

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK THOMAS IVERSON

Appeal No. 2002-1024
Application 09/156,060

ON BRIEF

Before FRANKFORT, MCQUADE, and BAHR, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Mark Thomas Iverson appeals from the final rejection of claims 1 through 13, all of the claims pending in the application.¹

THE INVENTION

The invention relates to a "table for bowlers and friends that allows them to sit at and which provides for ample space for the consumption of food and beverages while facilitating ease of

¹ Claims 6 and 10 have been amended subsequent to final rejection.

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access to the lanes" (specification, page 1). Representative claim 1 reads as follows:

1. In a bowling center having a bowling lane section, an approach section and a sitting/scoring section, said bowling lane section including pairs of lanes having front ends that divide the approach section from the bowling lane section, a ball return track disposed between the lanes of a pair of lanes and running the entire length of the lanes to a ball return rack in the approach section between a pair of lanes, said approach section including an open area on each side of the ball return rack allowing a bowler to run up to a lane and release a bowling ball down the lane, said sitting/scoring section being adjacent to and on the side of the approach section opposite from the bowling lane section, and a sitting/scoring table located in the sitting/scoring section, the improvement being in the sitting/scoring table,

said table being substantially triangular in shape and including a tabletop defined by a base edge and two substantially equal length side edges, means for supporting said tabletop at an elevation for accommodating a plurality of patrons, said base edge extending substantially parallel to said ends of said lanes, said side edges extending from the base edge and to a point disposed behind the ball return rack, wherein said table is sized to allow for at least six patrons to sit at said table and eat food and drink beverages from said tabletop, and said side edges being disposed to define open areas on each said side of said table and between said table and said ball return rack to allow for said patrons to walk toward said ball return rack and said approach section.

THE EVIDENCE

The item relied on by the examiner as evidence of obviousness is:

Stirling et al., (Stirling)
International Application

W096/21915

July 18, 1996

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The item relied on by the appellant as evidence of non-obviousness is:

The 37 CFR § 1.132 Declaration of Mark Thomas Iverson filed November 27, 2000 (Paper No. 13)

THE REJECTION

Claims 1 through 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Stirling.

Attention is directed to the appellant's main and reply briefs (Paper Nos. 21 and 23) and to the examiner's final rejection and answer (Paper Nos. 14 and 22) for the respective positions of the appellant and the examiner regarding the merits of this rejection.^{2,3}

² In the final rejection, claims 6 through 13 also stood rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The examiner has since withdrawn this rejection in view of the amendment of claims 6 and 10 subsequent to final rejection (see the advisory action dated February 22, 2001, Paper No. 19).

³ Although the Brunswick Bowling Catalog reference which is of record is cited on page 8 of the answer to support the appealed rejection, it is not included in the statement of the rejection. Where a reference is relied on to support a rejection, whether or not in a minor capacity, there is no excuse for not positively including the reference in the statement of the rejection. See In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970) and MPEP § 706.02(j). Hence, we have not considered the Brunswick reference in reviewing the merits of the examiner's rejection.

DISCUSSION

Stirling pertains to a scoring console for use in an automatic bowling scoring system. Figure 1 depicts one example of how such consoles might be incorporated into a bowling center. As shown, the bowling center includes a plurality of lanes 12, ball return racks serving respective pairs of lanes, scoring consoles 14 aligned with respective lanes behind their approach areas, and tables 16 positioned adjacent and to the rear of the consoles. Each table includes a rounded rectangular table top and a support leg, and accommodates a plurality of chairs.

Conceding that Stirling's tables lack the size, shape and bowling center orientation (i.e., location) required by independent claims 1, 6 and 10, the examiner nonetheless concludes that such would have been obvious matters of design choice as the appellant has not shown them to be critical in terms of solving a particular problem or producing unexpected results (see pages 2 through 4 in the final rejection). This conclusion is unsound for at least two reasons. First, a claim is not required to include critical limitations. See W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1556, 220 USPQ 303, 315 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Second, the appellant's specification does in fact establish that the table

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size, shape and location set forth in independent claims 1, 6 and 10 are critical in the sense that they are intended to provide "ample space for several patrons to eat food and drink beverages on the table and allow easy access for moving into the approach areas and about the ball return rack when taking bowling turns" (specification, page 3).

Rejections based on 35 U.S.C. § 103(a) must rest on a factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id. In the present case, the examiner has resorted to speculation, unfounded assumptions and hindsight reconstruction to overcome the admitted evidentiary deficiencies of Stirling relative to the subject matter claimed. By way of example, the case law cited in the final rejection for the proposition that differences in size, shape and orientation cannot impart patentability to a claimed invention has little, if any, relevance to the fact situation and particular issues of obviousness here at hand. Moreover, this approach, resting as it apparently does on so-called mechanical

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or per se rules of obviousness, is legally erroneous. See In re Ochiai, 71 F.3d 1565, 1570, 37 USPQ2d 1127, 1132 (Fed. Cir. 1995); In re Wright, 343 F.2d 761, 769-70, 145 USPQ 182, 190 (CCPA 1965). The case law cited in the examiner's answer relating to the skill, knowledge and common sense of the artisan is similarly unavailing. The examiner's unsupported comments on such factors are no substitute for the requisite evidence missing in this case. See In re Lee, 277 F.3d 1338, 1345, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002).

Thus, the examiner's application of Stirling fails to establish a prima facie case of obviousness with respect to the subject matter recited in independent claims 1, 6 and 10.⁴ Consequently, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 1, 6 and 10, and dependent claims 2 through 5, 7 through 9 and 11 through 13, as being unpatentable over Stirling.

⁴ This being so, it is not necessary to delve into the merits of the appellant's declaration evidence of non-obviousness.

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SUMMARY

The decision of the examiner to reject claims 1 through 13
is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
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)	APPEALS AND
JOHN P. MCQUADE)	
Administrative Patent Judge)	INTERFERENCES
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JENNIFER D. BAHR)	
Administrative Patent Judge)	

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