



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/473,600	03/29/2017	TODD JOSEPH CURRAN	CURRAN 2	1443
99344	7590	10/02/2019	EXAMINER	
Patent Law of Virginia, PLLC PO Box 9319 Richmond, VA 23227			DENNIS, MICHAEL DAVID	
			ART UNIT	PAPER NUMBER
			3711	
			NOTIFICATION DATE	DELIVERY MODE
			10/02/2019	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

brian@patentlawva.com
brianjteague@gmail.com
eofficeaction@apcoll.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TODD JOSEPH CURRAN

Appeal 2019-001576
Application 15/473,600
Technology Center 3700

Before JOHN C. KERINS, MICHAEL J. FITZPATRICK, and
ANNETTE R. REIMERS, *Administrative Patent Judges*.

REIMERS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner’s decision to reject claims 1–5 under 35 U.S.C. § 102(a)(1) as anticipated by Raymond (US 2011/0042901 A1, published Feb. 24, 2011) and to reject claim 6 under 35 U.S.C. § 103 as unpatentable over Raymond. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Todd Joseph Curran. Appeal Br. (“Br.”) 2, filed July 25, 2018.

CLAIMED SUBJECT MATTER

The claimed subject matter “relates generally to games, and more specifically to disc golf games.” Spec. ¶ 2, Figs. 2, 3.

Claim 1, the sole independent claim on appeal is representative of the claimed subject matter and recites:

1. A disc golf game system comprising:
two or more elongated poles adapted to be positionable upright on a surface, each pole comprising two or more selectively connectable pole segments, at least one pole segment of each pole having circumferential indicia along at least a portion of a length of the at least one pole segment of each pole, the indicia forming a target area.

ANALYSIS

Anticipation by Raymond

Claims 1–5

Appellant does not offer arguments in favor of dependent claims 2–5 separate from those presented for claim 1. *See* Br. 5–7. We select claim 1 as the representative claim, and claims 2–5 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(iv).

Appellant contends that “Raymond does not disclose a pole having circumferential indicia forming a target area,” as recited in claim 1. Br. 5. In particular, Appellant contends that “[t]here is no indication in Raymond of having circumferential target area indicia on the pole assembly itself” and that “[t]he indicia shown in Raymond Figures 9 and 10 are ‘scoring indicia’ (i.e., indicia for recording the score), not target indicia, and do not appear to be circumferential.” *Id.* (citing Raymond ¶ 53); *see also id.* at 6 (“As seen in Fig. 3 of Raymond, Raymond’s scoring indicator is a series of small

numbers in a single vertical column, apparently on only one side of the pole.”).

Appellant also contends that Raymond’s scoring indicator is not capable of functioning/performing as a target area because (1) “[t]he small numbers of Raymond’s scoring indicator are unlikely to be viewable from a throwing distance, for targeting purposes (i.e., giving the thrower something to aim at) or for scoring-keeping purposes (i.e., detecting a hit on the target at a distance)”;

and (2) “the single column of numbers of Raymond’s scoring indicator would not be visible from all possible throwing directions.” Br. 6.

As an initial matter, the Examiner never makes a finding that the “numbers” (i.e., scoring indicia 310) of Raymond’s scoring mechanism 300 constitute a “target area” and/or are capable of functioning/performing as a target area. See Final Act. 2–4, 6–8; see also Ans. 2–7, 10–12.² Further, Appellant does not identify record evidence supporting either of the above-cited contentions. See *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974) (“Attorney’s argument in a brief cannot take the place of evidence.”). In addition, Figures 3A and 3B of Raymond illustrate top cap 18 of pole assembly 10. See Raymond ¶¶ 25, 26, 39–41, Figs. 3A, 3B. There is no discussion in Raymond of Figures 3A and/or 3B representing a “scoring indicator.” See Raymond, generally. Nor does the Examiner rely on Figures 3A and/or 3B in the rejection. See Final Act. 2–4, 6–8; see also Ans. 2–7, 10–12.

A patent applicant is free to recite features of an apparatus structurally or functionally. See *In re Swinehart*, 439 F.2d 210, 212 (CCPA 1971).

² Final Office Action (“Final Act.”), dated Feb. 28, 2018; Examiner’s Answer (“Ans.”), dated Oct. 11, 2018.

Where the Patent Office has reason to believe that a functional limitation is an inherent characteristic of the prior art, it can require an applicant to show that the prior art does not possess the claimed functional features. *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997) (quoting *Swinehart*, 439 F.2d at 213); *see also In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990) (“when the PTO shows sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not” (citations omitted)); *see also In re King*, 801 F.2d 1324, 1327 (Fed. Cir. 1986) (finding it insufficient for an Appellant to merely assert that the prior art does not inherently possess the characteristic relied on and challenge the PTO to prove the contrary by experiment or otherwise, noting that “[t]he PTO is not equipped to perform such tasks.”); Final Act. 3, 7–8.

Here, Raymond discloses that scoring indicator 320 “can be displayed along the surface of at least one pole segment” and that score indicator 320 may be a “ring” “which can slide up and down along the surface of the pole assembly to designate a specific marking.” Raymond ¶¶ 15, 53; *see also id.* (“The scoring indicator can be a ring, a c-shaped clip or a bracket which is disposed in contact with at least a portion of the circumference of the pole segment.”), Fig. 9. As Raymond discloses that scoring indicator 320 can be a “ring” that “designate[s] a specific marking” (i.e., the ring can serve as a circumferential indicia) along at least a portion of a length of at least one pole segment 26, 28, 30 of each pole 14, we agree with the Examiner that “the structure and corresponding indicia” of Raymond is inherently capable of “performing as a target area.” *See* Final Act. 2–3. 8. Appellant does not provide persuasive evidence or argument apprising us of Examiner error.

The Examiner appears to take an alternate position in the Answer. In particular, the Examiner finds that “[t]he claimed indicia/target is merely providing color to a pole” and that “Raymond inherently has a color as well so that structurally both the prior art and claimed invention have the same structural components.” Ans. 3, 10. The Examiner also finds that “the structure of the pole 14 and corresponding indicia (‘colors to designate opposing teams’ - paragraph [0043]), are capable of serving as a target area as a player can easily toss the projectile at any of the pole segments” and that “[n]otably, Raymond expressly teaches instances wherein ‘the pole is struck by the projectile’ (paragraph [0044]).” Ans. 3, 10–11. Appellant does not address, and does not show error in, this alternative basis regarding the claimed indicia/target of claim 1.³

Appellant contends that “the claimed target indicia should be given patentable weight.” Br. 7. According to Appellant, “[t]he poles cannot function as a target without the claimed target indicia. The entire pole cannot be a target, as that would not conform to the dimensions of a disc pole hole. . . . There must be a specifically-located circumferential target indicia for the claimed poles to function as designed.” *Id.* at 6–7 (citing Spec. ¶ 20).

As an initial matter, we note Appellant’s Specification describes that “[i]n another alternative embodiment, the target indicia may span more than one pole segment, as long as the target indicia has the desired total height

³ As Appellant has not filed a Reply Brief, Appellant has waived any arguments against the Examiner’s findings. *See Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (“Informative”) (“[A]rguments that could be made in the reply brief, but are not, are waived.”).

and desired height above the ground,” which supports the Examiner’s position that “the indicia [of the subject invention] is not arranged such that it is positioned in a unique position with respect to the substrate.” Spec. ¶ 22; *see also* Ans. 7. Further, as correctly pointed out by the Examiner, “[T]he claims explicitly allow for either of the pole segments to comprise the indicia.” Ans. 7; *see also* Br. 9 (Claims App.).

In this case, we agree with the Examiner, “the printed matter of indicia target area is not functionally related to the substrate (pole segments).” Final Act. 3, 7. In other words, the pole segments would still be able to be used in a game without the printed matter and the target area would still be able to achieve its indicative purpose without the pole segments. As a result, the indicia target area does not distinguish the claimed invention from Raymond. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (“Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability.”).

Here, all that the printed matter does is provide information for use with a known device. *See* Ans. 7 (“The indicia conveys a message to a human, independent of the supporting product.”); *see also In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004) (distinguishing the patentable printed band of *Gulack* and holding that a printed set of instructions cannot be relied on to patentably distinguish a known kit from the prior art or else “anyone could continue patenting a product indefinitely provided that they add a new instruction sheet to the product.”). For these reasons, we agree with the Examiner, “there is no new and unobvious functional relationship between the printed indicia and the substrate” and with the Examiner’s position not to

give patentable weight to the printed indicia of the “circumferential indicia.”
Ans. 7, 11; *see also* Final Act. 3–4.

In summary, and based on the record presented, we are not persuaded the Examiner erred in rejecting independent claim 1 as anticipated by Raymond. Accordingly, we sustain the Examiner’s rejection of claim 1. We further sustain the rejection of claims 2–5, which fall with claim 1.

Obviousness over Raymond

Claim 6

Appellant does not present arguments for claim 6 separate from those presented for claim 1. Br. 5–7. As we find no deficiencies in the Examiner’s rejection of claim 1 as anticipated by Raymond for the reasons discussed above, we likewise sustain the Examiner’s rejection of claim 6 as unpatentable over Raymond.

DECISION

We AFFIRM the decision of the Examiner to reject claims 2–5 as anticipated by Raymond.

We AFFIRM the decision of the Examiner to reject claim 6 as unpatentable over Raymond.

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

AFFIRMED