

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STANLEY A. KIM

Appeal 2008-5041
Application 11/059,597
Technology Center 3700

Decided: November 25, 2008

Before DEMETRA J. MILLS, ERIC GRIMES, and RICHARD M. LEBOVITZ, *Administrative Patent Judges*.

GRIMES, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a test preparation product, which the Examiner has rejected as obvious. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

Appellant's Specification discloses "test preparation devices including a set of problem cards adapted for use in a board game" (Spec. 1). "In addition to containing a question in an academic subject or test area, each problem card of the invention can be marked with at least one discernible

identifier that corresponds to one or more discrete game token spaces on a game board” (*id.*). The discernible identifier can be, for example, “a shape, color, symbol/icon, or alphanumeric character or string of characters” (*id.* at 2). “[T]he problem cards can be designed for use with game boards that a student/test taker might already own and have previously played for recreational purposes” (*id.* at 2).

Claims 10-21 are pending and on appeal. The claims subject to each rejection have not been argued separately and therefore stand or fall together. 37 C.F.R. § 41.37(c)(1)(vii). Claim 10 is representative and reads as follows:

10. A test preparation device compatible for use with a game board comprising at least a first game token space and a second game space, the device comprising a plurality of problem cards each having thereon at least one question in a test area consisting of subject matter from a standardized test, the plurality of problem cards comprising at least (a) a first card comprising (i) a first discernible identifier corresponding to the first game token space and a first subset of the test area and (ii) a first test preparation question relating to the first subset of the test area and (b) a second card comprising (i) a second discernible identifier corresponding to the second game token space and a second subset of the test area and (ii) a second test preparation question relating to the second subset of the test area, wherein the first discernible identifier differs from the second discernible marking, the first test preparation question differs from the second test preparation question, and the first subset differs from the second subset.

The claims stand rejected as follows:

- Claims 10-17 under 35 U.S.C. § 103(a) as obvious in view of Olutunfese¹ and Zelmer;²

¹ Olutunfese, U.S. Patent 6,547,245 B1, issued April 15, 2003.

² Zelmer, U.S. Patent 5,645,280, issued July 8, 1997.

- Claims 18 and 19 under 35 U.S.C. § 103(a) as obvious in view of Olutunfese, Zelmer, and Charouhas;³ and
- Claims 20 and 21 under 35 U.S.C. § 103(a) as obvious in view of Olutunfese, Zelmer, and Britton.⁴

OBVIOUSNESS

Issue

The Examiner finds that Olutunfese discloses cards having discernible identifiers associated with game spaces and questions, and that Zelmer discloses questions relating to subject matter from a standardized test. The Examiner concludes that it would have been obvious to combine the questions taught by Zelmer with the game cards taught by Olutunfese, and therefore the product of claim 10 would have been obvious (Office action mailed Aug. 27, 2007, at 2).

Appellant contends that the Examiner's rejection relies on the present Specification as a basis for combining the elements found in the prior art (App. Br. 8-9).

The issue to be decided is: Did the Examiner err in concluding that the claimed product would have been obvious in view of Olutunfese and Zelmer?

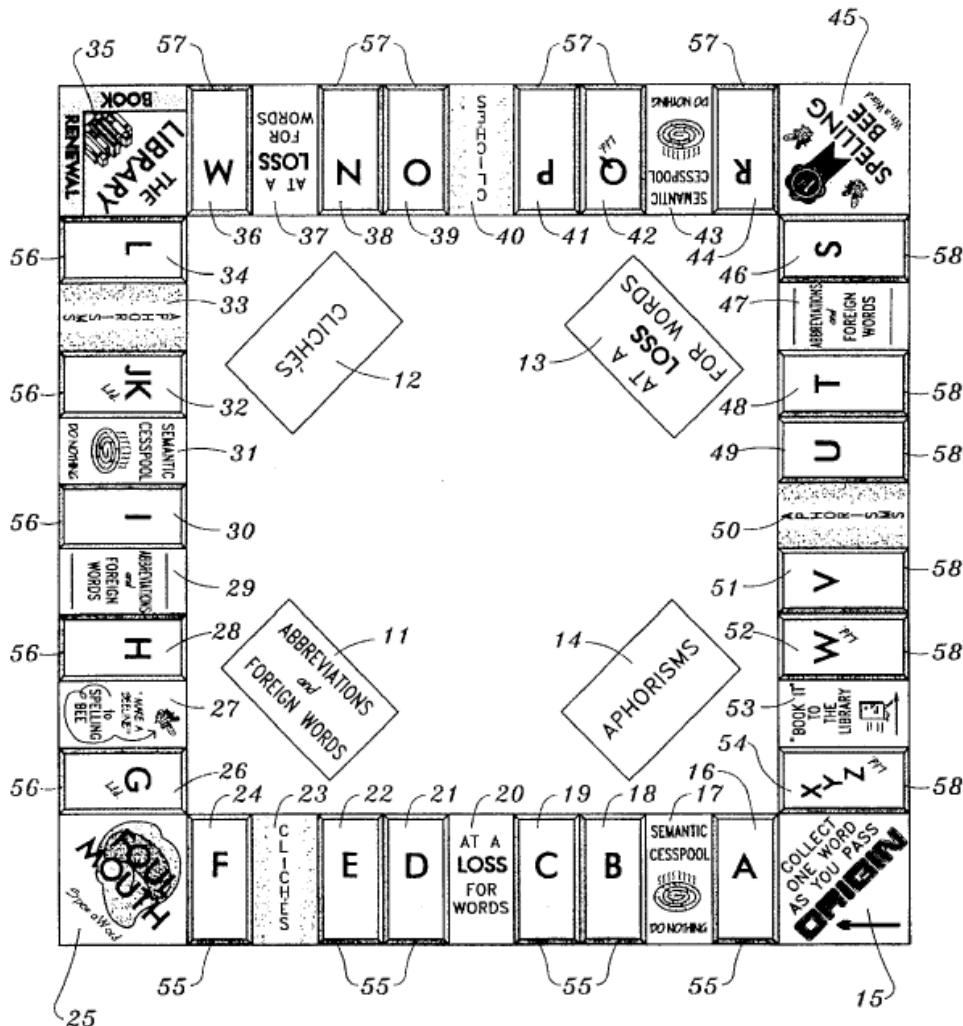
Findings of Fact

1. Zelmer discloses a board game to increase players' vocabularies (Zelmer, col. 1, ll. 29-31).

³ Charouhas, U.S. Patent 5,273,431, issued Dec. 28, 1993.

⁴ Britton, U.S. Patent 1,327,019, issued Jan. 6, 1920.

2. Zelmer states that, as a result of playing the game, players' "readiness for standardized tests, such as the Scholastic Aptitude Test and Graduate Record Examination, will be enhanced" (*id.* at col. 1, ll. 32-33).
3. Zelmer's Figure 1 is reproduced below:



The figure shows a square game board with game spaces around its perimeter. Some of the game spaces are marked with a letter (or group of letters) of the alphabet and others have game-events indicated on them.

4. Zelmer's Figures 9 and 10 are reproduced below:

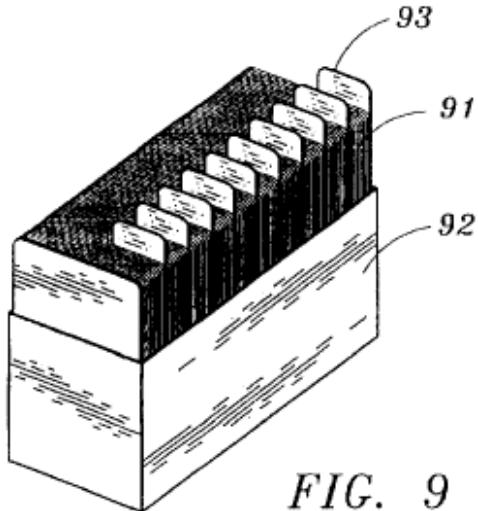


FIG. 9

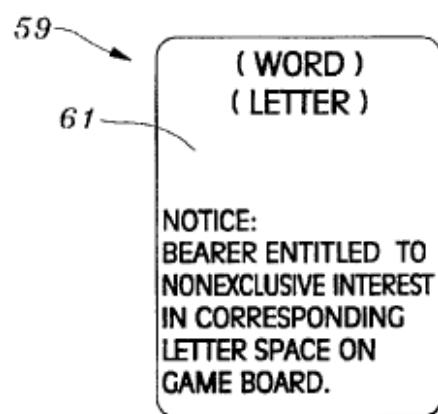


FIG. 10

Figure 9 shows a card holder containing a set of game cards; Figure 10 shows an example of a game card (*id. at col. 2, ll. 31-35*).

5. Zelmer discloses that “[i]f a player’s place marker lands on a space designated by a letter or letter group . . . , that player must correctly pronounce and define a vocabulary word on a word definition card **59** chosen from a card deck **91** with the appropriate letter designation stored in card holder **92**” (*id. at col. 4, ll. 23-28*).

6. The card 59 “bear[s] the word on one side **61** and the pronunciation and definition on the other [side] **62**” (*id. at col. 4, ll. 30-32*). Zelmer’s Figure 10 shows that each card bears the “LETTER” category of the word to be defined, as well as the word itself.

Principles of Law

“[D]uring examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.” *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000).

“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).

“[A]nticipation is the epitome of obviousness.” *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983).

Analysis

Claim 10 is directed to a product that comprises two cards, each of which includes (1) a discernible identifier that corresponds to a game token space and a subset of a test area, and (2) a question relating to that subset of the test area. The two cards include different identifiers and questions, and relate to different subsets of the test area.

Zelmer discloses a game that includes cards that have a letter on them corresponding to a game token space of Zelmer’s game board. A “discernible identifier” can be a letter. A “test area” is reasonably interpreted to encompass vocabulary words, and the limitation requiring different “subsets” of the test area encompasses vocabulary words beginning with different letters of the alphabet. Thus, Zelmer’s discernible identifier (a letter of the alphabet) corresponds to a subset of the test area (vocabulary words with that letter) and Zelmer’s cards contain a question relating to that subset. Zelmer’s game includes cards relating to different subsets of the test area (i.e., vocabulary questions beginning with different letters of the alphabet).

Zelmer discloses that use of the game (including the game cards) enhances players’ readiness for standardized tests such as the SAT or GRE.

The cards disclosed by Zelmer therefore meet all of the limitations of claim 10. Since anticipation is the epitome of obviousness, Zelmer (alone or with Olutunfese) also would have made obvious the product of claim 10.

The Examiner also rejected claims 18 and 19 as obvious in view of Olutunfese, Zelmer, and Charouhas, and rejected claims 20 and 21 as obvious in view of Olutunfese, Zelmer, and Britton (Ans. 3). With respect to these rejections, Appellant relies on his argument that Olutunfese and Zelmer would not have made obvious the product of claim 10 (App. Br. 8-9). We disagree with that position for the reasons discussed above. Appellant has not disputed the Examiner's conclusion that Charouhas or Britton would have suggested the additional limitations of claims 18-21.

CONCLUSION OF LAW

The Examiner did not err in concluding that the claimed product would have been obvious in view of Olutunfese and Zelmer.

SUMMARY

We affirm the rejection of claims 10-17 under 35 U.S.C. § 103(a) based on Olutunfese and Zelmer; the rejection of claims 18 and 19 under 35 U.S.C. § 103(a) based on Olutunfese, Zelmer, and Charouhas; and the rejection of claims 20 and 21 under 35 U.S.C. § 103(a) based on Olutunfese, Zelmer, and Britton.

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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

Ssc:

STANLEY A. KIM
12697 HEADWATER CIRCLE
WELLINGTON, FL 33414