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| MICHAEL BEST & FRIEDRICH LLP (Mke) 100 E WISCONSIN AVENUE Suite 3300 MILWAUKEE, WI 53202 | | | GRAHAM, MARK S | |
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JUSTIN L. VODEN

Appeal 2010-011335
Application 11/934,489
Technology Center 3700

Before: WILLIAM V. SAINDON, HYUN J. JUNG, and
RICHARD E. RICE, *Administrative Patent Judges*.

SAINDON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1-23, 25, and 26. We have jurisdiction under 35 U.S.C. § 6(b).

The Claimed Subject Matter

Claim 1, reproduced below, is illustrative of the claimed subject matter.

1. A three-in-one game system comprising:
 - a first base member;
 - a second base member constructed to engage the first base member and form a storage area therebetween;
 - a bag toss game target located on each of the first and second base members;
 - a washer toss game target located on each of the first and second base members; and
 - a pair of ladder golf game targets constructed to be removably affixed to the first and second base members, wherein the first and second base members form a base of the ladder golf game targets, and wherein each ladder golf game target fits within a perimeter of the first and second base members when removed therefrom for storage therein.

References

The Examiner relies upon the following prior art references:

| | | |
|---------|--------------------|---------------|
| Mudloff | US 3,628,793 | Dec. 21, 1971 |
| Haney | US 3,837,650 | Sep. 24, 1974 |
| Blume | US 4,392,653 | Jul. 12, 1983 |
| Johnson | US 4,726,591 | Feb. 23, 1988 |
| Koket | US 5,201,527 | Apr. 13, 1993 |
| Romero | US 5,417,434 | May 23, 1995 |
| Lynch | US 2005/0082761 A1 | Apr. 21, 2005 |
| Padilla | US 2006/0102667 A1 | May 18, 2006 |

*Rejections*¹

The Examiner makes the following obviousness rejections under 35 U.S.C. § 103(a):

- I. Claims 1-4, 6-11, 17-19, 23, and 25 over Blume, Johnson, Lynch, and Mudloff. Ans. 4.
- II. Claims 12, 13, 15, 16, and 26 over Blume, Johnson, Lynch, and Koket. Ans. 5.
- III. Claims 5 and 14 as applied to claims 4 and 12 above, respectively, and further in view of Romero. Ans. 7.
- IV. Claims 20 and 21 over Blume, Johnson, Lynch, Mudloff, and Haney. Ans. 7.
- V. Claim 22 over Blume, Johnson, Lynch, Mudloff, and Padilla.

SUMMARY OF DECISION

We AFFIRM-IN-PART and enter a NEW GROUND of REJECTION.

OPINION

Of Rejection I, Appellant separately argues claims 1, 9, and 17. We select claims 2-4, 6-8, 10, and 11 to stand or fall with claim 1, and claims 18, 19, 23, and 25 to stand or fall with claim 17. Appellant only argues claim 12 of Rejection II; claims 13, 15, 16, and 26 stand or fall with claim 12. Appellant does not set forth any arguments for Rejections III-V.

¹ We understand the Examiner's non-listing of a written description rejection in the Examiner's Answer as a withdrawal of the prior written description rejection (*see* Final Rejection mailed Aug. 20, 2009 p. 2), in view of Appellant's entered After Final Amendment (received Oct. 15, 2009, entered by the Examiner Nov. 19, 2009). *See also* App. Br. 2 and 4-5; Reply Br. 2.

Rejection I

The Examiner found that Blume discloses first and second base members having various targets. Ans. 4. The Examiner found that Johnson discloses that it is known in the art to utilize various types of targets on game members. *Id.* The Examiner concluded that it would have been obvious to a person of ordinary skill in the art to use “various different types of targets,” as taught by Johnson, in the Blume game, “to add further interest to it.” *Id.* The Examiner then found that Lynch discloses the common ladder-type target game. *Id.* The Examiner concluded that it would have been obvious to have attached a ladder-type target game to Blume’s base member, “to add further interest in the game.” *Id.* The Examiner noted that Johnson describes the necessity of having appropriate supports for a target game extending from the base. *Id.* The Examiner lastly found that Mudloff describes a plurality of bags and the ability to attach the base members together to form a carrying case for the game elements. Ans. 4-5. The Examiner concluded that it would have been obvious to provide such features to Blume’s game, “to use bag projectiles during play and to provide a convenient storage and transport configuration respectively.” Ans. 5.

Claim 1

Appellant argues that the Examiner’s reasoning (“to add further interest”) is improper. App. Br. 6-8; Reply Br. 3-5. Appellant’s arguments are unpersuasive. The Examiner’s combination appeals to common sense. In addition, the Examiner’s rationale finds support in Johnson. Johnson’s invention, like Appellant’s, is a simple aggregation of games into one structure. Johnson states that such a simple aggregation “permits the user to practice several skill games using the one device.” Col. 1, ll. 24-26. Clearly, adding the ability for a device to allow practicing several skill

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games “add[s] further interest.” We find no evidence (or reasoning) that the claimed aggregation is anything other than the predictable exercise of ordinary skill in the art. Instead, each individual game is as it was before; they are just all stored in the same box and share a common base member. “[W]hen 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.*, 550 U.S. 398, 417 (2007), citing *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282 (1976). Accordingly, we sustain the Examiner’s rejection of claim 1. Claims 2-4, 6-8, 10, and 11 fall therewith.

Claim 9

Claim 9 depends from claim 1 and adds a limitation of a base stand “connected to each of the first and second base members to tilt [them].” The Examiner’s rejection of claim 9 concludes that it would have been obvious to provide the base members of Blume with an angled support member, as described in Johnson. Ans. 5.

Appellant argues, and we agree, that Johnson’s tilt is due to the base itself, not a base stand “connected to” the base members. App. Br. 9. Accordingly, Appellant’s argument is persuasive of error.

However, as the Examiner demonstrates for claim 15 (see Rejection II at Ans. 6), which is similar in scope to claim 9, such a feature is obvious over Koket. Accordingly, we enter a NEW GROUND of REJECTION for claim 9 as unpatentable over Blume, Johnson, Lynch, Mudloff, and Koket. Koket describes a base stand connected to each of the first and second base members to tilt the first and second base members at an angle relative to a support surface. *See* figs. 1, 3, and 4. It would have been obvious to include such a feature in Blume, as modified by the teachings of Johnson, Lynch,

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and Mudloff as discussed *supra* with respect to the rejection of claim 1, to provide an easy way to adjust the angle of the flat Blume base to be inclined so as to provide the known target configuration for beanbag games, such as shown in Johnson and Mudloff.

Claim 17

The Examiner's rejection of claim 17 is the same as that for claim 1. Ans. 4-5. Appellant's arguments are largely duplicative of those deemed unpersuasive above. *See* App. Br. 9-11; Reply Br. 7-8. Appellant also argues, in reference to the ladder game limitation, that the claim is not simply "the addition of another simple toss game ... that utilizes the existing structure of Blume, Sr. or Johnson." App. Br. 11. However, the Examiner's proposed combination is to *modify* the Blume structure to include a ladder type target, which Lynch indicates is commonly known in the toss game art. Ans. 4-5. The Examiner is not proposing that the Blume structure already includes the necessary connector. The Examiner contends that simply adding another game to Blume, such as ladder toss, is obvious, especially in view of the teachings of Johnson, which shows an aggregated game structure. Ans. 4-5, 9. The Examiner points out that Johnson's device already contemplates a structure attached to it and extending from the base. Ans. 4; *see also* Johnson, fig. 5, item 20. In addition, we note that Lynch's ladder toss game contemplates removable bases. *See, e.g.*, Lynch, para. [0023] (discussing a friction-fit base).

Accordingly, in addition to those reasons already expressed above with respect to claim 1, we are not apprised of error in the Examiner's rejection of claim 17. Claims 18, 19, 23, and 25 fall therewith.

Rejection II

The Examiner's Rejection II (which includes claim 12) is largely similar to Rejection I, but with the substitution of Koket for Mudloff. In Rejection II, the Examiner found that Koket describes a case to store game components and concluded that it would have been obvious "to have stored the game components of the Blume/Johnson/Lynch game ... for convenience." Ans. 6.

Appellant argues that none of the references describes "a tubing structure configured to be stored within target boxes that are mated to one another." App. Br. 12; Reply Br. 9. However, the Examiner's rejection is one of obviousness, not anticipation. The Examiner's conclusion that it would have been obvious to store the game components inside a case formed by the two base members is reasonable and premised on the disclosure of Koket. Ans. 6. Appellant continues that there is no "logical connection" between storing the bags of Koket and the ladder of Lynch. App. Br. 12; Reply Br. 9. Both are the components of the game, however, and thus there is a logical connection between them. One of ordinary skill in the art has ordinary creativity and is not an automaton. *KSR*, 550 U.S. at 421; *see also id.* 418 (2007) ("the [obviousness] analysis 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"). Appellant has not apprised us of error in the Examiner's rejection of claim 12. Claims 13, 15, 16, and 26 fall therewith.

Rejections III-V

Appellant does not seek to apprise us of error in these rejections. They are sustained.

DECISION

We AFFIRM the Examiner's decision regarding claims 1-8, 10-23, 25, and 26.

We REVERSE the Examiner's decision regarding claim 9.

We enter a NEW GROUND of REJECTION for claim 9.

FINALITY OF DECISION

Regarding the affirmed rejections, 37 C.F.R. § 41.52(a)(1) provides "Appellant may file a single request for rehearing within two months of the date of the original decision of the Board." In addition to affirming the Examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review." 37 C.F.R. § 41.50(b) also provides that 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 Appellant elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek

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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 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 Patent Trial and Appeal Board for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv).

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

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