

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte PATRICK W. MURREY,
SCOTT THOMAS, MIKE GUERZINI,
JERRY SCHREIBER, and JAMES R. ALLSHOUSE

Appeal 2008-4302
Application 10/453,358
Technology Center 3700

Decided: December 22, 2008

Before DONALD E. ADAMS, RICHARD M. LEBOVITZ, and MELANIE
L. McCOLLUM, *Administrative Patent Judges*.

McCOLLUM, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a game table. The Examiner has rejected the claims as anticipated, obvious, indefinite, and/or not being supported by an adequate written description. We have jurisdiction under 35 U.S.C. § 6(b). We affirm-in-part.

STATEMENT OF THE CASE

Claims 1, 3-7, 9-11, 13-19, and 21-36 are pending and on appeal. We will focus on claims 1, 15, 18, 19, 24, 27, and 28, which read as follows:

1. A game table with lights for placement on a support surface, comprising:
 - a game table with a playing surface;
 - a peripheral rail surrounding said playing surface and defining a playing surface side and at least one of a top side, an outside vertical side and a bottom side, wherein said playing surface side borders said playing surface;
 - one or more power sources mounted to said game table;
 - one or more lights mounted to said game table and powered by said one or more power sources, wherein at least one of said one or more lights is mounted on at least one of said top side, said outside vertical side and said bottom side; and
 - one or more protective members attached to said game table and oriented to completely prevent players from viewing one or more lights during play.

15. The game table of claim [1 further comprising a controller configured to automatically switch said one or more lights on or off in response to predetermined conditions,] wherein said controller switches said lights on when the ambient light falls below a threshold.

18. A game table with lights, comprising:
 - a game table configured for placement on a support surface and having a rail and apron surrounding a playing surface, wherein said apron defines a bottom direction, said bottom direction being approximately perpendicular to the support surface; and,
 - a plurality of lights mounted to said game table with the at least one light mounted behind said apron to provide illumination directed in said bottom direction.

19. The apparatus of claim 18 wherein said lights are downward facing.

24. A billiards table, comprising:
a billiards table configured for placement on a support surface and having a top, two vertical end portions and two vertical side portions, and defining a downward direction toward the support surface; and,
at least one light mounted to one of said vertical side portions and oriented to provide indirect lighting predominantly in said downward direction.

27. A billiards table, comprising:
a billiards table with a playing surface wherein said playing surface includes a surrounding rail;
an upper apron with an outside portion mounted to said rail;
a lower apron mounted to said billiards table and offset horizontally inward from said upper apron outside portion; and
one or more lights mounted in the horizontal distance between said lower apron and said upper apron outside portion.

28. The billiards table of claim 27 wherein said lights are directed downward.

Claims 1, 3-7, 9-11, and 13-17 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement (Ans. 3).

Claims 15, 16, and 32 stand rejected under 35 U.S.C. § 112, second paragraph (Ans. 3).

Claims 1, 3, 4, 18, 19, 24, 25, and 33-36 stand rejected under 35 U.S.C. § 102(b) as anticipated by Horgan (WO 98/47586 A1, Oct. 29, 1998) (Ans. 3).

Claims 18, 24, 25, 27, 29, and 36 stand rejected under 35 U.S.C. § 102(b) as anticipated by Withers (GB 2,232,606 A, Dec. 19, 1990) (Ans. 6).

Claims 1, 3-7, 9-11, 13-17, 19, 21-23, 26, 28, 30-32, and 35 stand rejected under 35 U.S.C. § 103(a) as obvious over Withers in view of Horgan (Ans. 8).

WRITTEN DESCRIPTION

Issue

Have Appellants shown that the Specification provides written description support for the recitation in claim 1 of “one or more protective members attached to said game table and oriented to completely prevent players from viewing said one or more lights during play”?

Findings of Fact

1. The Specification discloses a game table including “a playing surface, held over a support surface, such as a floor, by a support structure such as one or more legs or pedestals” (Spec. 4: 8-13).

2. The Specification also discloses that “the playing surface is surrounded by a peripheral rail, which typically functions to retain game pieces within the area of the playing surface” (*id.* at 4: 15-16).

3. In addition, the Specification discloses light sources “mounted on the top, vertical sides or bottoms of the rails” (*id.* at 4: 23 to 5: 1).

4. Specification Figure 1A is reproduced below:

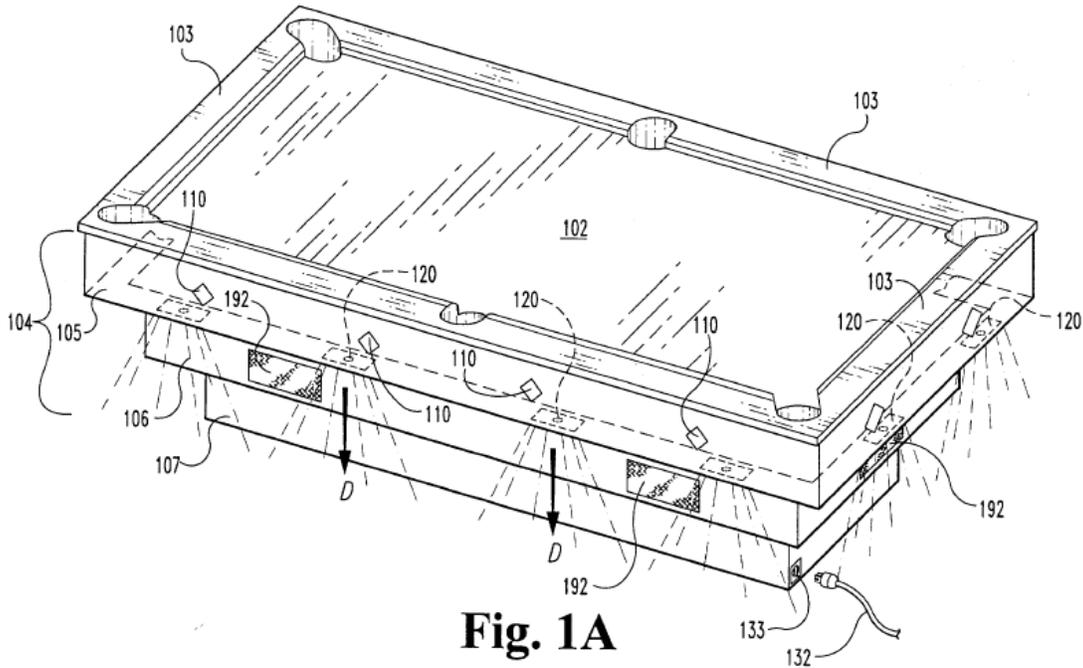


Figure 1A depicts a game table 100 “including a playing surface 102 surround[ed] by a railing 103 and supported by the base of a stepped apron 104. . . . Apron 104 includes upper, middle and lower portions or tiers 105, 106 and 107.” (*Id.* at 6: 6-11.) “Shown in partial cut-away are lights 120, mounted on a lower portion of upper tier 105 above middle tier 106. Lights 120 are situated in the horizontal distance between the vertical outer portion of upper tier 105 and middle tier 106.” (*Id.* at 6: 11-13.)

5. In addition, the Specification discloses a game table illustrated in Figures 3A-B having “lights 320 extending from the sides of railing 303” and states that “[l]ights 320 may be exposed, or may have protective covers.” (*Id.* at 8: 18-22.)

Analysis

“In order to satisfy the written description requirement, the disclosure as originally filed does not have to provide *in haec verba* support for the claimed subject matter at issue.” *Purdue Pharma L.P. v. Faulding, Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000). Nonetheless, the disclosure must convey with reasonable clarity to those skilled in the art that the inventor was in possession of the invention. *See id.*

Appellants argue that Specification Figures 1A and 1C “depict a protective member (upper portion or tier 105) attached to game table 100 and oriented to completely prevent players from viewing lights 120 during play” (App. Br. 12). In particular, Appellants argue:

As would be appreciated by one of ordinary skill in the art, the viewing point of a player during play is above the playing surface 102. Lights 120 are oriented to emit light in the downward direction D and the outer surface of upper-tier 105 prevents players from viewing any portion of the lights 120 during play. The players will see the effects of the light emanating from lights 120 without directly viewing the lights 120 during play.

(*Id.* at 12-13.)

We are not persuaded. Claim 1 requires that the peripheral rail surrounding the playing surface has a playing surface side and at least one of a top side, an outside vertical side, and a bottom side and that a light is mounted to the game table on at least one of the top side, the outside vertical side, and the bottom side of the peripheral rail. In Specification Figure 1A, lights are mounted on the lower portion of upper tier 105 above middle tier 106 (Finding of Fact (FF) 4). Thus, in order to depict light(s) mounted on at least one of the top side, the outside vertical side, or the bottom side of

a peripheral rail, upper tier 105 would need to be considered part of the peripheral rail. However, if upper tier 105 is considered part of the peripheral rail, it cannot also be considered a protective member that is attached to the game table. Stated another way, if upper tier 105 is considered a protective member attached to the game table, and not part of the peripheral rail, it is unclear how Figure 1A depicts a peripheral rail having a playing surface side, and at least one of a top side, an outside vertical side, and a bottom side with one or more lights mounted to the game table on at least one of the top side, the outside vertical side, and the bottom side of the peripheral rail.

For the reasons above, we agree with the Examiner that Appellants have not shown that the Specification provides written description support for the recitation in claim 1 of “one or more protective members attached to said game table and oriented to completely prevent players from viewing said one or more lights during play.” We therefore affirm the rejection of claim 1 under 35 U.S.C. § 112, first paragraph. Claims 3-7, 9-11, and 13-17 have not been argued separately and therefore fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii).

INDEFINITENESS

Issue

Have Appellants shown that the Examiner erred in concluding that the claim recitation “the ambient light” is indefinite?

Findings of Fact

6. Claim 15 ultimately depends from claim 1 and recites that a controller switches the “lights on when the ambient light falls below a threshold.”

7. There is not an earlier reference to ambient light in claim 15 or in a claim from which it depends.

Analysis

“A claim is indefinite if its legal scope is not clear enough that a person of ordinary skill in the art could determine whether a particular composition infringes or not.” *Geneva Pharms., Inc. v. GlaxoSmithKline PLC*, 349 F.3d 1373, 1384 (Fed. Cir. 2003).

The Examiner finds that there is insufficient antecedent basis for the limitation in, for example, claim 15 of “the ambient light” (Ans. 3). The recitation of “the ambient light” in claim 15 does not refer back to an earlier reference to “ambient light” (FF 7). However, we agree with Appellants that the failure of this phrase to refer back to an earlier reference to “ambient light” does not render claim 15 indefinite. Instead, we agree with Appellants that one of ordinary skill in the art would understand that “the ambient light” refers to the light surrounding the game table (App. Br. 13-14).

For the reasons above, we agree with Appellants that the Examiner has not shown that the recitation of “the ambient light” is indefinite. We therefore reverse the rejection of claims 15, 16, and 32 under 35 U.S.C. § 112, second paragraph.

ANTICIPATION - HORGAN

Issues

Have Appellants shown that the Examiner erred in concluding that Horgan discloses a game table having: (1) “one or more protective members attached to said game table and oriented to completely prevent players from viewing said one or more lights during play,” as recited in claim 1; (2) “at least one light mounted behind said apron to provide illumination directed in said bottom direction,” as recited in claim 18; (3) downward facing lights, as recited in claim 19; and (4) “at least one light mounted to one of said vertical side portions and oriented to provide indirect lighting predominantly in said downward direction,” as recited in claim 24.

Findings of Fact

8. Horgan discloses “an illuminated billiard or pool table comprising a translucent optical fiber and a light generator, wherein the optical fiber is located on a surface of the table” (Horgan 2: 13-15).

9. Horgan also discloses that the “optical fiber may be positioned on or adjacent the playing surface or on an exterior surface of the table. The optical fiber projects light onto the playing surface and/or the exterior surface of the table to provide functional and/or decorative lighting.” (*Id.* at 15-18.)

10. In addition, Horgan discloses a billiard or pool table including “a channel sized to house the optical fibers on or adjacent the playing surface or on the exterior surface. . . . Preferably, the channel which contains the optical fiber cable extends and runs at least a portion of a length

of or adjacent the playing surface of the table for directing illumination laterally therefrom.” (*Id.* at 2: 19 to 3: 5.)

11. Horgan also discloses that the “light illuminates the playing surface, the exterior surface and/or a surrounding area with a back light effect, radiating laterally from the surface of the pool table with an even and continuous glow” (*id.* at 4: 19-21).

12. As depicted in Figure 1, Horgan discloses a pool table having “[o]ne or more light emitting optical fibers 100a . . . installed on or adjacent the perimeter of the playing surface of the pool table” and “one or more light emitting optical fibers 100b . . . installed on an exterior surface 4 of the pool table” (*id.* at 5: 1-10 & Fig. 1).

13. Horgan also discloses that the “exterior surface is defined as a surface other than the playing surface 1” and therefore “comprise[s,] inter alia, the sides 4a of the table, the top of the rails 4b, or the table support legs 4c” (*id.* at 5: 10-13).

14. In addition, Horgan discloses that optical fibers 100a are within the area surrounded by sides 4a of the table (*id.* at Fig. 1 & 2; *see also* at 5: 1-6).

15. Horgan also discloses:

In . . . embodiments, the optical fibers 100 are arranged in a discontinuous manner on the surface, for example in a discontinuous manner around the perimeter of the playing surface and/or the exterior surface, i.e. the illumination is interrupted along the respective perimeter. For example, light may be blocked by an opaque covering which bisects or otherwise interrupts the length of the cable along the respective surface.

(*Id.* at 5: 21 to 6: 3.)

16. The Specification discloses that “indirect lighting” refers to “light primarily directed away from the playing surface” (Spec. 5: 2-3).

Analysis

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

With regard to claim 1, the Examiner finds that Horgan “shows the light(s) may be blocked by an opaque covering” (Ans. 4). Appellants argue that “Horgan has no protective members oriented to prevent one or more players from viewing optical fibers 100 during play. At least portions of each disclosed optical fiber 100 are viewed by a player during play.” (App. Br. 15). In particular, Appellants argue that the passage of Horgan relied upon by the Examiner for teaching this feature “discloses blocking mere *portions* of the optical fibers from players’ view with the opaque coverings, allowing players to still view other portions of the optical fibers during play” (*id.*). We agree with Appellants that the Examiner has not shown that Horgan anticipates claim 1.

Claim 1 recites that the game table with lights includes: (1) a game table; (2) “one or more lights mounted to said game table”; and (3) “one or more protective members attached to said game table and oriented to completely prevent players from viewing said one or more lights during play.” We interpret claim 1 to require that the game table with lights includes a protective member that is oriented relative to a mounted light such that players cannot view this mounted light during play.

Horgan discloses a game table having a light, specifically an optical fiber, mounted thereon (FF 8). Horgan discloses that the “light may be blocked by an opaque covering which bisects or otherwise interrupts the length of the [optical fiber] cable” (FF 15). However, we agree with Appellants that this opaque covering is not oriented relative to a mounted light, i.e., an optical fiber, such that players cannot view this mounted light during play. Instead, Horgan discloses that this opaque covering covers portions of an optical fiber such that “illumination is interrupted along the respective perimeter” (FF 15).

With regard to claim 18, Appellants argue that “Horgan does not disclose, either expressly or inherently, lights mounted behind an apron” (App. Br. 19). In particular, Appellants argue that “Horgan merely discloses optical fibers 100 located *on* the exterior surface of side 4a (‘upper apron’) and *on* the exterior surface supporting leg 4c (‘lower apron’) even when assuming the Office’s interpretation of exterior surface 4 being an ‘apron’” (*id.*).

Appellants also argue that “Horgan does not disclose lights mounted behind an apron and directed in a bottom direction approximately perpendicular to the support surface. In contrast, . . . Horgan discloses optical fibers mounted on a surface of the pool table and directed either horizontally and/or upwardly.” (*Id.* at 19-20.)

We are not persuaded. Appellants do not dispute that the sides 4a of Horgan’s table constitute an apron (App. Br. 19). Horgan discloses that optical fibers 100a are within the area surrounded by sides 4a of the table (FF 16). Thus, we are aware of no reason that optical fibers 100a cannot be

considered to be mounted behind the apron. In addition, although Horgan specifically discloses lateral illumination (FF 10-11), we are aware of no reason a translucent optical fiber would not also provide illumination directed in the bottom direction.

With regard to claim 19, the Examiner finds that Horgan “shows the one or more lights (100a, 100b) can be located on a surface of the table, on or adjacent the playing surface, or on an exterior surface of the table (sides, to rail or support legs). When positioned on the support legs or the sides of the table the light would be facing somewhat downwardly (see figure 1).” (Ans. 5.) Appellants argue that “Horgan does not disclose one or more downward facing lights” (App. Br. 21). We agree with Appellants that the Examiner has not shown that Horgan anticipates claim 19.

Claim 19 depends from claim 18 and recites that the lights are downward facing. We interpret this claim to require that the lights have a front face and that this face is downward facing. Horgan discloses translucent optical fibers (FF 8). As discussed above, we agree that these optical fibers would provide illumination directed in the bottom direction. However, we agree that the Examiner has not pointed to a teaching in Horgan of a light that is downward facing. Furthermore, we note that “said lights” in claim 19 refers to the plurality of lights recited in claim 18, which includes at least one light mounted behind the apron. The Examiner has not shown that any light mounted behind the apron is downward facing.

With regard to claim 24, the Examiner finds that Horgan “discloses a billiards table comprising . . . at least one light mounted (100b) to one of the vertical side portions and oriented to provide indirect lighting. . . .

Depending on the placement of the lights, the lights are capable of producing predominantly downward direction lighting.” (Ans. 5.) Appellants argue that “Horgan does not disclose at least one light mounted to a vertical side portion and oriented to provide lighting predominately in the downward direction toward the support surface” (App. Br. 22). We agree with Appellants that the Examiner has not shown that Horgan anticipates claim 24.

The Specification defines indirect lighting as “light primarily directed away from the playing surface” (FF 16). As a result, claim 24 requires a light mounted to one of the vertical side portions and oriented to provide “light primarily directed away from the playing surface” and “predominately” in the downward direction.

Horgan discloses a pool table having “one or more light emitting optical fibers 100b . . . installed on an exterior surface 4 of the pool table” (FF 12). Horgan also discloses that the “exterior surface is defined as a surface other than the playing surface 1” and therefore “comprise[s,] inter alia, the sides 4a of the table, the top of the rails 4b, or the table support legs 4c” (FF 13). Thus, Horgan discloses indirect lighting, i.e., “light primarily directed away from the playing surface” (FF 16). In addition, depending on where the light is placed, Horgan’s optical fibers may be capable of providing indirect lighting predominantly in the downward direction. However, we agree with Appellants that the Examiner has not pointed to a teaching in Horgan of a light mounted to one of the vertical side portions of the table that is oriented to provide indirect lighting predominantly in the downward direction.

Conclusions of Law

As discussed above, we agree with the Examiner that Horgan discloses a game table having “at least one light mounted behind said apron to provide illumination directed in said bottom direction,” as recited in claim 18. We therefore affirm the rejection of claim 18 as anticipated by Horgan.

However, we agree with Appellants that the Examiner has not shown that Horgan discloses a game table having: “one or more protective members attached to said game table and oriented to completely prevent players from viewing said one or more lights during play,” as recited in claim 1; downward facing lights, as recited in claim 19; or “at least one light mounted to one of said vertical side portions and oriented to provide indirect lighting predominantly in said downward direction,” as recited in claim 24. We therefore reverse the rejection of claims 1, 19, and 24 and of claims 3, 4, 25, and 33-36, which depend from claims 1, 19, or 24, as anticipated by Horgan.

ANTICIPATION - WITHERS

Issues

Have Appellants shown that the Examiner erred in concluding that Withers discloses a game table having: (1) “at least one light mounted behind said apron to provide illumination directed in said bottom direction,” as recited in claim 18; (2) “at least one light mounted to one of said vertical side portions and oriented to provide indirect lighting predominantly in said downward direction,” as recited in claim 24; and (3) “one or more lights

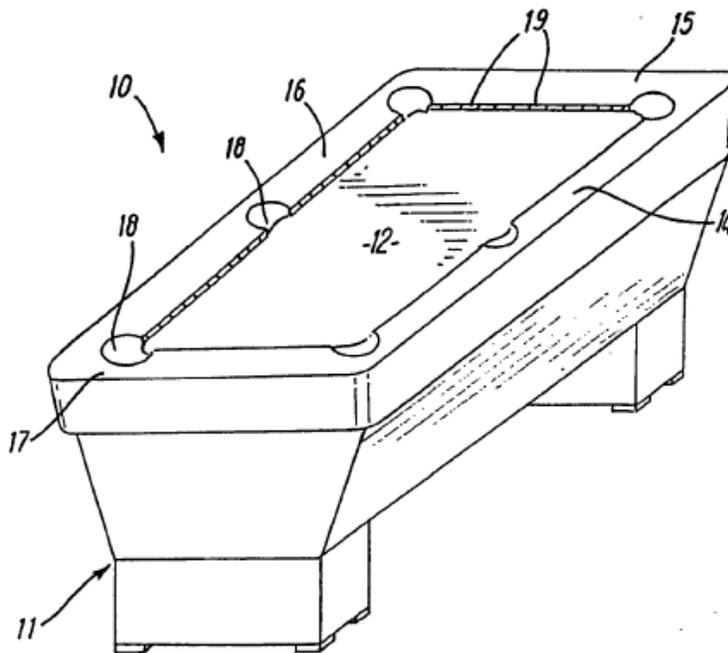
mounted in the horizontal distance between said lower apron and said upper apron outside portion,” as recited in claim 27.

Findings of Fact

17. Withers discloses “a lighting arrangement for a games table . . . having a floor standing base part supporting a top playing surface bounded by peripheral cushion structures wherein said arrangement comprises illumination means disposed on or adjacent to said playing surface” (Withers 1: 21-25).

18. Withers also discloses that the “illumination means may be interposed between said cushion structures and said playing surface or alternatively may be mounted within said cushion structures, in both cases said means being arranged to direct light outwardly across the playing surface” (*id.* at 2: 9-12).

19. Withers Figure 1 is reproduced below:



The figure above depicts a lighting arrangement incorporated in a pool table (Withers 3: 5-6). The table 10 has a floor-standing base 11 and a top surface 12 bounded by cushions 14-17 (*id.* at 3: 11-14). Multiple illumination devices 19 comprising conventional bulbs are disposed in the cushions 14-17 (*id.* at 3: 16-19). “The bulbs 19 are electrically connected by means not shown to a source of electrical power which can be provided within the table 10” (*id.* at 3: 22-24).

20. In particular, Withers Figure 1 depicts a “game table (10) includ[ing] an upper apron (the outer vertical sides of the cushions 14-17) and a lower apron (the inwardly slanted mid section of the base 11, positioned between the legs and the rails), wherein the lower apron is offset horizontally inward from the upper apron” (Ans. 15; Withers Fig. 1).

21. In addition, Withers discloses that illumination devices 19 are within the area surrounded by the upper apron (Withers Fig. 1).

22. Alternatively, Withers discloses that the “playing surface may be formed from transparent or translucent material and in this case the illumination means may be disposed beneath said playing surface thereby to illuminate the same from below and therefore said means may be supported within said base part” (*id.* at 2: 15-18).

23. In particular, Withers discloses “a spotlight 21 suitably mounted within the base 11 and arranged to direct light onto the [playing surface]” (*id.* at 4: 5-9).

24. In addition, Withers discloses that spotlight 21 is within the area surrounded by the lower apron (*id.* at Fig. 2).

Analysis

As noted above, a “claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co., supra*.

With regard to claim 18, Appellants argue that “Withers does not disclose, either expressly or inherently, at least one light mounted behind an apron” (App. Br. 24). Appellants also argue that “Withers does not disclose at least one light providing illumination directed in a bottom direction” (*id.*).

We are not persuaded. First, Withers discloses lights mounted within the area surrounded by the upper and lower aprons (FF 21 & 24). Thus, we agree with the Examiner that Withers discloses at least one light mounted behind the apron. In addition, although the purpose of Withers’ lights is “to direct light outwardly across the playing surface” (FF 18) or to direct light upwardly onto the playing surface (FF 22-23), we are aware of no reason why these lights would not also “provide illumination directed in said bottom direction,” as recited in claim 18.

With regard to claim 24, the Examiner finds that Withers discloses “at least one light mounted (bulb 19) to one of the vertical side portions and oriented to provide indirect lighting predominantly in the downward direction” (Ans. 6-7). Appellants argue that “Withers does not disclose ‘at least one light ... oriented to provide indirect lighting predominantly in [the] downward direction’” (App. Br. 26). In particular, Appellants argue that “[i]ndirect light is defined in the specification as ‘light primarily directed away from the playing surface ...’ In contrast, Withers discloses light directed upward or substantially in a horizontal direction for directly

illuminating the playing surface.” (*Id.*) We agree with Appellants that the Examiner has not shown that Withers anticipates claim 24.

As discussed above, claim 24 requires a light mounted to one of the vertical side portions and oriented to provide indirect light, i.e., “light primarily directed away from the playing surface,” that is “predominately” in the downward direction. As discussed above, Withers discloses illumination means “arranged to direct light outwardly across the playing surface” (FF 18) or to direct light upwardly onto the playing surface (FF 22-23). The Examiner does not explain how Withers discloses at least one light “oriented to provide indirect lighting predominantly in the downward direction,” as recited in claim 24.

With regard to claim 27, the Examiner finds that Withers discloses a billiards table comprising “one or more lights (21) mounted in the horizontal distance between the lower apron and the upper apron outside portion (see figure 2)” (Ans. 7). Appellants argue that “Withers does not disclose one or more lights mounted in the horizontal distance between an upper apron outside portion and a lower apron offset horizontally inward from the upper apron outside portion” (App Br. 27). We agree with Appellants that the Examiner has not shown that Withers anticipates claim 27.

Claim 27 is directed to a billiards table comprising an upper apron with an outside portion, a lower apron offset horizontally inward from the upper apron outside portion, and a light mounted in the horizontal distance between the lower apron and the upper apron outside portion. Withers discloses “a spotlight 21 suitably mounted within the base 11 and arranged to direct light onto the [playing surface]” (FF 23). However, the Examiner

has not shown that Withers discloses mounting this light in the horizontal distance between the lower apron and the upper apron outside portion.

Conclusions of Law

As discussed above, we agree with the Examiner that Withers discloses a game table having “at least one light mounted behind said apron to provide illumination directed in said bottom direction,” as recited in claim 18. We therefore affirm the rejection of claim 18 as anticipated by Withers.

However, we agree with Appellants that the Examiner has not shown that Withers discloses a game table having: “at least one light mounted to one of said vertical side portions and oriented to provide indirect lighting predominantly in said downward direction,” as recited in claim 24; or “one or more lights mounted in the horizontal distance between said lower apron and said upper apron outside portion,” as recited in claim 27. We therefore reverse the rejection of claims 24 and 27 and of claims 25, 29, and 36, which depend from claims 24 or 27, as anticipated by Withers.

OBVIOUSNESS

Issues

Have Appellants shown that the Examiner erred in concluding that claims 1, 19, 21-23, 26, 28, and 30-32 would have been obvious?

Analysis

Under 35 U.S.C. § 103, “the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.

Against this background, the obviousness or nonobviousness of the subject matter is determined.” *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

With regard to claim 1, the Examiner relies on Withers for teaching a game table with lights comprising a game table (pool table 10), the table including a playing surface (12) and a peripheral rail (14-17) surrounding the playing surface, the rail including [a] playing side, a top side, an outside vertical side and a bottom side; one or more power sources mounted to the game table . . . and one or more lights (bulbs 19) mounted to the game [table] and powered by the power source.

(Ans. 8.) The Examiner relies on Horgan for teaching a game table having “one or more lights . . . mounted on at least [a] top side or outside vertical side” and for teaching that “the light(s) may be blocked by an opaque covering” (*id.* at 8-9). The Examiner concludes that “it would have been obvious to position the light at any desired location on the Withers table, the motivation being to provide functional and/or decorative lighting for the game table of Withers” (*id.* at 9).

Appellants argue that “neither Withers nor Horgan discloses a protective member that prevents players from viewing a light mounted to the peripheral rail” (App. Br. 29). We agree with Appellants that the Examiner has not set forth a prima facie case that claim 1 would have been obvious.

As discussed above, claim 1 requires that the game table includes a protective member that is oriented relative to a mounted light such that players cannot view this mounted light during play. The Examiner relies on Horgan for teaching the claimed protective member (Ans. 9). However, for the reasons discussed above, we do not agree that the Examiner has shown

that Horgan teaches the claimed protective member, nor has the Examiner shown that the claimed protective member would have been obvious.

With regard to claim 19, the Examiner finds that “Withers shows the lights are adjustable and can be positioned in any desired direction, including downward facing” (Ans. 12). Appellants argue that “claim 19 is allowable since neither Withers, Horgan, nor their combination disclose or suggest downward facing lights” (App. Br. 32). We agree with Appellants that the Examiner has not set forth a prima facie case that claim 19 would have been obvious.

Claim 19 depends from claim 18 and recites that “said light are downward facing.” As discussed above, “said lights” refers to the plurality of lights recited in claim 18, which includes at least one light mounted behind the apron. Withers discloses that the lights are for illuminating the playing surface (FF 18 & 24), not underneath it. The Examiner has not provided a sufficient reason to include a downward facing light behind the apron.

With regard to claims 21-23, Appellants argue that these claims are patentable based on their dependency on claim 18 (App. Br. 32). However, we have affirmed the anticipation rejections of claim 18 over Withers and Horgan. Thus, we do not find Appellants’ argument persuasive.

With regard to claim 26, Appellants argue that this claim is allowable based on its dependency on claims 24 and 25, which are not rejected under 35 U.S.C. § 103 and are “patentable since they are anticipated by neither Horgan nor Withers” (App. Br. 33). We are not persuaded.

As discussed above, we agree with Appellants that the Examiner has not shown that claims 24 and 25 are anticipated by Withers or Horgan. However, Appellants have not shown that claims 24 and 25 would not have been obvious over Withers in view of Horgan. In particular, Horgan discloses including lights on the exterior surface of the table “to provide functional and/or decorative lighting” (FF 9). In addition, Horgan discloses that the “exterior surface is defined as a surface other than the playing surface” and therefore “comprise[s,] inter alia, the sides 4a of the table, the top of the rails 4b, or the table support legs 4c” (FF 13). Thus, in the absence of sufficient arguments to the contrary, we agree with the Examiner that, in view of the teachings in Horgan, “it would have been obvious to position . . . light[s] at any desired location on the Withers table, the motivation being to provide functional and/or decorative lighting for the game table of Withers,” and that, “[d]epending on the placement of the lights, the lights are capable of producing predominantly downward direction lighting” (Ans. 9 & 5).

With regard to claim 28, Appellants argue that this claim is allowable based on its dependency on claim 27, which “is patentable since claim 27 is not anticipated by Withers” (App. Br. 33). Appellants also argue that “claim 28 is allowable since . . . neither Withers nor Horgan disclose or suggest downward directed lights mounted in the horizontal distance between a lower apron and an upper apron outside portion” (*id.*) We are not persuaded.

As discussed above, we agree with Appellants that the Examiner has not shown that claim 27 is anticipated by Withers. However, Appellants

have not shown that claim 27 would not have been obvious over Withers in view of Horgan. As discussed above, Horgan discloses including lights on the exterior surface of the table “to provide functional and/or decorative lighting” and discloses that the “exterior surface is defined as a surface other than the playing surface” and therefore “comprise[s,] inter alia, the sides 4a of the table, the top of the rails 4b, or the table support legs 4c” (FF 9 & 13). Thus, in the absence of sufficient arguments to the contrary, we agree with the Examiner that, in view of the teachings in Horgan, “it would have been obvious to position . . . light[s] at any desired location on the Withers table,” including directed downward, as recited in claim 28 (Ans. 9 & 13). It is proper to “take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007).

With regard to claims 30-32, Appellants argue that these claims are patentable based on their dependency on claims 27 and 29, which are not rejected under 35 U.S.C. § 103 and are “patentable since neither is anticipated by Withers” (App. Br. 34). We are not persuaded.

As discussed above, we agree with Appellants that the Examiner has not shown that claims 27 and 29 are anticipated by Withers. However, Appellants have not shown that claims 27 and 29 would not have been obvious over Withers in view of Horgan. As discussed above, Horgan discloses including lights on the exterior surface of the table “to provide functional and/or decorative lighting” and discloses that the “exterior surface is defined as a surface other than the playing surface” and therefore “comprise[s,] inter alia, the sides 4a of the table, the top of the rails 4b, or

the table support legs 4c” (FF 9 & 13). Thus, in the absence of sufficient arguments to the contrary, we agree with the Examiner that, in view of the teachings in Horgan, “it would have been obvious to position . . . light[s] at any desired location on the Withers table” (Ans. 9).

Conclusions of Law

As discussed above, Appellants have not shown that the Examiner erred in concluding that claims 21-23, 26, 28, and 30-32 would have been obvious over Withers in view of Horgan. We therefore affirm the obviousness rejection of claims 21-23, 26, 28, and 30-32.

However, we agree with Appellants that the Examiner has not shown that claims 1 and 19 would have been obvious over Withers in view of Horgan. We therefore reverse the obviousness rejection of claims 1 and 19 and of claims 3-7, 9-11, 13-17, and 35, which depend from either claim 1 or claim 19.

CONCLUSION

We affirm the written description rejection of claims 1, 3-7, 9-11, and 13-17, the anticipation rejections of claim 18, and the obviousness rejection of claims 21-23, 26, 28, and 30-32. However, we reverse the anticipation rejections of claims 1, 3, 4, 19, 24, 25, 27, 29, and 33-36 and the obviousness rejection of claims 1, 3-7, 9-11, 13-17, 19, and 35. We also reverse the rejection of claims 15, 16, and 32 under 35 U.S.C. § 112, second paragraph. Thus, claims 19, 24, 25, 27, 29,¹ and 33-36 are not currently subject to a rejection.

¹ The obviousness rejection of claims that depend from claims 24, 25, 27, and 29 have, however, been affirmed.

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

AFFIRMED-IN-PART

Ssc:

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