

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 FERNANDO MAURO MARCILIO

Appeal 2006-2056
Application 10/102,192
Technology Center 3700

Decided: March 28, 2007

Before WILLIAM F. PATE, III, TERRY J. OWENS, and JENNIFER D. BAHN, *Administrative Patent Judges*.

PATE, III, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 3, 6, and 12-20. The rejection of claims 1-11 based on prior art was withdrawn by the Examiner in the Answer.

The claimed invention is directed to a method of playing a card game and equipment used for playing the game. Claim 12 reproduced below is further indicative of the claimed subject matter:

12. Equipment for use in playing a card game comprising:

only one deck of cards; and

said at least one deck of cards having fours [sic, four] suits only with cards numbered 2 to 10 in each suit and with an ace in each suit.

The references of record relied upon by the Examiner as evidence of anticipation and obviousness are:

Webb	US 5,685,774	Nov. 11, 1997
Adams	US 5,743,798	Apr. 28, 1998
Baerlocher	US 6,435,970 B1	Aug. 20, 2002

Claim 1 stands rejected under 35 U.S.C. § 112, first paragraph, as based on a disclosure which does not provide written description support for the claimed subject matter.

Claims 3 and 6 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite.

Claims 12-14 and 16 stand rejected under 35 U.S.C. § 102 as anticipated by Webb.

Claims 17-19 stand rejected under 35 U.S.C. § 103 as unpatentable over Webb in view of Adams.

Claim 15 stands rejected under 35 U.S.C. § 103 as unpatentable over Webb in view of Baerlocher.

Claim 20 stands rejected under 35 U.S.C. § 103 as unpatentable over Adams in view of Baerlocher.

ISSUES

The following issues are before us on appeal. First, whether claim 1 is based on a Specification that does not provide written description support

for the claimed subject matter. Further, whether claims 3 and 6 are indefinite under the purview of 35 U.S.C. § 112, second paragraph. Third, whether claims 12-14 and 16 are properly rejected as lacking novelty over Webb, and, finally, whether claims 15 and 17-20 are unpatentable under § 103.

FINDINGS OF FACT

Appellant's Specification clearly discloses that in order to be eligible for an add on prize, the player must have made an add on bet and the player must receive an ace in his or her hand. While the second act of receiving an ace in the hand is not discretionary on the part of the player, placing the bet is discretionary. Therefore, it is our view that the language of the claim does not preclude the second condition—receiving an ace. Accordingly, we do not sustain the rejection of claim 1 under § 112, first paragraph.

Pertaining to the Webb patent, Webb discloses a method of playing a card game using a regular 52 card, four suit deck. Webb shows a gaming table for playing the card game with a position for the dealer on the straight side and a curved side having positions for up to 7 players. Each player has a play area with an ante area 18, bet or play area 20, and a pairs plus or insurance bet area at 16.

Adams shows a roulette game table which has a totem or standard 36 with a jackpot sign 38 and speakers thereon. The standard has a set of colored lights 1-7 which indicate which players have placed a jackpot wager and are thus eligible to participate in the jackpot. The jackpot value is also shown on the jackpot sign 38.

Baerlocher shows a roulette gaming apparatus which discloses controls for the dealer, buttons 48-60, which the dealer uses to enable spin

stop buttons 32a-44a at the player positions. This button, when pressed by the dealer, enables an individual player's button so that the player may perform a randomizing event that is part of the game.

PRINCIPLES OF LAW

“Whether a specification complies with the written description requirement of [35 U.S.C. § 112, first paragraph], is a question of fact.” *Regents of Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1566, 43 USPQ2d 1398, 1404 (Fed. Cir. 1997), *cert. denied*, 523 U.S. 1089 (1998)(citing *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991)). “To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that ‘the inventor invented the claimed invention.’” *Id.* citing *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997) and *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (“[T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.”) With regard to the second paragraph requirement for “‘particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention,’” it has been stated that the “essence of that requirement is that the language of the claims must make it clear what subject matter they encompass.” *In re Hammack*, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970). This has been frequently stated in a shortened form as a requirement that the claims set forth the “metes and bounds” of their coverage. *See, merely for example, In re Venezia*, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976); *In re Goffe*, 526 F.2d 1393, 1397, 188 USPQ 131, 135 (CCPA 1975);

In re Watson, 517 F.2d 465, 477, 186 USPQ 11, 20 (CCPA 1975); *In re Knowlton*, 481 F.2d 1357, 1366, 178 USPQ 486, 492 (CCPA 1973). This requirement has usually been viewed from the perspective of a potential infringer, "so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance." *Hammack*, 427 F.2d at 1382, 166 USPQ at 208.

“A claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the pertinent art.” *In re Kahn*, 441 F.3d 977, 985, 78 USPQ2d 1329, 1334-35 (Fed. Cir. 2006) citing 35 U.S.C. § 103(a) (2000); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14, 148 USPQ 459, 467 (1966). “The ultimate determination of whether an invention would have been obvious is a legal conclusion based on underlying findings of fact.” *Id.* (citing *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999)).

Nonfunctional descriptive material cannot render nonobvious an invention that is otherwise obvious over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983)(when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Our reviewing court and its predecessor have frequently cautioned the “Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art.” *In re Lowry*, 32 F.3d 1579, 1582-83, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994) quoting *In re*

Gulack 703 F.2d 1381, 1384-85, 217 USPQ 401, 403-04 (Fed. Cir. 1983). Furthermore, the Federal Circuit has cautioned against a liberal use of a printed matter rejection. *Id.*, 32 F.3d at 1582-83, 32 USPQ2d at 1034. Nonetheless, we recognize in the instant case the classic printed matter situation in which Appellant is advancing patentability based on the content of the labels of the invention. These printed matter cases “dealt with claims defining as the invention certain novel arrangements of printed lines or characters, useful and intelligible only to the human mind.” *Id.* quoting *In re Bernhart*, 417 F.2d 1395, 1399, 163 USPQ 611, 615 (CCPA 1969). Accordingly, although we will not disregard any claim limitations and will assess the claimed invention as a whole, we will follow the Federal Circuit’s guidance as in the *Gulack* decision and will “not give [any] patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate.” *Id.* (Emphasis supplied).

CONCLUSIONS OF LAW

As noted above, it was our finding that claim 1 is not based on a Specification that lacks descriptive written support. With respect to the second paragraph rejection of claims 3 and 6, the steps in claims 3 and 6 that are pointed to by the Examiner presumably are performed by the dealer. In our view, these claims are not vague, indistinct, or unclear in this respect.

Turning to the rejection of claim 12 as lacking novelty, we are in agreement with the Examiner that the standard card deck of Webb is a single deck and it has 4 suits only, that is hearts, clubs, spades, and diamonds. We are in further agreement with the Examiner that a normal deck has cards numbered 2-10 and an ace. We see nothing in the claims that precludes the

presence of the face cards. Accordingly, we agree with the Examiner that Webb anticipates claims 12 and 13.

With respect to claims 14, 15, and 16 it is our finding that these claims differ from the subject matter of Webb only to the extent that the printed matter of Appellant is different from the printed matter shown in Webb. As noted above, the jurisprudence recognizes that a mere change in printed matter will not render unpatentable subject matter patentable. For example, the fact that Webb calls his bet area the play area can in no way serve to render the subject matter of claim 14 patentable over Webb. Accordingly, while we reverse the § 102 rejection of claims 14 and 16, we will enter a new rejection under § 103 of this subject matter of claims 14-16, hereinbelow. We include claim 15 in the new rejection, inasmuch as the thrust of the rejection has been changed. Consequently, we reverse the standing 35 U.S.C. § 103 rejection of claim 15, in favor of the new rejection.

We affirm the rejection of claim 17 as unpatentable over Webb in view of Adams, inasmuch as Adams shows an electronic totem pole, and the Examiner has articulated a motivation for placing this totem pole on the gaming table of Webb. We reverse the rejection of claim 18 as unpatentable over Webb in view of Adams. We find no teaching in the prior art of displaying Appellant's so-called super ace. Likewise, with respect to claim 20, although Baerlocher discloses dealer activated individual buttons for the players, Baerlocher makes no reference to a button for selecting a super ace. Therefore, the rejections of claims 18 and 20 are reversed.

With respect to claim 19, we are in agreement with the Examiner that Adams discloses an electronic control device to help the dealer and players keep track of the numerous transactions at real time speed of the game. It

would have been obvious to use such an electronic table control in the game of Webb.

REJECTION UNDER 37 C.F.R. § 41.50(b)

As noted above, claims 14, 15, and 16 are rejected under 35 U.S.C. § 103 as unpatentable over Webb. The subject matter claimed differs from that disclosed in Webb merely as to printed matter on the play table.

ORDER

The rejections of claims 1, 3, and 6 under § 112 are reversed.

The rejection of claims 12 and 13 under 35 U.S.C. § 102 as anticipated by Webb is affirmed.

The rejection of claims 14 and 16 as anticipated by Webb is reversed.

The rejection of claim 15 under 35 U.S.C. § 103 as unpatentable over Webb in view of Baerlocher is reversed.

The rejection of claim 17 under 35 U.S.C. § 103 as unpatentable over Webb in view of Adams is affirmed.

The rejection of claim 19 under 35 U.S.C. § 103 as unpatentable over Webb in view of Adams is also affirmed.

The rejections of claims 18 and 20 under 35 U.S.C. § 103 are reversed.

A new rejection of claims 14-16 has been entered pursuant to our authority under 37 C.F.R. § 41.50(b).

Regarding the affirmed rejection(s), 37 C.F.R. § 41.52(a)(1) provides "Appellant may file a single request for rehearing within two months from the date of the original decision of the Board."

In addition to affirming the Examiner's rejection(s) of one or more claims, this decision contains new grounds of rejection pursuant to 37 C.F.R.

Appeal 2006-2056
Application 10/102,192

§ 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R.

§ 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that Appellant, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should Appellant elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

Appeal 2006-2056
Application 10/102,192

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 CFR § 1.136(a)(1)(iv) (2006).

AFFIRMED-IN-PART
37 C.F.R. § 41.50(b)

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