

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK TROKAN

Appeal 2008-0107
Application 10/397,793
Technology Center 3700

Decided: March 14, 2008

Before TONI R. SCHEINER, ERIC GRIMES, and FRANCISCO C.
PRATS, *Administrative Patent Judges*.

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DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a non-alcoholic beer-pong game system. The Examiner has rejected the claims as obvious. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.¹

¹ In this decision we consider only those arguments actually made by Appellant. Arguments that Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. See 37 C.F.R. § 41.37(c)(1)(vii).

STATEMENT OF THE CASE

Claims 1-10 are pending and on appeal (App. Br. 5). Claim 1 is representative of the appealed subject matter and reads as follows:

Claim 1: A non-alcoholic beer-pong game system for two or more players, comprising:

- a. a distinctly colored beer-pong ball having at least one printed message thereon, said ball having a stain resistant, transparent coating that substantially covers and protects said printed message from deterioration and also protects said distinct coloration of said balls from alteration;
- b. a plurality of cups arranged in pyramidal form on opposing sides of a game table, each of said cups being filled with a non-alcoholic beverage;
- c. two sets of said beer-pong balls, each set containing three balls bearing, respectively, a color that is RED, ORANGE and YELLOW, and being appointed for distribution to a first and second team of players, respectively; and
- d. a set of game rules, providing for at least one player of a team to toss or bounce at least one of said colored beer-pong balls across the length of said game table in an attempt to land said colored beer-pong ball within one of said cups, whereupon, depending on the color of the ball, a successful attempt requires a player of the opposing team perform a first action, including (i) drinking substantially the entire contents of one or more cups, (ii) awarding from 0 to 2 or more prize points to the team whose player successfully tossed the ball, (iii) removing one or more cups, whose contents have been consumed, from that player's pyramid, and (iv) adding at least one cup to the opposing team's pyramid, and to execute a second action, as directed by a message printed on said colored beer-pong ball.

The Examiner applies the following documents in rejecting the claims:

Hogge US 6,806,347 B2 Oct. 19, 2004

National Beer Pong League - <http://www.nbpl.net/rulesno>.²

The Webtender - Drinking Games - <http://www.webtender.com/handbook/ga>

Claims 1-10 stand rejected under 35 U.S.C. § 103(a) as being obvious in view of “Existing Beer-Pong Games” (as evidenced by the National Beer Pong League website and the Webtender website) and Hogge (Ans. 4-5).³

OBVIOUSNESS

ISSUE

The Examiner cites the National Beer Pong League (“NBPL”) website as teaching that many variations of the Beer Pong game are known throughout the U.S., and that “[i]n almost all versions the cups or containers are placed on a table such as a pool or ping-pong table. The cups are arranged in a pyramid form” (Ans. 4). The Examiner cites the NBPL website as teaching that certain versions of the game use multiple balls, that certain versions use colored balls, and that the “common ball used in these types of games is a PING PONG ball which is . . . commonly provided with some form of printed matter” (*id.* at 4-5).

Regarding the ball colors recited in claim 1, the Examiner contends that “such is considered to be an obvious matter of choice, and many colors

² Our citations of the National Beer Pong League and Webtender websites are to the printed versions of these documents of record in the case.

³ Examiner’s Answer mailed March 15, 2007.

are available on the market including the claimed colors, orange, yellow and red” (*id.* at 5). Regarding the balls’ transparent outer coating recited in claim 1, the Examiner urges that “it would have been obvious to include[] a protective coating such as the one taught by Hogge et al, the motivation being to enhance the overall water vapor barrier (WVB) properties of the game ball” (*id.*). The Examiner cites the Webtender website as evidence that drinking games can be played with non-alcoholic beverages (*id.*). The Examiner concludes that the claimed game system would have been obvious to a person of ordinary skill in the art because Appellant “has merely combined what is already old and well-known” (*id.*).

Appellant contends that the Examiner has not made out a prima facie case of obviousness because the cited prior art does not disclose or suggest every feature of the claimed game system, and because the cited prior art does not provide motivation to modify the ping pong ball of the Existing Beer Pong Games (*see App. Br.* 11-18).

The issue with respect to this rejection, therefore, is whether the Examiner erred in concluding that Hogge, the NBPL website, and the Webtender website would have rendered a beer pong game system having the claimed elements obvious to a person of ordinary skill in the art.

PRINCIPLES OF LAW

Recently addressing the issue of obviousness, the Supreme Court reaffirmed “the conclusion that when a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740 (2007) (quoting *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282 (1976)).

The Court reasoned that a “patent for a combination which only unites old elements with no change in their respective functions . . . obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men.” *Id.* at 1739 (quoting *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152 (1950)).

The Court emphasized that “[i]n determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls. What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *Id.*, at 1741-42. The Court also emphasized a flexible approach to the obviousness question, stating that the analysis under 35 U.S.C. § 103 “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 1741. The Court noted that “[a] person of ordinary skill is . . . a person of ordinary creativity, not an automaton.” *Id.* at 1742.

In *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004), our reviewing court held that combining, in kit form, a known product and printed instructions for using the product did not render the product patentable, despite the fact that the instructions recited a novel and unobvious process. The court explicitly reaffirmed the principle that, when “printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability.” *Id.* (quoting *In re Gulack*, 703 F.2d 1381, 1387 (Fed. Cir. 1983)).

FINDINGS OF FACT

1. Claim 1 recites a system which two or more players can use to play beer pong. The system has the following items:

(a) two sets of three beer pong balls, with each set containing a red, orange, and yellow ball, each ball having a printed message on it, and each ball having a stain resistant transparent coating that protects the printed message and coloration of the balls;

(b) a plurality of cups filled with a non-alcoholic beverage arranged in a pyramid form on opposing sides of a game table; and

(c) a set of game rules governing the players' actions.

2. The NBPL website discloses about fourteen beer pong games that can be played without paddles. Under "Virginia Rules" the game uses a white ping pong ball and a yellow "[m]oney ball." Under "Cockeysville Rules" the game uses "three balls, two whites and a multi-colored money ball." "Beirut-East Coast Style" beer pong also uses 3 ping pong balls.

3. Under Virginia Rules, party cups are filled about one third full with beer and then "arrange[d] . . . in a pyramid . . . , 3 cups in the back, 2 in the middle row, 1 in the front, all tightly pushed together. The cups are on either end of [a] ping pong table." Beirut-East Coast Style beer pong also uses cups filled with beer placed in a pyramid form on a ping pong table.

4. Each game provides a specific set of rules governing the players' actions. In general, the object of the games is to toss a ping pong ball into a beer-containing cup on the opponents' side of the table, thereby requiring the opponent to drink the contents of the cup (*see, e.g.*, "Long Island Style . . . [w]hen a ball lands in a cup, one player from that side must chug that cup").

5. Ping pong balls are “commonly provided with some form of printed matter” (Ans. 5; *see also* App. Br. 15 (“[I]t is well known that PING PONG balls have a dull finish, with printed messages thereon”)).

6. Hogge discloses “a golf ball comprising a thin water vapor barrier (‘WVB’) layer” (Hogge, col. 4, ll. 10-11). “To prevent or minimize the penetration of water vapor into the core of the golf ball, a thin WVB layer may be disposed anywhere between the core and the cover, preferably immediately around the core” (*id.* at col. 5, ll. 11-14). Hogge discloses that the reason for including the WVB in golf balls is to prevent the damaging effects caused by water vapor entering the balls under conditions of high humidity and elevated temperature (*id.* at col. 1, ll. 28-41).

7. Hogge discloses that the “thin WVB layer [has] at least one layer that is formed from poly-para-xylylene and its derivatives (‘parylenes’)” (Hogge, col. 2, ll. 16-18). Hogge discloses that “[a]lternatively, the thin WVB layer comprising at least one parylene-based layer may have one or more non-parylene layers to further enhance the overall performance of the thin WVB layer. . . . Suitable WVB materials for the one or more non-parylene layers include . . . polytetrafluoroethylene . . . SiOx . . .” (*id.* at col. 7, ll. 5-18).

8. The Webtender website discloses that “drinking games” should be played by those of legal drinking age when using beer or drinks, “but anyone can play these games with non-alcoholic beverages as well.” The Webtender site lists “Beer Pong” among such drinking games.

ANALYSIS

We agree with the Examiner that the cited prior art would have rendered a beer pong game system having the claimed elements obvious to a

person of ordinary skill in the art. Specifically, because a person of ordinary skill in the beer pong art would have considered red, orange, and yellow balls to be useful in the multi-colored, multi- or three-ball games disclosed on the NBPL website (*see* Findings of Fact (“FF”) 2, above), we agree with the Examiner that a person of ordinary skill playing beer pong with pyramidally arranged beer-containing cups on a ping pong table (*see* FF 3) would have considered it obvious to include the two claimed sets of balls in a beer pong system. A person of ordinary skill in the art would also have reasoned from the Webtender website (*see* FF 8) that the cups would have suitably contained non-alcoholic beverages.

Because the balls spend a significant amount of time in the beverage contained in the cups (*see* FF 4), we also agree with the Examiner that a person of ordinary skill in the art would have been prompted to provide the balls with a water resistant transparent coating made of a material like that disclosed by Hogge (*see* FF 6), to ensure that the coloring (*see* FF 2) and printed message (*see* FF 5) would not be removed from the balls. A person of ordinary skill in the art playing beer pong would also have recognized, and appreciated, that a water resistant coating would ensure that the beverage’s flavor would be maintained because it would prevent the beverage from being contaminated with the coloring and printing materials.

We note that the rules disclosed in the NBPL website appear to be different than those recited in claim 1. However, because the balls and cups as claimed can be used to play beer pong regardless of the actual content of the rules, the rules recited in claim 1 are not functionally related to the balls and cups. The rules in claim 1 are therefore analogous to the printed directions in *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004), and thus

“will not distinguish the invention from the prior art in terms of patentability.” *Id.* (quoting *In re Gulack*, 703 F.2d 1381, 1387 (Fed. Cir. 1983).

Therefore, because a person of ordinary skill viewing the cited prior art would have been prompted to assemble a beer pong game system having the claimed set of playing balls and pyramidally arranged cups, along with a set of rules, we agree with the Examiner that the claimed game system would have been *prima facie* obvious to a person of ordinary skill in the art.

Appellant argues that the Examiner has failed to set forth a *prima facie* case of obviousness because the cited prior art does not disclose or suggest the limitation requiring the game system’s balls to have “a stain resistant, transparent coating that substantially covers and protects said printed message from deterioration and also protects said distinct coloration of said balls from alteration” (*see* App. Br. 11-13). Appellant argues that Hogge fails to suggest such a coating because Hogge’s water vapor barrier (WVB) is not sufficiently durable for beer pong play, and because Hogge uses its water resistant coating inside a golf ball rather than as an outer coating for protecting printed messages on a ping pong ball’s surface (*see id.* at 14-15; *see also* Reply Br. 3-5, 8-10).

We are not persuaded by this argument. As noted above, in emphasizing a flexible approach to the obviousness question the Supreme Court recently advised that the analysis under 35 U.S.C. § 103 “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). The Court also advised that

“[a] person of ordinary skill is . . . a person of ordinary creativity, not an automaton.” *Id.* at 1742.

We agree with the Examiner that one of ordinary skill in the art, being a person of ordinary creativity and common sense, and also being aware that beer pong balls spend a significant amount of time in liquids during play (*see* FF 4), would have been prompted to provide beer pong balls with a water resistant coating of sufficient durability to ensure that the message printed on the balls (*see* FF 5), or the coloration on the balls (*see* FF 2), did not become dislodged from the balls by the liquid.

We note that Hogge’s WVB coating is used between the core and cover of a golf ball (FF 6), rather than as an outer coating. However, given Hogge’s disclosure that its WVB protects a game ball from damage by moisture, a person of ordinary creativity and common sense playing beer pong would have reasoned that, given the beer pong balls’ frequent encounters with liquids, it would be desirable to protect the beer pong balls with an outer coating made of a material impervious to moisture, such as the WVB materials described by Hogge. Moreover, because Hogge teaches that its WVB materials can include polytetrafluoroethylene or silicon (Hogge, col. 7, ll. 5-18), we do not agree with Appellant’s argument (Reply Br. 6, 10-11) that the Examiner has failed to show that Hogge suggests using those materials in a protective coating for beer pong balls.

Appellant argues that the USA Table Tennis Association has specific rules for the balls’ shape, size, weight, color, and finish (matte), and that a person of ordinary skill would therefore not have been motivated to provide a different coating to a ping pong ball (App. Br. 15, 17-18; Reply Br. 7).

We are not persuaded by this argument. Appellant does not point to, nor do we see, any evidence suggesting that a person of ordinary skill playing beer pong according to the rules set out on the NBPL website would have required, or even considered it important, that the balls meet the specifications of conventional table tennis. Rather, as discussed above, one of ordinary skill in the beer pong art, recognizing the usefulness of colored balls (FF 2) having printed messages on them (FF 5), and also recognizing that beer pong balls spend a significant amount of time in contact with moisture (FF 4), would have reasoned that a water resistant coating would have been useful in ensuring that the coloring and printing materials did not get transferred into the all-important beverage.

Appellant argues that the claimed coating provides the advantages of protecting the balls' colorations as well as facilitating maintenance of the balls' bouncing properties during their service lives (App. Br. 16).

This argument does not persuade us that the Examiner's conclusion of obviousness is erroneous. We note that evidence of unexpected results may rebut an examiner's prima facie case of obviousness. *See In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998); *see also KSR*, 127 S. Ct. at 1740 ("The fact that the elements worked together in an unexpected and fruitful manner supported the conclusion that Adams's design was not obvious to those skilled in the art.") (discussing *United States v. Adams*, 383 U.S. 39 (1966)).

However, "[m]ere improvement in properties does not always suffice to show unexpected results. . . . [W]hen an applicant demonstrates *substantially* improved results . . . and *states* that the results were *unexpected*, this should suffice to establish unexpected results *in the absence of* evidence to the contrary." *In re Soni*, 54 F.3d 746, 751 (Fed. Cir. 1995).

Thus, in our view, a person of ordinary skill in the beer pong art would have expected that a water resistant coating would protect a beer pong ball from the damage that can result from the repeated dunkings a beer pong ball must endure. Therefore, on the current record, the advantages conferred by the water resistant coating do not appear to constitute an unexpected result which would overcome the Examiner's prima facie case of obviousness.

Appellant argues that the Examiner has failed to establish that the cited prior art renders the claimed game system obvious because the Examiner has not shown that the cited prior art teaches or suggests a set of rules requiring the actions set forth in claims 1 and 7-10, or suggests the messages recited in claims 5 and 6 (App. Br. 16-17; *see also* Reply Br. 17-18).

We are not persuaded by these arguments. Because the balls and cups recited in the claims can be used to play beer pong even in the absence of the claimed rules and printed messages on the balls, we do not agree with Appellant that the claimed rules and printed messages are functionally related to the claimed balls and cups.

As noted above, when printed matter in a claim is not functionally related to the structural elements of the claim, the printed matter does not have any patentable weight. *See In re Ngai* 367 F.3d 1336, 1339 (Fed. Cir. 2004). Thus, because they do not carry any patentable weight, the claimed rules and printed messages cannot render the claimed game system unobvious over the cited references.

Appellant argues that the Examiner's rejection is improperly based on a hindsight reconstruction based on Appellant's own disclosure (Reply. Br. 10-14). We are not persuaded by this argument.

As the Supreme Court recently pointed out, "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). Rather, the Court reasoned, "it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does . . . because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *Id.*

Regarding hindsight reasoning, the Court specifically noted that "[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. Rigid preventative rules that deny factfinders recourse to common sense, however, are neither necessary under our case law nor consistent with it." *Id.* at 1742-43 (citations omitted).

Thus, in recognizing the importance in the obviousness analysis of identifying a reason for practicing a claimed invention, the Court nonetheless emphasized a flexible common sense-based approach to the issue, ultimately reaffirming "the conclusion that when a patent 'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an

arrangement, the combination is obvious.” *Id.* at 1740 (quoting *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282 (1976)).

In the instant case, as discussed above, we agree with the Examiner that, in view of the NBPL website’s disclosure of beer pong games that use multiple balls of different colors (FF 2), a person of ordinary skill in the beer pong art would have considered two sets of three balls colored red, orange, and yellow, to be useful in beer pong games having cups arranged in pyramid form on a ping pong table. A person of ordinary skill in the beer pong art, recognizing the usefulness of colored balls (FF 2) having printed messages on them (FF 5), and also recognizing that beer pong balls spend a significant amount of time in contact with moisture (FF 4), would have reasoned that a transparent water resistant coating would have been useful in ensuring that the coloring and printing materials did not get transferred into the beverage. A person of ordinary skill in the art would also have recognized from the prior art that the game was suitably provided with a set of rules (FF 4), and suitably played with non-alcoholic beverages (FF 8).

Given the prior art’s disclosure of the usefulness of the claimed elements in a beer pong system, we agree with the Examiner that a person of ordinary skill would have considered the claimed game system *prima facie* obvious. Because the Examiner’s conclusion is based solely on the disclosures from the prior art, we do not agree with Appellant’s hindsight argument. Moreover, we see no evidence that the claimed elements function unexpectedly.

We therefore affirm the Examiner’s obviousness rejection of claims 1-10 as obvious in view of the National Beer Pong League website, the Webtender website, and Hogge.

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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

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