 and 30-35).

³ We do not address the Appellant’s arguments regarding *Ex parte Breslow*, 192 USPQ 431 (Bd. App. 1975), *Ex parte Fredlund*, 2002 WL 31321750 (Bd. Pat. App. & Int. 2002) and *Ex parte Brassey*, 2003 WL 23013149 (Bd. Pat. App. & Int. 2003) (Br. 14-16) because they are not binding precedent upon this panel.

There is no dispute as to whether it would have been obvious to one of ordinary skill in the art to put Brandt's indicia on Napolitano's cards. The Appellant argues that Brandt discloses, at most, indicating what index is being played, not its intensity (Br. 21). The Appellant's indicia are nonfunctional descriptive material because without the indicia the cards still would function as cards, and without the cards the indicia could be placed on any other substrate. Hence, the Appellant's indicia do not patentably distinguish the Appellant's cards from Napolitano's cards having Brandt's indicia.

We therefore are not convinced of reversible error in the Examiner's rejection over Napolitano in view of Brandt.

Rejection over Napolitano in view of
Brandt and Howard

Howard discloses a card game having joker cards (10; p. 2, ll. 82-85; figs. 3 and 4) which the Examiner relies upon as corresponding to the Appellant's wild cards (Answer 6).

There is no dispute as to whether it would have been obvious to one of ordinary skill in the art to include Howard's joker cards among Napolitano's cards. The Appellant argues that "neither Howard, Brandt, or [sic] Napolitano, alone or in combination, disclose or suggest a plurality of uniquely colored cards, cards having hue and intensity indicia, or a chromatic wheel" (Br. 21). That argument is not persuasive for the reasons given above regarding the rejections over Napolitano and over Napolitano in view of Brandt.

Hence, we are not convinced of reversible error in the Examiner's rejection over Napolitano in view of Brandt and Howard.

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DECISION

The rejections of claims 1, 3 and 4 under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103 over Napolitano, claims 1, 3 and 4 under 35 U.S.C. § 103 over Napolitano in view of Brandt, and claims 7-12 and 15-21 under 35 U.S.C. § 103 over Napolitano in view of Brandt and Howard, are affirmed.

AFFIRMED

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

jrg

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