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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHELLE D. VALENCIA

Appeal 2019-006880
Application 15/438,640
Technology Center 3700

Before MICHAEL C. ASTORINO, KENNETH G. SCHOPFER, and
AMEE A. SHAH, *Administrative Patent Judges*.

ASTORINO, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), the Appellant¹ appeals from the Examiner's decision to reject claims 7 and 11. 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. The Appellant identifies the real party in interest as the inventor, Michelle D. Valencia. Appeal Br. 3.

STATEMENT OF THE CASE

Subject Matter on Appeal

The Appellant's "invention relates to toys and games, and particularly to a stomp and catch game including a stomp and catch board mounted on a stabilizing base." Spec. ¶ 1. The Specification explains that "[a] typical stomp and catch board is a lever having one end configured for stomping with the foot and the other end configured to launch a projectile, such as a beanbag. A central fulcrum rests between the lower surface of the board and a support surface, such as the ground, a floor, etc." *Id.* ¶ 2.

Claims 7 and 11 are the independent claims on appeal. Claim 7, reproduced below, is illustrative of the claimed subject matter.

7. A stomp and catch game, consisting of:

a planar base, the planar base consisting of an elongated front portion having a first length and an opposed rear portion having a second length shorter than the first length, opposed planar upper and lower surfaces, the opposed rear portion including a front area and a rear end, the elongated front portion having a front end and a rear area that merges into the front area of the rear portion, the elongated front portion has a first width and the rear portion has a second width larger than the first width to provide an area large enough to allow a user to stand, the rear portion of the upper surface having a pair of visual indicators disposed thereon to indicate where a user should stand with either foot to hold the lower surface of the base against a support surface;

a pivoting board having opposed upper and lower surfaces and opposed first and second ends, wherein the first end is located in a first length portion of the pivoting board and the second end is located in a second length portion of the pivoting board, the first end being configured for stomping on with the user's foot, the second end being configured for releasably supporting and launching a target object in the air for the user to attempt to catch, wherein each of the first and

second ends have distinct indicia for indicating where a user stomps and where a user places the target object, respectively, further wherein the second length of the pivoting board is greater than the first length of the pivoting board;

a fulcrum connector pivotally attaching the pivoting board to the upper surface of the base, wherein the fulcrum connector comprises:

a pair of hubs mounted on the upper surface of the base at the front portion thereof, wherein the pair of hubs are configured to support the lower surface of the pivoting board thereon; and

an axle having a pair of opposed ends rotatably mounted in the hubs, the pivoting board being fixed to the axle for rotation therewith;

a first pad mounted on the upper surface of the base adjacent the front area of the rear portion and spaced from the pair of visual indicators, the first pad being located beneath the first end of the pivoting board, such that the first end of the pivoting board selectively contacts and rests on the first pad;

a second pad mounted on the upper surface of the base adjacent the front end of the elongated front portion and beneath the second end of the pivoting board, such that the second end of the pivoting board selectively contacts and rests on the second pad.

Rejections

Claims 7 and 11 are rejected under 35 U.S.C. § 112(b) as indefinite.

Claims 7 and 11 are rejected under 35 U.S.C. § 103 as unpatentable over Welbourn (US 3,669,451, iss. June 13, 1972), Give a Flip coordination game, (Mar. 31, 2014), <https://funandfunction.com/give-a-flip.html> (hereinafter “Flip”), Jones (US 5,280,922, iss. Jan. 25, 1994), Carr (US 4,813,665, iss. Mar. 21, 1989), and Nicot et al. (US 2,146,156, iss. Feb. 7, 1939) (hereinafter “Nicot”).

ANALYSIS

Indefinite

The Examiner rejects claims 7 and 11 as indefinite. Final Act. 2–3. The Appellant does not present an argument for this rejection. *See* Appeal Br. 10; Reply Br. 4; Ans. 3. Therefore, we summarily sustain the Examiner’s rejection of claims 7 and 11 under 35 U.S.C. § 112(b) as indefinite.

Obviousness

The Appellant argues that the Examiner’s reliance on the teachings of Jones to further modify Welbourn’s catapult game in view of Flip’s teachings is based on impermissible hindsight reasoning. *See* Reply Br. 7–8. The Appellant’s argument is persuasive.

The Examiner finds that Welbourn’s catapult game includes base member 10 and lever member 20, and that these elements correspond with the claimed “planar base” and “pivoting board,” respectively. Final Act. 3–4. The Examiner also finds that Welbourn’s planar base has an elongated front portion with a first width and an opposed rear portion with a second width, but the rear portion lacks a “second width [that] is larger than the [elongated front portion’s] first width to provide an area large enough to allow a user to stand.” *Id.* at 4.

To remedy this deficiency, the Examiner relies on Flip’s game to teach “that it is advantageous to use the pivoting board . . . on a supporting surface . . . on which a user stands, so that the target object can be launched from the pivoting board . . . by stomping with the user’s foot to improve

hand-foot coordination.” *Id.* at 4–5. The Examiner also relies on Jones’ self-stabilizing apparatus for training a user to kick a soccer ball to teach:

when using a foot-operated game apparatus on a supporting surface, Jones teaches that it is advantageous to stabilize the apparatus on the supporting surface by providing a planar base . . . with a rear portion providing an area large enough to allow a user to stand . . . , so that the apparatus can be stabilized by the weight of the user.

Id. at 5 (citing Jones col. 1, ll. 62–64, Figs. 1, 2). Then, the Examiner determines:

it would have been obvious to one of ordinary skill in the art . . . to modify the invention of Welbourn by enlarging the rear portion of the planar base to provide an area large enough to allow a user to stand, as taught by Jones, such that the second width is wider than the first width, *in order to stabilize the game on a supporting surface* . . . so that the pivoting board can be stomped on with the user’s foot, as taught by . . . Flip, to improve hand-foot coordination.

Id. (emphasis added) (citing Jones col. 1, ll. 62–64; Flip 1).

However, Welbourn’s catapult game “is adapted to stably rest upon a suitable horizontal underlying planar surface” by use of base member plate portion 11. Welbourn, col. 1, ll. 57–66; *see also* Ans. 5. The stability is specific for a catapult game. *See* Welbourn, col. 1, ll. 7–11, col. 2, ll. 33–35; Figs. 1–2. And, whether Welbourn’s catapult game is hit with impact implement 100 (e.g., a mallet) or stomped on by a user’s foot — like that of Flip’s game — the game is used in a similar manner. So, it is unclear why Welbourn’s device, which is adapted to stably rest upon a suitable horizontal underlying planar surface, needs to be stable, as it is already stable.

The Examiner explains that “one of ordinary skill in the art would have been motivated to combine the teaching of Welbourn and Jones in view

of the teaching of . . . Flip, to yield the predictable result of stabilizing the base for launching the projectile by means of the user's foot." Ans. 7. Also, "Flip has been cited as evidence that it is known in the art to use a catapult amusement device of the kind taught by Welbourn on the floor to be struck by a user's foot." *Id.* at 5. Therefore, it appears that the basis for the Examiner's modification is that once Welbourn's catapult game is placed on the floor and rearward-portion 20R of lever member 20 is stomped on by a user, stability is an issue. However, the Examiner does not use evidence or technical reasoning to explain why Welbourn's catapult game, which is adapted to be stable when struck by an impact implement while the game is situated on a suitable horizontal underlying planar substrate "S," is not adapted to be stable when used in a similar manner, i.e., while stomped on by a user's foot and the game is situated on the floor. Put simply, the Examiner fails to adequately explain on the record why Welbourn's catapult game is lacking in stability when used by a specific implement (i.e., foot) and location (i.e., floor) such that the self-stabilizing structure as taught by Jones provides a remedy. *See* Reply Br. 7–8. Further, it is notable that Welbourn's catapult game and Jones' self-stabilizing apparatus for training a user to kick a soccer ball are different in structure and function.

The Examiner also relies on a design choice rationale and teachings from Carr and Nicot to cure other deficiencies of Welbourn with respect to the claimed subject matter. *See* Final Act. 5–7. The additional findings and rationales directed to these other deficiencies do not cure the inadequately supported reasoning for modifying Welbourn's catapult game as discussed above.

Thus, we do not sustain the Examiner's rejection of claims 7 and 11 under 35 U.S.C. § 103 as unpatentable over Welbourn, Flip, Jones, Carr, and Nicot.

CONCLUSION

In summary:

| Claims Rejected | 35 U.S.C. § | References/Basis | Affirmed | Reversed |
|------------------------|--------------------|------------------------------------|-----------------|-----------------|
| 7, 11 | 112(b) | Indefinite | 7, 11 | |
| 7, 11 | 103(a) | Welbourn, Flip, Jones, Carr, Nicot | | 7, 11 |
| Overall Outcome | | | 7, 11 | |

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