

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte KIRK BOYD EVANS, and
WAYNE KIRK EVANS

Appeal 2008-0172
Application 10/949,868
Technology Center 3700

Decided: March 26, 2008

Before DONALD E. ADAMS, ERIC GRIMES, and FRANCISCO C.
PRATS, *Administrative Patent Judges*.

PRATS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a pool cue with icons on its surface. The Examiner has made two separate rejections for anticipation and one rejection for obviousness. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm the Examiner's first anticipation rejection,¹ but reverse the second anticipation rejection and the obviousness rejection. However, we find that the reference applied in the affirmed rejection anticipates all but one of the appealed claims, and renders obvious the non-anticipated claim. We therefore enter new grounds of rejection with respect to certain claims.

STATEMENT OF THE CASE

Claims 1-7 and 8-21 are pending (*see* App. Br. 2).² Claims 7 and 11-21 have been withdrawn from consideration by the Examiner (*id.*).

Claims 1-6 and 8-10 are on appeal (*id.*). Claim 1 is representative of the appealed subject matter and reads as follows:

Claim 1. A pool cue system including at least one pool cue shaft having a length, an exterior surface, a tip end, a distal end, and a ferrule-receiving portion of the pool cue shaft proximate the tip end, said pool cue system comprising:

at least one icon appearing on the exterior surface of the pool cue shaft observable within a user's peripheral vision when the pool cue shaft is in use,

wherein said at least one icon is located at least one predetermined distance axially along the pool cue shaft from the ferrule-receiving portion of said pool cue shaft; and

said at least one predetermined distance has a relationship to at least one game parameter.

¹ In this decision we consider only those arguments actually made by Appellants. Arguments that Appellants 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).

² Appeal Brief filed October 27, 2006.

The Examiner applies the following documents in rejecting the claims:

Gibney	GB 2 219 517 A	Dec. 13, 1989
Preast	US 941,728	Nov. 30, 1909
Williams	GB 2 029 368 A	Mar. 19, 1980
Holt	US 6,165,078	Dec. 26, 2000

The following rejections are before us for review:

Claims 1-3, 5, 6, 9, and 10 stand rejected under 35 U.S.C. § 102(b) as anticipated by Gibney (Ans. 3).³

Claims 1-6, 9, and 10 stand rejected under 35 U.S.C. § 102(b) as anticipated by Preast (Ans. 3).

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being obvious in view of Williams and Holt (Ans. 3-4).

ANTICIPATION -- GIBNEY

ISSUE

The Examiner cites Gibney as disclosing a pool cue with “parts 14 [which] comprise an icon along the shaft from the ferrule-receiving portion of the shaft and [which] are used for aiming” (Ans. 3). The Examiner contends that “Gibney’s icon located at its particular position on the pool cue meets the structural limitations of the claimed pool cue and icon. How the icon is used is not at issue so long as it can be used as claimed” (*id.*).

Appellants “contend that the Examiner never presented a prima facie case of anticipation by Gibney” (App. Br. 11). Specifically, Appellants urge that “the Examiner did not establish a prima facie case of anticipation where

³ Examiner’s Answer mailed April 24, 2007.

he never addressed the third element of the sole independent claim at issue” (*id.* at 12).

Appellants do not argue the claims subject to this ground of rejection separately (*see* App. Br. 9-18). We select claim 1 as representative of the rejected claims. *See* 37 C.F.R. § 41.37(c)(1)(vii).

The issue with respect to this ground of rejection, then, is whether the Examiner erred in concluding that Gibney anticipates claim 1.

PRINCIPLES OF LAW

“To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently.” *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). During examination, the PTO must interpret terms in a claim using “the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant’s specification.” *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

FINDINGS OF FACT

1. Claim 1 recites a pool cue system that includes a pool cue shaft that has a length, exterior surface, tip end, distal end, and ferrule-receiving portion adjacent to the tip end. The pool cue system also has at least one icon on the exterior surface of the pool cue shaft. The icon must be within a user’s peripheral vision when the cue is being used.

The icon must be located at least one predetermined distance axially along the cue shaft from the ferrule-receiving portion of the cue. The

predetermined distance between the icon and the ferrule-receiving portion must have a relationship to at least one game parameter.

2. The Specification does not define “game parameter.” However, the Specification lists “bridge hand . . . location,” “stroke length or stroke speed,” and “second stroke length” as “game parameters” (Spec. 8).

3. Gibney discloses:

[A] cue bearing a sighting aid at a position within the user’s field of view when using the cue, normally nearer the striking tip of the cue than the user's eyes, so that simply keeping the sighting aid in view assists the player in moving the cue reliably in the intended direction for the cue ball and in avoiding twisting of the cue.

(Gibney 2.)

4. Gibney discloses that “a suitable sighting aid will involve a small visible part close to the cue tip, conveniently just below any ferrule for the tip itself but feasibly also on or extending onto such ferrule” (Gibney 2).

5. Figure 1 of Gibney is reproduced below:

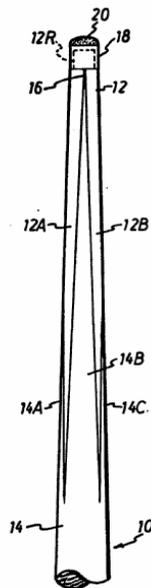


Fig 1

The figure shows an embodiment in which the sighting aid is created by splicing an end part 12 onto a main or intermediate part 14 of the cue. Regarding Figure 1, Gibney states that each of “portions (14A, B, C) represents a convergent shape which, when viewed by the user as for position 14B of Figure 1, has a ‘training’ effect for a straight direction of cue movement by way of the user concentrating upon that portion as a pointer for the intended cueing direction” (Gibney 4-5).

6. Gibney discloses that “[t]here may be a single sighting aid or several about the cue” (Gibney 2-3). Gibney discloses that its sighting aid may be “an arrow formation including a straight line shaft and connected or spaced head or V. Moreover, extension to or from positions close to the cue tip is considered to be advantageous rather than essential” (Gibney 6).

7. Gibney states that “[i]t is to be appreciated that any way of marking or incorporating a suitable eye-training component or indication may be

employed, and that its nature is subject to considerable variation compared with a simple solid or outline V as indicated in the drawings” (Gibney 6).

ANALYSIS

We agree with the Examiner that Gibney anticipates claim 1. The sighting aid on Gibney’s pool cue, disclosed as being in the field of view of the cue’s user (*see* Finding of Fact (“FF”) 3, above), meets claim 1’s limitation that the icon must be “within a user’s peripheral vision when the pool cue shaft is in use.” Because Gibney discloses that the sighting aid can be “close to the cue tip, conveniently just below any ferrule for the tip itself” (Gibney 2 (FF 4)), Gibney also meets the limitation that the icon be “located at least one predetermined distance axially along the pool cue shaft from the ferrule-receiving portion of said pool cue shaft.”

We also agree with the Examiner that Gibney discloses that the predetermined distance between the icon and the ferrule-receiving portion has a relationship to at least one game parameter. Specifically, Gibney discloses that placing the sighting aid in the user’s field of vision “assists the player in moving the cue reliably in the intended direction for the cue ball and in avoiding twisting of the cue” (Gibney 2 (FF 4)).

Gibney also discloses that the convergent shape of portions 14A, B, and C, “when viewed by the user as for position 14B of Figure 1, has a ‘training’ effect for a straight direction of cue movement by way of the user concentrating upon that portion as a pointer for the intended cueing direction” (Gibney 4-5 (FF 5)). Thus, because Gibney discloses that its sighting aids are placed on the pool cue at locations that promote a straight movement of the cue by the user, we agree with the Examiner that the

distance between the sighting aids and ferrule-receiving portion of the cue “has a relationship to at least one game parameter.”

Appellants argue⁴ that the Examiner failed to make out a prima facie case of anticipation because, rather than pointing to a specific passage in Gibney to meet the final element of claim 1, the Examiner “repeatedly referred to ‘aiming the cue’ as being ‘all that is required by the claims’” (App. Br. 12). Appellants argue, however, that “[a]iming is a process, not a game parameter. Claim one [sic] is an apparatus claim, not a process claim” (*id.*; *see also* Reply Br. 6-10, 14 and 15).⁵

We are not persuaded by this argument. Given Gibney’s express disclosure that the sighting aids are located in the player’s field of vision to promote moving the cue in the intended direction (FF 3-5), we agree with the Examiner that the distance between the ferrule-containing portion of the cue and the sighting aids is predetermined to ensure accurate aiming of the pool cue.

We do not agree with Appellants that aiming is not a game parameter. Striking the cue ball in the appropriate place and in the appropriate direction

⁴ Appellants argue that the Final Rejection was premature because the Examiner made an inherency argument for the first time after the Final Rejection, (*see, e.g.*, App. Br. 16-17 (citing MPEP § 706.07(d)).

However, MPEP § 706.07(c) provides that the prematurity of a final rejection “is purely a question of practice, wholly distinct from the tenability of the rejection. *It may therefore not be advanced as a ground for appeal, or made the basis of complaint before the Board of Patent Appeals and Interferences.* It is reviewable by petition under 37 CFR 1.181. *See* MPEP § 1002.02(c).” (Emphasis added.) We will therefore not address the issue of whether the Examiner’s Final Rejection was premature.

⁵ Reply Brief filed May 17, 2007.

clearly affects the outcome of the game. Thus, because it affects the outcome of the game, proper aim is a game parameter.

Interpreting the term “game parameter” as encompassing proper aiming is consistent with the Specification. The Specification lists bridge hand location, stroke length, stroke speed, and second stroke length as “game parameters” (FF 2). Like accurate aiming, every one of these factors relates to the technique, or process, required to successfully strike a cue ball. Thus, whether it is considered a noun (“aim”), or a verb (“aiming”) (*see, e.g., Reply Br. 7*), we agree with the Examiner that it was reasonable, and consistent with the Specification, to interpret “game parameter” to encompass aiming the cue stick, as disclosed by Gibney.

Appellants argue that Gibney does not anticipate claim 1 because inherent anticipation cannot be based on possibilities or probabilities (App. Br. 13-14), nor can it be established “by a drawing which incidentally shows a similar arrangement of parts, where such arrangement is not essential to the first invention and was not designed, adapted, and used to perform the function which it performs in the second invention, and where the first patent contains no suggestion of the way in which the result sought is accomplished by the second invention” (*id.* at 14 (*quoting Munising Paper Co. v. American Sulphite Pulp Co.*, 228 F. 700, 703-03 (6th Cir. 1915); *see also Reply Br. 10*).

We are not persuaded by this argument. As discussed above, we agree with the Examiner that Gibney explicitly meets the limitations of claim 1, including the limitation that the predetermined distance between the icon and ferrule-receiving portion of the cue “has a relationship to at least one game parameter.” The inquiry into whether Gibney anticipates claim 1

therefore does not require an evaluation of whether any inherent properties might, or might not, necessarily result from Gibney's explicit disclosure.

Appellants argue that "Gibney's marks do not necessarily have any predetermined distance from applicants' ferrule-receiving portion 230, as Gibney discloses the icon touching or extending onto the ferrule (App. Br. 15 (citing Gibney 2, ll. 9-12)). Appellants urge that "[h]aving no necessary predetermined distance, there can be no necessary relationship between the predetermined distance and a game parameter" (*id.*). Appellants urge that Gibney's decorative or aiming icons are not the same as those claimed because "[f]or example, appliqués of colorful daisies applied to a cylindrical glass have no meaning relating to the use of the glass, but calibrated marks and the words describing the marks on the glass do have a meaning for the operation of a graduated cylinder used in chemistry laboratories. By virtue of the markings, the base object becomes a different thing" (Reply Br. 11).

We are not persuaded by these arguments. Lines 9-12 on page 3 of Gibney state that "[i]n either case, pointings of the cue body could closely approach [or] even reach the base of the ferrule or a direct-fitted tip" (Gibney 3). Because Gibney states that the icons can "closely approach" the base of the ferrule, Gibney's marks are some distance from the ferrule-receiving portion of the cue, as required by claim 1. (*See also* Gibney 2 ("[A] suitable sighting aid will involve a small visible part *close* to the cue tip, conveniently *just below any ferrule* for the tip itself") (emphasis added).)

Thus, Gibney's sighting aids are some distance from the ferrule-receiving portion. Because the sighting aids must be placed in the user's field of vision (*see* FF 3), the distance between the aids and the end of

the cue is predetermined according to the user's field of vision. Further still, because the marks are placed such that they promote accurate aiming of the pool cue, the predetermined distance has a relationship to a game parameter.

Therefore, because we agree with the Examiner that Gibney meets all of the limitations of claim 1, we affirm the Examiner's anticipation rejection of that claim. Because they were not argued separately, claims 2, 3, 5, 6, 9, and 10 fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii).

ANTICIPATION -- PREAST

ISSUE

Claims 1-6, 9, and 10 stand rejected under 35 U.S.C. § 102(b) as anticipated by Preast (Ans. 3). The Examiner cites Preast as disclosing a pool cue having "differently colored laminates which form directional pointers along the shaft [which] may be used for aiming and thus meet the limitations of the claims" (*id.*).

The Examiner contends that "Preast's laminates may be considered icons located at their particular position on the pool cue and thus meet the structural limitations of the claimed pool cue and icon. How the icon is used is not at issue so long as it can be used as claimed" (*id.*).

Appellants "contend that the Examiner never presented a prima facie case of anticipation by Preast" (App. Br. 19), and that Preast does not inherently meet the limitations of claim 1 (*see id.* at 20-23).

The issue with respect to this rejection, therefore, is whether the Examiner erred in holding that Preast meets all of the limitations of claim 1.

PRINCIPLES OF LAW

"Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of

circumstances is not sufficient.” *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981) (quoting *Hansgirt v. Kemmer*, 102 F.2d 212, 214 (CCPA 1939)) (emphasis in original)).

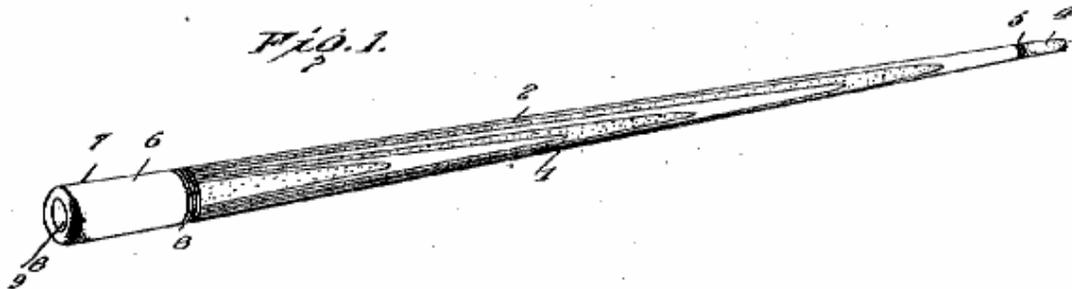
“[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.” *Hockerson-Halberstadt, Inc. v. Avia Group Int’l, Inc.*, 222 F.3d 951, 956 (Fed. Cir. 2000) (citing *In re Wright*, 569 F.2d 1124, 1127 (CCPA 1977) (“Absent any written description in the specification of quantitative values, arguments based on measurement of a drawing are of little value.”)).

FINDINGS OF FACT

8. Preast discloses a “pool or billiard cue, which is formed of a series of laminae, preferably of wood of different colors, throughout the length of the cue body, that the cue may be bent and will always resume a true or straight position, will be durable in construction, pleasing in appearance and not susceptible to becoming warped, or losing color under damp or other conditions” (Preast, page 1, ll. 9-17).

9. Preast discloses that the body portion of the cue is “constructed throughout its length of a plurality of continuous laminae extending from one end to the other, the same being preferably formed by gluing together a series of veneers and turning the cue down to the proper taper” (Preast, page 1, ll. 42-48).

10. Figure 1 of Preast, reproduced below, is a perspective view of a cue constructed according to the disclosure:



The figure shows Preast's tapered pool cue with the alternating lighter and darker colored layers of wood forming apices that point in the general direction of the cue's tip.

ANALYSIS

We agree with Appellants that the Examiner has not made out a prima facie case of anticipation based on Preast.

We note Preast's disclosure that its laminar construction, when turned to a tapered shape, yields a cue that has apices on its surface that appear to point in the general direction of the cue's tip (*see* FF 10). However, we do not agree with the Examiner that the markings on Preast's cue can necessarily be used for aiming.

As note above, "patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue." *Hockerson-Halberstadt, Inc. v. Avia Group Int'l, Inc.*, 222 F.3d at 956. The Examiner does not point to, nor do we see, any disclosure in Preast specifically stating how close the markings are to the tip of the pool cue. Nor do we see any explicit

disclosure in Preast, other than Figure 1, describing the shape and orientation of the markings on the cue.

Preast's Figure 1 therefore cannot be relied to show the actual proportions of the elements on the cue. Thus, despite the fact that Preast's Figure 1 shows the pointed markings fairly near the cue's tip, it is not clear that shaping Preast's laminar starting material into a cue-shaped taper will necessarily result in any of the markings being in a pool player's field of view when the cue is in use. Moreover, because the drawing cannot be relied on to show proportions, it is not clear that Preast's markings will necessarily have a shape or orientation relative to each other that would allow them to be used for aiming the cue.

We note that it might be possible that making a cue in the manner disclosed by Preast would inherently yield markings located and oriented such that they could be used for aiming. However, it is well settled that inherent anticipation cannot be based on possibilities or probabilities. *In re Oelrich*, 666 F.2d at 581.

Thus, because Preast does not disclose sufficient information about the structural elements of its pool cue to establish that the markings would necessarily be located and oriented to allow their use in aiming, we do not agree with the Examiner that Preast meets all of the limitations in claim 1. We therefore reverse the Examiner's anticipation rejection of claim 1 and its dependent claims 2-6, 9, and 10.

OBVIOUSNESS -- WILLIAMS AND HOLT

ISSUE

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being obvious in view of Williams and Holt (Ans. 3-4). Claim 8 recites "[t]he pool cue

system of Claim 1, wherein said at least one icon comprises at least one trademark logo.”

The Examiner cites Williams as disclosing that “it is known in the art for manufacturers to provide a cue with special marks desired by a retailer,” but concedes that “Williams only discusses placing such marks on the butt end” of a cue stick (Ans. 3). Citing Holt as disclosing that it is “known in the art to place marks along the cue,” the Examiner concludes that a person of ordinary skill in the art would have considered it obvious “to have done the same with Williams['] marks if such a visibility was desired by the user or retailer. Furthermore, such marks would inherently be useful as aiming points” (*id.* at 4).

Appellants “contend that the Examiner never presented a *prima facie* case of obviousness regarding claim 8” (App. Br. 25).

The issue with respect to the obviousness rejection, then, is whether the Examiner erred in concluding that one of ordinary skill would have considered claim 8 obvious in view of Williams and Holt.

PRINCIPLES OF LAW

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. “[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.”

In re Fritch, 972 F.2d 1260, 1265 (Fed. Cir. 1992) (citations omitted, bracketed material in original).

As the Supreme Court recently pointed out, “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.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). Thus, “[i]n determining whether obviousness is established by combining the teachings of the prior art, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.” *In re GPAC Inc.*, 57 F.3d 1573, 1581 (Fed. Cir. 1995) (internal quotations omitted).

FINDINGS OF FACT

11. Claim 8 recites “[t]he pool cue system of Claim 1, wherein said at least one icon comprises at least one trademark logo.”

12. Williams discloses “[a] label device for a billiard cue [that] has a first part which is intended to carry a self-adhesive printed label and is stuck onto the butt end of a cue, and a second part which is a window and is snapped into the first part after the printed label has been stuck in the first part” (Williams, abstract). Williams discloses that its rectangular (*see, e.g.* Figures 1 and 5) label-holding device makes it easier for cue manufacturers to provide different labels for the many retailers that sell pool cues (*see id.* at page 1, ll. 5-59).

13. Holt discloses:

Those skilled in pool often take pride in their special cues with one competitor often trying to psychologically outdo another competitor by arriving at the match with a cue having a special physical appearance. Typically, this special physical appearance relates to the types of wood grains used, the inlay of special designs along the cue, or other custom features for which the

billiard player often spends vast sums of money in the purchase of a specific pool cue over another cue of similar quality.

(Holt, col. 1, ll. 13-22.) Seeking to compete with other pool cues of ornate or special design, Holt discloses an illuminated cue that has transparent portion in the shaft which is illuminated by a light (*id.*, abstract).

ANALYSIS

We agree with Appellants that the Examiner has not made out a prima facie case of obviousness based on Williams and Holt.

We note that Holt discloses the desirability of placing ornate or special designs along the cue to impress other competitors (FF 13). However, we do not agree with the Examiner that a person of ordinary skill in the art desiring to impress competitors with ornate or special designs on a pool cue would have been prompted by Williams or Holt to place Williams' simple rectangular manufacturer/retailer label at a location on the cue that would be visible to the player when the cue was in use. Moreover, given Williams' explicit disclosure that the manufacturer/retailer label device should be in the butt end of the cue (*see* FF 12), we do not agree with the Examiner that Holt's disclosure of the desirability of ornate or special designs along the cue would have prompted a person of ordinary skill to move Williams' label device to a position on the cue that would be in a player's view when the cue was in use.

Because we do not agree with the Examiner that the cited references would have prompted a person of ordinary skill to make a pool cue having the structural elements recited in claim 8, we reverse the Examiner's obviousness rejection of that claim.

NEW GROUND OF REJECTION -- ANTICIPATION

Under the provisions of 37 C.F.R. § 41.50(b), we enter the following new ground of rejection: claim 4 is rejected under 35 U.S.C. § 102(b) as being anticipated by Gibney.

Claim 4 recites “[t]he pool cue system of Claim 1, wherein said at least one icon comprises two icons and said at least one predetermined distance comprises two distinct predetermined distances providing a distance between at least part of each icon of said two icons.” Claim 4 therefore encompasses pool cues that meet all of the limitations of claim 1, and which have two icons on their surfaces at different distances from the ferrule-receiving portion of the cue.

As discussed above, Gibney meets all of the limitations of claim 1. Gibney also discloses that its cue may have several sighting aids “about the cue” (Gibney 2-3 (FF 6)), including “an arrow formation including a straight line shaft and connected or spaced head or V” (Gibney 6 (FF 6)). Because Gibney discloses that its sighting aid may consist of an arrow formed of two icons, a straight line shaft spaced apart from an arrowhead or “V,” Gibney meets the limitations in claim 4.

NEW GROUND OF REJECTION -- OBVIOUSNESS

Under the provisions of 37 C.F.R. § 41.50(b), we enter the following new ground of rejection: claim 8 is rejected under 35 U.S.C. § 103(a) as being obvious in view of Gibney.

Claim 8 recites “[t]he pool cue system of Claim 1, wherein said at least one icon comprises at least one trademark logo.”

As discussed above, Gibney discloses a cue that meets all of the limitations of claim 1. Regarding the sighting marks on its cue, Gibney

discloses that “any way of marking or incorporating a suitable eye-training component or indication may be employed, and that its nature is subject to considerable variation compared with a simple solid or outline V as indicated in the drawings” (FF 7 (Gibney 6)).

Recently addressing the issue, the Supreme Court emphasized a flexible approach to the obviousness question, advising 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.

The Court also 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.

One of ordinary skill in designing pool cues, recognizing that Gibney’s sighting marks could incorporate a number of designs beyond the simpler ones disclosed by Gibney (*see* FF 7), and further recognizing that Gibney’s sighting marks were frequently in view of the cue’s user and other players, would have been prompted to incorporate at least one trademark logo in Gibney’s sighting marks. Being a person of ordinary creativity and common sense, *see KSR*, 127 S. Ct. at 1742-43, one of ordinary skill would have reasoned that incorporating a trademark logo into Gibney’s sighting marks would be desirable because it would ensure that the logo would be

highly visible not only to the user, but to other players and observers. We therefore conclude that claim 8 would have been obvious to a person of ordinary skill in the art in view of Gibney.

SUMMARY

We affirm the Examiner's rejection of claims 1-3, 5, 6, 9, and 10 under 35 U.S.C. § 102(b) as anticipated by Gibney.

We reverse the Examiner's rejection of claims 1-6, 9, and 10 under 35 U.S.C. § 102(b) as anticipated by Preast.

We reverse the Examiner's rejection of claim 8 under 35 U.S.C. § 103(a) as being obvious in view of Williams and Holt.

We enter a new ground of rejection of claim 4 under 35 U.S.C. § 102(b) as anticipated by Gibney. *See* 37 C.F.R. § 41.50(b).

We enter a new ground of rejection of claim 8 under 35 U.S.C. § 103(a) as being obvious over Gibney. *See* 37 C.F.R. § 41.50(b).

TIME PERIOD FOR RESPONSE

Regarding the affirmed rejection(s), 37 CFR § 41.52(a)(1) provides that "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 a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides: "A new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground 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 the appellant elect to prosecute further before the examiner pursuant to 37 CFR § 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 the 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.

AFFIRMED-IN-PART, 37 C.F.R. § 41.50(b)

Appeal 2008-0172
Application 10/949,868

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