

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL J. HICKS

Appeal No. 2002-1900
Application 09/728,901

ON BRIEF

Before ABRAMS, MCQUADE, and NASE, Administrative Patent Judges.
MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Michael J. Hicks appeals from the final rejection of claims 1 through 7, all of the claims pending in the application.

THE INVENTION

The invention relates to a hand-held amusement device which is defined in representative claim 1 as follows:

1. A hand-held amusement device comprising;
an aerial projectile and
a U-shaped conduit having a uniform circular cross-section throughout its length and having opposite open ends so that one open end can discharge the aerial projectile therefrom while the other open end can receive the aerial projectile therein whereby proper manipulation of the curved conduit by a player in a clockwise/counterclockwise movement will keep the aerial projectile in a continuous play mode.

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THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Burrows	3,069,805	Dec. 25, 1962
Griffin	3,445,551	May 20, 1969
Cummings	4,863,174	Sep. 5, 1989

THE REJECTIONS

Claims 1, 2 and 4 through 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cummings in view of Burrows.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Cummings in view of Burrows and Griffin.

Attention is directed to the brief (Paper No. 8) and the answer (Paper No. 9) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

DISCUSSION

Cummings, the examiner's primary reference, discloses a hand-held ball catching and throwing device generally similar to that claimed by the appellant. One of Cummings' objectives is "to provide a catching surface having a shape adapted to receive a ball in ballistic flight and which will smoothly and progressively change the direction of the ball" (column 2, lines 2 through 5). To this end,

a straight, rigid elongated open-ended tubular member [10] formed of transparent material provides an enclosed smooth passage for receiving and discharging an aerial projectile, such as a ball [16], at or from either end thereof, and has an outwardly extending scoop-shaped throwing and catching member [12, 14] attached to each end for providing a curved surface over which the projectile may be directed at or from the open end of the tubular member by baton-like manipulation [column 2, lines 25 through 34].

Each throwing and catching member 12 or 14 presents an upwardly concave scoop-shaped surface having a generally circular outer rim of a radius approximately twice that of the tube 10 (see column 3, lines 18 through 26; and column 4, lines 1 through 8).

As conceded by the examiner (see page 2 in the answer), the Cummings device does not respond to the limitation in appealed claim 1 requiring "a U-shaped conduit having a uniform circular cross-section throughout its length and having opposite open ends so that one open end can discharge the aerial projectile therefrom while the other open end can receive the aerial projectile therein." The examiner's reliance on Burrows to overcome this deficiency is not well taken.

Burrows discloses an amusement device comprising a plurality of support blocks 10, a plurality of straight and curved conduits 24 and 26, and a plurality of couplings 28 for selectively

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joining the conduits to one another and to the blocks (see, for example, Figure 4) such that the conduits form a continuous passageway for a ball/marble M. Figure 5, which is focused on by the examiner (see page 2 in the answer), shows U-shaped passageway section composed of a pair of curved conduits 26 joined by a coupling 28.

In proposing to combine Cummings and Burrows to reject the appealed claims, the examiner concludes that it would have been obvious to one of ordinary skill in the art "to have employed the ends of Burrows [presumably as shown in Figure 5] with the apparatus of Cummings in order to increase the skill level of the player as the game is played" (answer, page 3).

Even if Burrows is assumed to analogous art (the appellant argues that it is not), however, there is nothing in its depiction of coupled conduit sections (Figure 5) intended to form part of a larger conduit system (Figure 4) which would have suggested modifying the Cummings device in the manner proposed for any discernable reason, let alone the unfounded skill level rationale advanced by the examiner. Indeed, Cummings' stated intention to provide a catching surface having a shape adapted to receive a ball and smoothly and progressively change its direction seemingly would have taught away from this

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modification. Thus, although the appellant's invention is a relatively simple and straightforward device, the examiner's reference evidence does not justify a conclusion that the differences between the subject matter set forth in claim 1 and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 1, and dependent claims 2 and 4 through 7, as being unpatentable over Cummings in view of Burrows.

Since Griffin's disclosure of a phosphorescent, glow in the dark ball does not cure the shortcomings of the Cummings-Burrows combination relative to parent claim 1, we also shall not sustain the standing 35 U.S.C. § 103(a) rejection of dependent claim 3 as being unpatentable over Cummings in view of Burrows and Griffin.

SUMMARY

The decision of the examiner to reject claims 1 through 7 is reversed.

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REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	APPEALS AND
JOHN P. MCQUADE)	
Administrative Patent Judge)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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