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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte NICK T. THOMOPOULOS

Appeal 2015-000528
Application 13/489,625¹
Technology Center 3700

Before THOMAS F. SMEGAL, ERIC C. JESCHKE, and PAUL J. KORNICZKY, *Administrative Patent Judges*.

SMEGAL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Nick T. Thomopoulos (Appellant) seeks our review under 35 U.S.C. § 134 of the Examiner's Final Rejection under 35 U.S.C. § 103(a) of claims 1–3, 5, and 7–15 as unpatentable over Joel (US 4,285,521, iss. Aug. 25, 1981); of claim 16 as unpatentable over Joel and either Wittwer (US 7,334,796 B2, iss. Feb. 26, 2008) or Macrory (US 4,120,503, iss. Oct. 17, 1978); and of claims 17–19 as unpatentable over Joel and Schneider (US 2006/0214370 A1, pub. Sept. 28, 2006).² We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ According to Appellant, the real party in interest is StatoGames, Inc. Appeal Br. 1.

² Claims 4 and 6 have been canceled. Appeal Br. 17 and 18, Claims App.

CLAIMED SUBJECT MATTER

Claim 1, the sole independent claim, is reproduced below and illustrates the claimed subject matter, with disputed limitations emphasized.

1. A game for simulating American football, comprising:
action cards, each action card including offensive plays and defensive outcomes,

where the action cards include a chance element of the game and the chance element is introduced by different defensive outcomes for the same offensive plays on different action cards, and

where each of the action cards includes the offensive plays and each of the offensive plays has a single corresponding defensive outcome;

a field, where the field simulates an American football field; and

markers, where the markers attach removably to the field to monitor the progress of the game, and

where the game is played by consecutively selecting the action cards and plotting the defensive outcomes of the offensive plays with the markers on the field.

ANALYSIS

Obviousness of Claims 1–3, 5, and 7–15 over Joel

We are persuaded by Appellant’s arguments that the Examiner erred in rejecting claims 1–3, 5, and 7–15 over Joel. *See* Appeal Br. 5–8.

In rejecting claim 1, the Examiner finds that Joel teaches a game having, *inter alia*, “a plurality of action cards indicating offensive plays and defensive outcomes[,]” where the “[a]ction cards can be treated as including [a] *chance element*[,]” that the Examiner determines to be “a ‘rule/method’ aspect of [the] game and not a structure.” Final Act. 2 (citing Joel, figs. 2, 3) (emphasis added). From the foregoing, the Examiner concludes that “[i]n order to convey a desired message it would have been obvious to use any

suitable indicia on the card[,]” and that “[o]ne of ordinary skills [sic] in [the] art at the time the invention was made would have suggested printing any suitable indicia to convey any desired message and to create a variation.” *Id.* at 2–3.

The Examiner also observes that “[s]hould applicant have arguments about printed matter on cards, the differences residing in meaning and information conveyed by printed matter are not considered patentable differences.” *Id.* at 2 (citations omitted).

In contesting the Examiner’s rejection as obvious over Joel, Appellant first explains that “[t]he action cards recited in [claim 1] *each* include offensive plays and a *single* corresponding defensive outcome for each offensive play” so that “different defensive outcomes for the same offensive plays [are] provided on the different action cards [to] introduce the *chance element* of Applicant’s game.” Appeal Br. 4 (emphases added). In contrast, Appellant points out that “*Joel* teaches using two decks of cards, one for each player, where the defense deck of cards determines which of a plurality of defensive outcomes results from a specific offensive play.” *Id.* at 5 (citing Joel, Abstract; col. 1, ll. 57–61; col. 3, ll. 18–20, 24–25; and figs. 2, 3).

Appellant continues by explaining that “*Joel* provides offensive plays as a first deck of cards played by the offensive player and provides the outcome of the selected offensive play with a second deck of cards played by the defensive player,” which results in “a game in which both players have a wide latitude in determining their respective strategies.” *Id.* at 6–7 (citing Joel, col. 2, ll. 23–25). However, Appellant points out that the game recited by claim 1 “provides no opportunity for the defensive player to

determine or use strategy, as the chance element is incorporated into the cards by providing different defensive outcomes for the same offensive plays.” *Id.* at 7 (citing Spec. ¶ 13).

Without responding to Appellant’s arguments regarding the deficiencies of Joel, the Examiner observes that “in an apparatus claim, limitations directed to the inherent functional characteristics of a particular structure must create a structural distinction between the claimed subject matter and the prior art[,]” and then concludes, without further elaboration, that “[i]f a prior art structure can function or be used in the manner recited in the claim the claim will read on the prior art even if there is no express mention of that capability, because it would be inherent.” Ans. 5–6.

“Inherency, however, 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 Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted). “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (BPAI 1990).

Furthermore, inherency involves a burden-shifting framework wherein the Examiner can shift the burden to an applicant to demonstrate why the allegedly inherent characteristic is not necessarily present in the prior art. MPEP § 2112(V). This is because an applicant is generally in the best position to enter evidence pertaining to how a device actually works. Nevertheless, before the burden shifts, the Examiner must provide sufficient evidence or scientific reasoning to establish that there is a sound basis for the

Examiner's belief that it is an inherent characteristic of the prior art that it produces the recited results. *See In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990) (discussing the standard for burden-shifting before the PTO); *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1351 n.4 (Fed. Cir. 2002) (discussing the similar applicability of inherency principles to both method and composition or product claims).

Here, we find that the Examiner has not provided sufficient evidence to establish that there is a sound basis for the Examiner's belief that Joel inherently discloses "action cards [that include] the offensive plays [where] each of the offensive plays has a single corresponding defensive outcome[,]" as recited by claim 1.

Regarding the Examiner's rejection of claim 1 under the "printed matter doctrine" (Final Act. 2), we agree with Appellant that "[d]ifferences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter." Appeal Br. 10 (citing *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983)). As our reviewing court also held in *Gulack*, "the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate." *Id.*

Appellant contends that "the printed matter on the action cards [recited by claim 1] directly relates to how the game is played[,]" and "results in a form of play that is not described or suggested [by] Joel." Appeal Br. 10. In particular, Appellant explains that "[t]he printed matter functionally relates to the cards, markers, and field, and distinguishes . . . claim 1 from Joel." *Id.* at 11.

In response, the Examiner reasons that “indicia on cards are functional limitations,” but that “[t]here is no patentable weight given to the printed matter unless there is an unobvious functional relationship between the printed matter and the substrate.” Ans. 6. The Examiner determines that Appellant’s “claim includes a functional relationship ‘but not an unobvious’ functional relationship[,]” and “[t]herefore, the printed matter has no patentable weight.” *Id.*

Noting that “under *Gulack*, the printed matter of the action cards must be considered when determining the patentability of [Appellant’s] claim, Appellant again explains that “*Joel* provides a game in which both players have a wide latitude in determining their respective strategies,” including “offensive plays from a first deck of cards played by the offensive player[,]” and “the selection of one of a plurality of defensive outcomes from a second deck of cards played by the defensive player.” Reply Br. 5 (citing *Joel*, col. 3, ll. 8–27). Appellant continues by again pointing out that “[i]n direct contrast to *Joel*, the action cards of [Appellant’s] claim 1 provide no opportunity for the defensive player to determine or use strategy, as a chance element is incorporated into the cards by providing different defensive outcomes for the same offensive plays.” *Id.*

Based on the foregoing, we agree with Appellant that there is a nonobvious functional relationship between the printed matter on the action cards recited by claim 1, so that “[t]he ‘two active player’ game of *Joel* cannot be played with the action cards of the pending claims[.]” *Id.* We, therefore, find that the Examiner’s legal conclusion of obviousness is not supported by evidence and, thus, cannot stand. *See In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967) (“The legal conclusion of obviousness must be

supported by facts. Where the legal conclusion is not supported by facts it cannot stand.”).

For the foregoing reasons, we do not sustain the Examiner’s rejection of claims 1–3, 5, and 7–15 over Joel.

Obviousness of Claim 16 over Joel and either Wittwer or Macrory; and of Claims 17–19 over Joel and Schneider

Regarding claims 16–19, each of the Examiner’s rejections are based on the same unsupported findings discussed above with respect to the disclosure of Joel. *See generally* Final Act. 4–5. The addition of either Wittwer or Macrory, or Schneider does not remedy the deficiencies of Joel, as discussed *supra*.

Accordingly, for similar reasons as discussed above for claim 1, we do not sustain the Examiner’s decision rejecting claim 16 over Joel and either Wittwer or Macrory; and of Claims 17–19 over Joel and Schneider.

DECISION

We REVERSE the Examiner’s rejections.

REVERSED