

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 JUSTIN L. VODEN

Appeal No. 2006-1747
Application No. 10/455,666

HEARD: JULY 13, 2006

Before FRANKFORT, OWENS and CRAWFORD, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from a rejection of claims 1-5, 17-23, 34 and 38. Claims 6-13, 15, 16, 24-33, 36 and 37 have been indicated allowable. Claims 14 and 35 have been canceled. Claims 39-45 have been withdrawn from consideration by the examiner.

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THE INVENTION

The appellant claims a rotary game table having on opposite sides thereof two of the following: a pool table, an air powered hockey table, and a gaming table. Claim 1 is illustrative:

1. A rotary game table comprising:

a combination game table including a pool table disposed on one side and an air powered hockey table disposed on the other side thereof, said combination game table including two end frame members and two lengthwise frame members, a space being defined between said pool table and said air powered hockey table, at least one air opening being formed through at least one of said frame members of said combination game table, said at least one air opening communicating with said space;

at least one air blower retained within said space;

two side support members;

at least one cross member being terminated by one of said two side support members on each end thereof, said combination game table being pivotally supported on each end by one of said two side support members; and

a pair of support latches being contained in at least one of said two side support members, said pair of support latches preventing said combination game table from rotating.

THE REJECTION

Claims 1-5, 17-23, 34 and 38 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one of ordinary skill in the art to make and/or use the

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invention.^{1,2,3,4,5}

OPINION

We reverse the rejection of claims 1-5 and 17-23, and affirm the rejection of claims 34 and 38.

Claims 1-5 and 17-23

The examiner argues that "[t]he application as filed does

1 The examiner does not argue that the appellant's disclosure would have failed to enable one of ordinary skill in the art to make and use the claimed invention. Hence, we consider the examiner's rejection to be under the 35 U.S.C. § 112, first paragraph, written description requirement.

2 The examiner omits claim 38 from the statement of the rejection (answer, page 3). However, the examiner's reliance upon the comments regarding claim 34 (answer, page 4) indicates that the examiner intends for the argument set forth regarding claim 34 to be applied to the same issue in claim 38.

3 The examiner does not formally reject claims 19 and 38 under 35 U.S.C. § 112, second paragraph, but argues that those claims are indefinite (answer, pages 4-5). Regarding claim 19 the examiner argues: "The drawer has only one space there are no compartments. Therefore, to claim 'a space of a drawer' would not only introduce new matter, but also render the claim indefinite" (answer, page 4). Claim 19, which requires "an air blower being retained in a drawer, said drawer being slidably retained in said combination game table" does not recite "a space of a drawer". Thus, it is the examiner's argument, rather than claim 19, that is unclear. As for claim 38, the examiner argues that it is unclear why an electrical cord has been provided with a combination gambling and billiards table (answer, pages 4-5). The relevant inquiry under 35 U.S.C. § 112, second paragraph, is whether the claim language, as it would have been interpreted by one of ordinary skill in the art in light of the appellant's specification, sets out and circumscribes a particular area with a reasonable degree of precision and particularity. See *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). There is no requirement that the claims include an explanation as to why the claims include the recited elements.

4 The examiner objects under 35 U.S.C. § 132 to an amendment filed September 13, 2004 as introducing new matter to the disclosure (answer, page 5). The alleged new matter, i.e., deletion of the requirement that the pool table is full sized and changing "at least one spring pin" to "a respective spring pin", does not pertain to an issue before us on appeal. Consequently, the objection is a petitionable issue to be decided by the group director, rather than an appealable issue to be decided by the board. See *Manual of Patent Examining Procedure* § 1002.02(c)(3)(c), 8th ed., rev. 2, May 2004.

5 The examiner argues that "[i]f indeed one is to interpret that a drawer is the space or cavity as appellant appears to be suggesting, then it is noted that the claims could be rejected over the prior art of record, namely Kavka '127 [US D247,127] and Tsai '797 [US 6,347,797]" (supplemental answer, page 2). Kavka does not disclose an air blower, and Tsai's air blower (65) is mounted at the end of a combination table rather than in a space or cavity between the two tables.

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not provide support for the newly added limitation 'at least one air blower being retained within said space' as in claim 1, or [']with a cavity formed therebetween, the cavity constructed to receive a blower motor therein' as in claim 17" (answer, page 3).

The examiner acknowledges that "[t]he specification provides support for an air blower retained in a sliding drawer between the pool [table] and air powered hockey table between the cavity surface". See *id.* Thus, the examiner's argument is that the appellant's specification requires that the air blower must be in a drawer in the space or cavity between the pool table and the air powered hockey table.

The examiner's argument is not persuasive even if it is correct. The reason is that, as pointed out by the appellant (reply brief, page 5), the drawer fits in a space or cavity between the pool table and the air powered hockey table, and the drawer has a space or cavity within it. Hence, the air blower in the drawer is within a space or cavity between the pool table and the air powered hockey table.

We therefore reverse the rejection of claims 1-5 and 17-23.

Claims 34 and 38

Independent claim 32 requires a combination game table having a pool table on one side and a gambling table on the other

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side. Claims 34 and 38 depend from claim 32 and require an air blower.⁶

The examiner argues that "the application as filed does not provide support for an air blower retained in a drawer in a combination game table wherein the combination table is a pool table and a gambling table" (answer, page 3).

The appellant argues (brief, page 11) that the specification states that "[t]he combination game table 136 may be substituted for the combination game table 10 in any of the preferred embodiments 1-4" (page 16). Combination game table 10 has a pool table on one side and an air powered hockey table on the other side (specification, page 8), and combination game table 136 has a gambling table on one side and either a pool table or an air hockey table on the other side (specification, pages 16-17). The specification does not disclose an air blower with a combination pool table and gambling table.

The appellant argues that the disclosure that combination game table 136 preferably has a pool table opposite the gambling table but may have another game surface such as an air hockey surface (specification, page 17) "clearly discloses a combination

⁶ In the event of further prosecution the examiner and the appellant should address on the record whether there is adequate antecedent basis for "said air blower" in claim 38.

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game table having a gambling table and an air hockey table and that the combination game table 136 can include a pool table and gambling table that is convertible to an air hockey surface" (brief, page 11). The specification discloses that a pool table or an air hockey table can be opposite the gambling table, but does not disclose that the pool table is convertible to an air hockey table.

The appellant argues that "[a]s clearly stated in the Specification, any table of the multiple embodiments could be adapted or modified to play games that require an airflow if an air blower were included during manufacture as disclosed" (brief, page 11). The appellant does not point out the relied upon disclosure in the specification, and none is apparent.

For the above reasons we are not convinced of reversible error in the examiner's rejection of claims 34 and 38.

DECISION

The rejection of claims 1-5, 17-23, 34 and 38 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one of ordinary skill in the art to make and/or use the

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invention, is reversed as to claims 1-5 and 17-23, and affirmed as to claims 34 and 38.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(vii).

AFFIRMED-IN-PART

CHARLES E. FRANKFORT)
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