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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MASSIMO BARALDI, GIAN LUCA FERRARI,
IVANO NOFERINI, VITTORIO SCAGLIARINI, and ROBERTO VAIOLI

Appeal 2017-007379
Application 14/548,515¹
Technology Center 2600

Before NATHAN A. ENGELS, JAMES W. DEJMEK, and
MICHAEL M. BARRY, *Administrative Patent Judges*.

DEJMEK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 1–11. We have jurisdiction over the pending claims under 35 U.S.C. §6(b).

We reverse and enter a new ground of rejection pursuant to our authority under 37 C.F.R. § 41.50(b).

¹ Appellants identify QUBICA Europe S.P.A. as the real party in interest. App. Br. 2.

STATEMENT OF THE CASE

Introduction

In their Specification, Appellants describe a backlit keyboard for entering data in an electronic system. Spec. ¶¶ 2, 4, and 7. In a preferred embodiment, the electronic system is part of an entertainment apparatus located in a bowling center, such as the console where players may enter the names of participants in a bowling game for score keeping purposes. Spec. ¶¶ 18, 20. Additionally, in a disclosed embodiment, an ambient lighting mechanism may be mounted on a stand on which the backlit keyboard is also mounted. Spec. ¶ 99. According to the Specification, such ambient lighting is “for illuminating the area around the device or player point.” Spec. ¶ 99.

Claim 1 is exemplary of the subject matter on appeal and is reproduced below:

1. An entertainment unit comprising a backlighting system facing a flooring system and controlled by an entertainment system, the backlighting system comprises LED lights to light the flooring behind a pedestal in a bowling centre.

The Examiner’s Rejections

1. Claims 1, 3, 4, and 6–8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Tsujita (US 6,270,421 B1; Aug. 7, 2001).

Final Act. 3.

2. Claims 2 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsujita and Negley (US 2007/0019129 A1; Jan. 25, 2007).

Final Act. 4–5.²

² In the body of the rejection, claim 5 is mistakenly identified as claim 2; nevertheless, each of the recited limitations of claim 5 is addressed. Final Act. 5. We find the Examiner’s typographical error to be harmless.

3. Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsujita and Moody et al. (US 5,842,929; Dec. 1, 1998) (“Moody”). Final Act. 5.

4. Claims 10 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsujita and Gauselmann (US 2006/0063591 A1; Mar. 23, 2006). Final Act. 5–6.

*Issue on Appeal*³

Did the Examiner err in finding Tsujita discloses “the backlighting system comprises LED lights to light the flooring behind a pedestal,” as recited in claim 1?

ANALYSIS⁴

The Examiner finds Tsujita anticipates claim 1. Final Act. 3. We begin our analysis with a brief review of Tsujita.

Tsujita is generally directed to “a display unit for bowling alleys for presenting displays to bowlers and spectators in a bowling alley.” Tsujita, col. 1:5–7. Figure 2 of Tsujita, as relied on by the Examiner, is illustrative and is reproduced below:

³ We only address this issue, which is dispositive. We do not address additional issues raised by Appellants’ arguments.

⁴ Throughout this Decision, we have considered the Appeal Brief, filed September 19, 2016 (“App. Br.”); the Reply Brief, filed April 10, 2017 (“Reply Br.”); the Examiner’s Answer, mailed February 9, 2017 (“Ans.”); and the Final Office Action, mailed February 25, 2016 (“Final Act.”), from which this Appeal is taken.

FIG.2

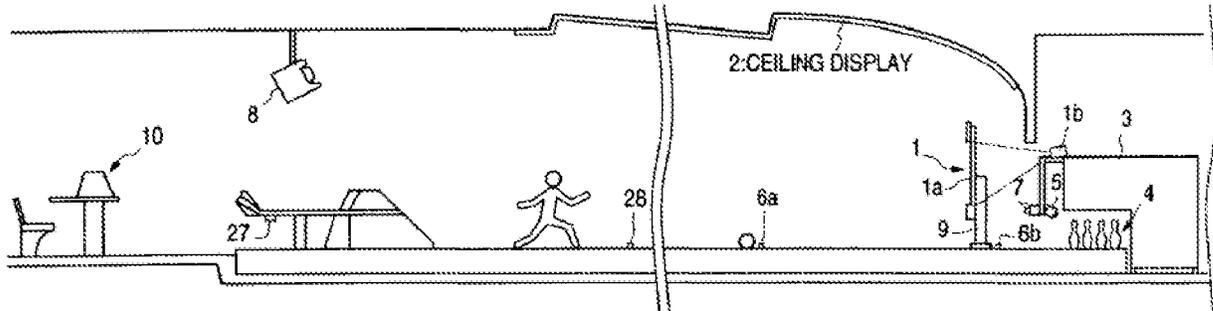


Figure 2 of Tsujita shows a side view of a lane in a bowling alley equipped with Tsujita's claimed invention. Tsujita, col 3, ll. 42–43. As shown in Figure 2, Tsujita discloses a display system viewable by a bowler comprising, *inter alia*, a masking display (1), masking display screen (1a), a projector (1b), and a ceiling display (2). Tsujita, col. 4, ll. 31–59. Tsujita describes the masking display screen (1a) and projector (1b) constitute the masking display (1) but in embodiments using a panel display (e.g., Plasma Display Panel or LED panel), the need for projector (1b) is eliminated. Tsujita, col. 4, ll. 50–56. Additionally, Tsujita discloses from above the masking display (1) to the ceiling, ceiling display (2) is “implemented by an LED or lamp is arrayed in a continuous manner.” Tsujita, col. 4, ll. 56–58.

Appellants argue Tsujita does not disclose a backlighting system facing a flooring system, as recited in claim 1. App. Br. 3. In particular, Appellants assert the masking display screen (1a), even if configured as a display panel comprising a back light of an LED display, is not facing the flooring system. App. Br. 4–5. Additionally, Appellants assert the ceiling display is described as an “LED or lamp” array for lighting the ceiling rather

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than lighting the flooring system. App. Br. 4–6 (citing Tsujita, col. 4, ll. 42–64, col. 10, ll. 33–57).

Although we agree with the Examiner that “the display 2 in the ceiling provides lighting from the ceiling, one of ordinary skill in the art would readily recognize that the light from the ceiling display 2 would reach the floor below,” the Examiner has not shown the ceiling display is a backlighting system, as recited in claim 1. Rather, Tsujita’s disclosure of a backlighting system was in relation to masking display (1), which is not “facing a flooring system.”

“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. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987). Additionally, to anticipate, a prior art reference must disclose more than “multiple, distinct teachings that the artisan might somehow combine to achieve the claimed invention.” *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008); *see also In re Arkley*, 455 F.2d 586, 587 (CCPA 1972) (“[T]he [prior art] reference must clearly and unequivocally disclose the claimed [invention] or direct those skilled in the art to the [invention] without *any* need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference.”).

For the reasons discussed *supra*, and constrained by the record before us, we do not sustain the Examiner’s rejection of independent claim 1. For similar reasons, we do not sustain the Examiner’s rejection of claims 2–11, which depend therefrom.

NEW GROUND OF REJECTION

We enter a new ground of rejection pursuant to our authority under 37 C.F.R. § 41.50(b). We reject independent claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Gauselmann.

Gauselmann is generally directed to an illumination technique for slot machines. Gauselmann ¶ 1. In particular, “[a] slant top slot machine is described where a raised translucent or transparent housing for light emitting diodes (LEDs) surrounds the main display area of the machine.”

Gauselmann ¶ 4. Additionally, Gauselmann discloses “[t]he illumination also illuminates the area surrounding the machine such as the seat and floor.” Gauselmann ¶ 6.

In a disclosed embodiment, Gauselmann’s slant top slot machine has two displays, each of which is surrounded by a raised housing for LEDs. Gauselmann ¶ 22, Fig. 2 (items 12, 14, 40, and 41). Figure 3 of Gauselmann is illustrative of a raised housing and is reproduced below:

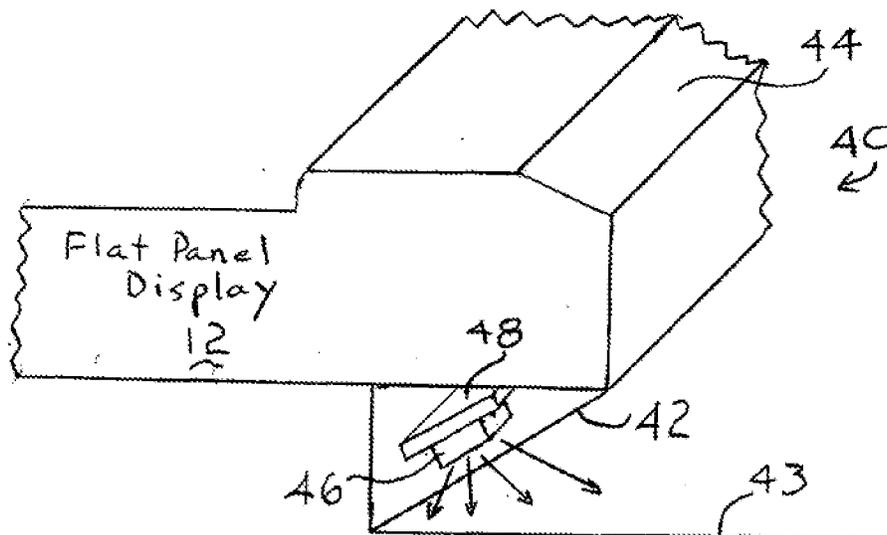


Fig. 3

Figure 3 is a cutaway view of one of the raised housings showing a downward emitting LED array. Gauselmann ¶¶ 12, 23. As illustrated, Figure 3 shows an array of LEDs (46) mounted on a circuit board (48), which is mounted behind a translucent plastic edge (42) of raised housing (40). Gauselmann ¶¶ 23, 24. In addition, Figure 3 shows a plurality of arrows directed away from the LED array (46) depicting the downward emission of light. *See* Gauselmann ¶ 26. Gauselmann additionally teaches the downward light from the LED array (46) illuminates not only the front surface of the slot machine 10, but also the area surrounding the machine, including the seat and *the floor*. Gauselmann ¶¶ 6, 26. Gauselmann further teaches that the LEDs are controlled by a game controller board in the slanted top slot machine. Gauselmann ¶¶ 33, 36, Fig. 5, item 64.

Accordingly, we find Gauselmann discloses an entertainment unit (a slot machine) comprising a backlighting system (LED array (46) mounted within raised housing (40)) facing a flooring system (Gauselmann ¶¶ 6, 26), and controlled by an entertainment system (game controller board (64)), as recited in independent claim 1. As described in Gauselmann, the backlighting system (i.e., LED array) comprises LED lights to illuminate “the area surrounding the machine such as the seat and floor.”

Gauselmann ¶ 6.

We conclude the claim element “to light the flooring behind a pedestal in a bowling centre” recites an intended use of the backlighting system that does not further limit the *structure* of the claimed apparatus. Our reviewing court guides that the patentability of an apparatus claim “depends on the claimed structure, not on the use or purpose of that structure.” *Catalina Mktg. Int’l Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 809 (Fed. Cir. 2002). “An intended use or purpose usually will not limit the

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scope of the claim because such statements usually do no more than define a context in which the invention operates.” *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003); *see also Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1468 (Fed. Cir. 1990) (finding “apparatus claims cover what a device *is*, not what a device *does*.”). Accordingly, the intended use of “light[ing] the flooring behind a pedestal in a bowling centre” is not entitled to patentable weight. *See In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997) (explaining that an intended use of a structure does not have patentable weight if the structure is already known). Additionally, we note there is no structural relationship between the recited “pedestal” and any other element recited in the claim. Thus, the “pedestal” is also non-limiting.

Further, to the extent Appellants contend the claimed entertainment unit further comprises a pedestal⁵ and that the claim element “to light the flooring behind a pedestal” imparts some structure on the backlighting system, we find it would be within the ken of an ordinarily skilled artisan to orient (or add) the LED arrays of Gauselmann to illuminate the desired areas around the entertainment unit. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007). “If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *KSR*, 550 U.S. at 417.

The Patent Trial and Appeal Board is a review body, rather than a place of initial examination. We have made a new rejection regarding

⁵ We note that, in the Specification, Appellants’ do not describe an entertainment unit as comprising a pedestal. The word “pedestal” does not appear in the Specification.

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independent claim 1 under 35 U.S.C. § 103(a), pursuant to 37 C.F.R. § 41.50(b). However, we have not reviewed the remaining claims to the extent necessary to determine whether these claims are unpatentable over Gauselmann or other prior art, either alone or in combination. We leave it to the Examiner to ascertain the appropriateness of any further rejections based on these or other references. Our decision not to enter a new ground of rejection for all claims should not be considered as an indication regarding the appropriateness of further rejection or allowance of the non-rejected claims. *See* MPEP § 1213.02 (9th ed. Rev. 08.2017, Jan. 2018).

DECISION

We reverse the Examiner's decision rejecting claims 1–11.

We newly reject claim 1 under 35 U.S.C. § 103 as unpatentable over Gauselmann.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides:

When the Board enters such a non-final decision, 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 prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the

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claims, Appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

REVERSED;
37 C.F.R. § 41.50(b)