

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3  
4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6

7  
8 *Ex parte* JOSEPH EDWIN LEWIS  
9

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11 Appeal 2008-0034  
12 Application 10/961,551  
13 Technology Center 3700  
14

15  
16 Decided: April 21, 2008  
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19 *Before* WILLIAM F. PATE, III, DAVID B. WALKER and  
20 STEVEN D.A. McCARTHY, *Administrative Patent Judges*.

21  
22 PATE, III, *Administrative Patent Judge*.

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24  
25 DECISION ON APPEAL

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27 STATEMENT OF CASE

28 The Appellant appeals under 35 U.S.C. § 134 (2002) from a Final  
29 Rejection of claims 45 to 55. Claims 1 to 44 have been previously canceled.  
30 We have jurisdiction under 35 U.S.C. § 6(b) (2002).



1 FINDINGS OF FACT

2 The record supports the following findings of fact (FF) by a  
3 preponderance of the evidence.

4 1. Rideout discloses a toy baseball game including a playing piece  
5 30 mounted on a turntable 20 and a fixed plate 16 that is disposed around the  
6 playing piece (Figs. 1 and 2; Col. 1, ll. 53-65).

7 2. Rideout also illustrates that the playing piece 30 is a right-  
8 handed batter (Fig. 2).

9 3. Bowen discloses a toy money box including a left-handed batter  
10 figurine C that includes a rotatable head X (Figs. 3 and 4; Pg. 1, ll. 72-81).

11  
12 PRINCIPLES OF LAW

13 “A claim is anticipated only if each and every element as set forth in  
14 the claim is found, either expressly or inherently described, in a single prior  
15 art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d  
16 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over  
17 the prior art under 35 U.S.C. § 102 begins with a determination of the scope  
18 of the claim. We determine the scope of the claims in patent applications  
19 not solely on the basis of the claim language, but upon giving claims their  
20 broadest reasonable construction in light of the specification as it would be  
21 interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech.*  
22 *Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim  
23 must then be compared with the prior art.

24 “Section 103 forbids issuance of a patent when ‘the differences  
25 between the subject matter sought to be patented and the prior art are such

1 that the subject matter as a whole would have been obvious at the time the  
2 invention was made to a person having ordinary skill in the art to which said  
3 subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727,  
4 1734 (2007). In *KSR*, the Supreme Court noted that “[t]o facilitate review,  
5 this analysis should be made explicit,” but “the analysis need not seek out  
6 precise teachings directed to the specific subject matter of the challenged  
7 claim” *KSR*, 127 S.Ct. at 1741, citing *In re Kahn*, 441 F.3d 977, 988 (Fed.  
8 Cir. 2006).

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## ANALYSIS

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### Claims 45-50 and 52-55

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The Examiner rejected claims 45-50 and 52-55 as lacking novelty  
over Rideout (Ans. 3 and 4). The Appellant argues each of the rejected  
claims separately, and thus, we address each of these arguments in detail  
*infra*.

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### Claim 45

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In rejecting independent claim 45, the Examiner contends that Rideout  
discloses a batter mannequin 30 which rotates to a right-handed position or  
to a left-handed position citing Column 3, lines 26-30 of Rideout (Ans. 3 and  
5). Rather than arguing that Rideout does not disclose a batter mannequin,  
the Appellant argues that Rideout merely discloses a batter that neither  
rotates to a right-handed batting position nor a left-handed batting position  
(Appeal Br. 5; Reply Br. 6 and 7). The Appellant also argues that the  
Examiner has misconstrued the disclosure of Rideout in that the cited

1 portion of Rideout relates to positioning a ball-projecting block 114 to  
2 represent a right-handed batter or a left-handed batter, but that the cited  
3 portion of Rideout does not relate to the batter mannequin itself (Appeal Br.  
4 5 and 6; Reply Br. 7). The Appellant further argues that the batter of  
5 Rideout is a fixed toy figure, and as such, cannot change batting hands  
6 (Appeal Br. 5; Reply Br. 7).

7           Initially, we concur with the Appellant that the Examiner  
8 misconstrued the Rideout reference in that the cited portion relied upon for  
9 disclosing the right and left-handed batting positions is related to the bulk  
10 projecting block 114 and not to the batter 30. However, it is also noted that  
11 Rideout does disclose that the batter 30 is mounted on a rotatable carousel  
12 20 so that the batter can be rotated to the position shown in Figure 1 in  
13 which the batter is in a right-handed batting position. Although Rideout  
14 does not disclose rotation of the batter to a left-handed batting position, we  
15 note that independent claim 1 uses the alternative term “or”. Hence,  
16 independent claim 45 does not require rotation of the batter to both a right-  
17 handed batting position *and* a left-handed batting position as argued by the  
18 Appellant (Reply Br. 7). Instead, claim 45 is satisfied upon rotation of the  
19 batter to either a right-handed or a left-handed batting position, the right-  
20 handed position being disclosed in Rideout (FF 1 and 2).

21           The Appellant’s argument seeking to distinguish the right or left-  
22 handedness of the batter from the right or left “batting position” recited in  
23 claim 1 is noted (Reply Br. 7). In particular, the Appellant contends that the  
24 term “batting position” requires the batter to assume “a specific physical  
25 relationship with respect to the plate and with respect to the catcher” (Reply

1 Br. 7). However, we note that claim 45 does not recite a plate or a catcher,  
2 much less define the specific physical relationship between them. In  
3 essence, the Appellant is arguing that we should interpret the term “batting  
4 position” as requiring such specified physical relationship between the  
5 batter, a catcher and a plate.

6 We decline to adopt such a restricted construction of the term “batting  
7 position” as advocated by the Appellant. The Appellant is reminded that  
8 during prosecution, the Examiner and the Board are required to give claims  
9 their broadest reasonable construction in light of the specification as it would  
10 be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci.*  
11 *Tech. Ctr.*, 367 F.3d at 1364 (stating giving broad construction to claim  
12 terms is not unreasonable during examination because the applicant can  
13 amend the claims). Thus, because Figure 1 of Rideout clearly shows the  
14 batter 30 in the appropriate position on the modeled baseball diamond for  
15 batting, we find that Rideout discloses a batter in a “batting position” as  
16 claimed.

17 The Appellant’s additional argument that the batter figure of Rideout  
18 is a fixed toy figure, and as such, cannot possibly change batting hands is  
19 also noted (Appeal Br. 5; Reply Br. 7). However, the Appellant’s argument  
20 fails from the outset because it is not based on limitations appearing in claim  
21 1, which merely recites rotation of the batter mannequin to a right-handed  
22 batting position or to a left-handed batting position. *In re Self*, 671 F.2d  
23 1344, 1348 (CCPA 1982). Therefore, in view of the above, the Appellant  
24 has not shown that the Examiner erred in rejecting independent claim 45 as  
25 lacking novelty over Rideout.

1                    Claim 46

2                    In rejecting claim 46, the Examiner contends that Rideout shows a  
3 fixed plate (i.e. field 16) that is disposed in front of the batter 30 and that the  
4 batter rotates about the fixed plate (Ans. 3 and 5). The Appellant argues that  
5 the recited “fixed plate” refers to a home plate so that it is improper for the  
6 Examiner to interpret the field 16 as corresponding to the recited fixed plate  
7 (Appeal Br. 6). In support, the Appellant refers to the Specification of the  
8 application which states “[t]urntable 26 rotates about a fixed plate 32 (home  
9 plate) which is disposed in front of batter mannequin 22,” and statements  
10 regarding the batter being positioned in relationship to the fixed plate like  
11 the actual game of baseball (App. Br. 6 and 7; Reply Br. 8; Spec. 9, ll. 27-  
12 30).

13                    The Examiner contends that the field 16 corresponding to the fixed  
14 plate is all around the batter 30 (including the front of the batter) and further  
15 contends that the Appellant is arguing limitations not in the claim 46 which  
16 merely requires the plate to be fixed, but does not recite a particular shape or  
17 form of the fixed plate (Ans. 5). We agree.

18                    While there is some support in the Specification for interpreting the  
19 limitation “fixed plate” to only refer to the home plate, we find that the cited  
20 passage with the parenthetical does not clearly limit the definition of the  
21 fixed plate as argued. If the Appellant intended for fixed plate to refer to a  
22 fixed home plate, the Appellant had the opportunity to amend the claims  
23 accordingly during prosecution. Thus, in giving the term “fixed plate” the  
24 broadest reasonable construction in light of the specification, we find that  
25 Rideout discloses this limitation and that the Appellant has failed to establish

1 that the Examiner erred in rejecting dependent claim 46 as lacking novelty  
2 over Rideout. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d at 1364.

3  
4 Claim 47

5 With respect to claim 47, the Appellant relies on arguments presented  
6 relative to independent claim 45 (App. Br. 7). The Appellant also contends  
7 that in contrast to the Examiner's Answer, limitations are not being read into  
8 the claims other than the proper definition of the claim words (Reply Br. 9).  
9 The Appellant refers to the term "catcher" as an example. However, the  
10 relevance of this argument to claim 47 in particular is not clear because there  
11 is no dispute as to the meaning of the terms in claim 47 and "catcher" is not  
12 recited in the claim. Therefore, the Appellant has not established Examiner  
13 erred in rejecting claim 47 as lacking novelty over Rideout.

14  
15 Claim 48

16 The Examiner asserts that Rideout discloses a batter mannequin  
17 having a body which faces the center of the turntable as recited in claim 48  
18 (Ans. 3 and 6). The Appellant argues that in Rideout, the batter's body faces  
19 about 90° away from the center of rotation 24 of the rotor 20, and thus, does  
20 not disclose this limitation (Appeal Br. 7; Reply Br. 10; Figs. 1, 2 and 4).  
21 We agree.

22 Figure 2 of Rideout clearly shows that the batter 30 is positioned so  
23 that his body faces a tangential direction of the turntable, and his body does  
24 not face the center of the turntable as recited in claim 48 (Appeal Br. 7;  
25 Reply Br. 10). Therefore, because Rideout does not disclose each and every

1 limitation of claim 48, the Appellant has shown that the Examiner erred in  
2 rejecting claim 48 as lacking novelty over Rideout.

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4 Claim 49

5 In rejecting claim 49, the Examiner states that the turntable of Rideout  
6 is capable of rotating not only to 180°, but also to 360° to position the batter  
7 (Ans. 6). The Appellant argues that the batter of Rideout rotates around the  
8 bases of a diamond, and because the batter is fixed, it cannot go from a right-  
9 handed batter to a left-handed batter regardless of the amount of rotation of  
10 the turntable (Appeal Br. 8; Reply Br. 11). We agree with the Appellant.

11 It is noted that dependent claim 49 specifically recites rotation of the  
12 turntable to position the batter in the “right-handed *and* left-handed batting  
13 positions” (emphasis added), thereby reciting both right and left-handed  
14 batting positions (in contrast to independent claim 45 which recites these  
15 positions using the alternative language “or”). Rideout clearly does not  
16 disclose a left-handed batting position. Therefore, the Appellant has shown  
17 that the Examiner erred in rejecting dependent claim 49 as lacking novelty  
18 over Rideout.

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20 Claim 50

21 In response to the Examiner’s rejection of dependent claim 50, the  
22 Appellant again relies upon the argument that the recited “fixed plate” refers  
23 to a home plate (Appeal Br. 9; Reply Br. 12). However, this argument is not  
24 persuasive as discussed above relative to dependent claim 46. Thus, the

1 Appellant has not shown that the Examiner erred in rejecting claim 50 as  
2 lacking novelty over Rideout.

3

4 Claim 52

5 In rejecting dependent claim 52, the Examiner asserts that the batter  
6 shown in Figure 1 of Rideout has both a left looking face and a right looking  
7 face (Ans. 3). However, as argued by the Appellant, the basis for the  
8 Examiner's assertion is unclear (Appeal Br. 10; Reply Br. 13). In fact,  
9 Figure 2 of Rideout appears to show a batter with a single face that is  
10 looking to the right, not both to the left and to the right. Thus, the Appellant  
11 has shown that the Examiner erred in rejecting claim 52 as lacking novelty  
12 over Rideout.

13

14 Claim 53

15 In response to the Examiner's rejection of dependent claim 53 which  
16 recites that the batter mannequin has a body which, when viewed from the  
17 front, is bilaterally symmetrical about a vertical median plane, the Appellant  
18 notes that Rideout batter is holding a bat over one shoulder as shown in  
19 Figures 1, 2, and 4 so that it is not bilaterally symmetrical (Appeal Br. 10  
20 and 11; Reply Br. 13 and 14). The Appellant also argues that the recited  
21 feature allows the batter to assume both a right-handed batting position and a  
22 left-handed batting position (Appeal Br. 10; Reply Br. 13). However, it is  
23 noted that claim 53 merely requires the batter to have a bilaterally  
24 symmetrical body, and does not specify that the batter's body is *positioned*  
25 to be bilaterally symmetrical about the vertical median plane which is what

1 the Appellant is essentially arguing. In this regard, it is noted that the body  
2 of the batter as shown in Figures 2 and 4 of Rideout is bilaterally  
3 symmetrical about a vertical median plane in that each side of the body  
4 includes a portion of the torso as well as an arm and a leg, etc. Thus, the  
5 Appellant has not shown that the Examiner erred in rejecting dependent  
6 claim 53 as lacking novelty over Rideout.

7

8 Claim 54

9 In rejecting dependent claim 54 which recites a fixed plate disposed in  
10 front of the batter mannequin and a catcher mannequin disposed behind the  
11 batter mannequin, the Examiner notes that Rideout discloses various  
12 mannequins 158, 160, 162 and 164 for catching the ball as satisfying the  
13 claim limitation (Ans. 6). In response, the Appellant again contends that  
14 Rideout does not disclose a home plate as argued relative to dependent claim  
15 46 discussed *supra*, and further contends that Rideout does not teach a  
16 catcher mannequin that is disposed behind the batter mannequin as claimed  
17 (Appeal Br. 11; Reply Br. 14). In this regard, the Appellant notes that the  
18 Specification clearly defines the limitation “disposed behind said batter  
19 mannequin” to mean a relationship wherein the batter is disposed between  
20 the pitching area and the catcher as in an actual game of baseball or softball  
21 (Appeal Br. 11-12; Reply Br. 10; Spec. 10, ll. 21-26).

22 We concur with the Appellant because the cited portion of the  
23 Specification clearly defines “disposed behind said batter mannequin”.  
24 While the Examiner’s finding that Rideout discloses various mannequins  
25 158, 160, 162 and 164 for catching the ball is correct, these disclosed

1 mannequins are not in the proper positional relationship recited in claim 54  
2 as defined in the Specification.

3 Thus, in view of the definition of the recited positional relationship  
4 between the catcher and the batter which is defined in the Specification, we  
5 agree with the Appellant that Rideout does not disclose claim 54. Thus, the  
6 Appellant has shown that the Examiner erred in rejecting dependent claim  
7 54 as lacking novelty over Rideout.

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9 Claim 55

10 In regards to the Examiner's rejection of dependent claim 55, we find  
11 that Rideout fails to disclose the right-handed and left-handed batting  
12 positions as discussed relative to dependent claim 49, a batter having both  
13 the left looking face and a right looking face as discussed relative to  
14 dependent claim 52, or a catcher disposed behind the batter as discussed  
15 relative to dependent claim 54. Therefore, the Appellant has shown that the  
16 Examiner erred in rejecting dependent claim 55.

17

18 Claim 51

19 Dependent claim 51 recites that the batter mannequin has a rotatable  
20 head, the rotatable head automatically assuming a left-looking position when  
21 the batter mannequin is in a right-handed batting position, and automatically  
22 assuming a right-looking position when the batter mannequin is in a left-  
23 handed batting position.

24 The Examiner rejected dependent claim 51 as unpatentable over  
25 Rideout in view of Bowen which discloses a coin money box with a left-

1 handed batter having a rotatable head (Ans. 4). The Examiner contends that  
2 it would have been obvious to one of ordinary skill in the art to provide a  
3 rotatable head as disclosed in Bowen on the batter of Rideout to make the  
4 game of Rideout more realistic (Ans. 5).

5 While the Examiner has articulated a reason with rational  
6 underpinnings for combining the references in the manner suggested, we  
7 find that such a combination still fails to render obvious the recited invention  
8 of claim 51. We note that claim 51 requires automatic rotation of the head  
9 based on the batting position of the batter (either right-handed or left-  
10 handed). While Bowen does disclose a left-handed batting position, both  
11 Rideout and Bowman disclose fixed batting positions and do not suggest  
12 changing the batting position of the batter. Therefore, the Examiner has not  
13 established that claim 51 is unpatentable over Rideout and Bowen, and the  
14 Appellant has shown that the Examiner erred.

15

16

### CONCLUSIONS

17 1. The Appellant has not shown that the Examiner erred in  
18 rejecting claims 45-47, 50 and 53 as lacking novelty over Rideout.

19 2. The Appellant has shown that the Examiner erred in rejecting  
20 claims 48, 49 and 52, 54 and 55 as lacking novelty over Rideout.

21 3. The Appellant has shown that the Examiner erred in rejecting  
22 claim 51 as unpatentable over Rideout in view of Bowen.

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ORDER

1. The Examiner's rejection of claims 45-47, 50 and 53 is AFFIRMED.
  2. The Examiner's rejections of claim 48, 49, 51, 52, 54 and 55 are REVERSED.
- 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 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

vsh

TED MASTERS  
TED MASTERS & ASSOCIATES, INC.  
5121 SPICEWOOD DRIVE  
CHARLOTTE, NC 28227-0313