

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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LESKER L. BERTRAND

Appeal No. 2004-1218
Application No. 09/956,195

ON BRIEF

Before PAK, WALTZ, and DELMENDO, Administrative Patent Judges.
WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's final rejection of claims 1 through 9 and 11, which are the only claims remaining in this application. We have jurisdiction under 35 U.S.C. § 134.

According to appellant, the invention is directed to a tray for holding game pieces which have indicia on one side, where the tray includes an elongate generally rectangular base having a reflective surface, mounted in association with an elongate transparent easel portion overlying the reflective base at such

Appeal No. 2004-1218
Application No. 09/956,195

an angle that the indicia on the game pieces can be viewed in reflection, without requiring a player to lift or manipulate the game piece (Brief, pages 2-3). Appellant states that the claims stand together as a single group (Brief, page 3). Therefore, pursuant to the provisions of 37 CFR § 1.192(c)(7)(2000), we select claim 1 from this grouping of claims and decide the ground of rejection in this appeal on the basis of this claim alone.

Representative independent claim 1 is reproduced below:

1. A tray for holding game pieces having indicia on only side thereof, said tray comprising:

an elongate generally rectangular base portion having a reflective surface;

an elongate transparent easel portion; and

assembly means for temporarily mounting said elongate transparent easel portion at an acute angle along and overlying one edge of said elongate generally rectangular base portion such that indicia on a lower surface of each game piece mounted on said elongate transparent easel portion is visible in reflection within said elongate generally rectangular base portion when said elongate transparent easel portion is so mounted and wherein said tray may be collapsed and packaged in a flat container when disassembled.

The examiner has relied upon the following references as evidence of obviousness:

Chapman	898,833	Sep. 15, 1908
Morse	4,146,229	Mar. 27, 1979
Conville	6,244,598	Jun. 12, 2001

Appeal No. 2004-1218
Application No. 09/956,195

The claims on appeal stand rejected under 35 U.S.C. § 103(a) as unpatentable over Morse, for the reasons set forth in the final Office action dated Nov. 1, 2002 (Paper No. 6), with evidentiary support from Chapman and Conville (Answer, page 3). We *affirm* this rejection essentially for the reasons stated in the final Office action, the Answer, and those reasons set forth below.

OPINION

The examiner finds that Morse discloses a card viewer having a rectangular reflective surface 3 with a transparent plastic top wall 16, corresponding to the claimed easel portion, mounted at an acute angle (30°) with respect to the reflective surface (Answer, page 3, citing the final Office action (Paper No. 6), which itself refers to the first Office action of Paper No. 4). The examiner recognizes that Morse does not explicitly disclose that his card holder is collapsible or may be disassembled (Paper No. 6, page 2).¹ However, the examiner concludes that it would have been obvious to one of ordinary skill in this art to disassemble the

¹The examiner has not presented any analysis of the "assembly means" as a "means plus function" under 35 U.S.C. § 112, ¶6 (see Paper Nos. 4 and 6 as well as the Answer). See *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 1318, 50 USPQ2d 1161, 1166 (Fed. Cir. 1999). However, appellant has not presented any argument that Morse fails to disclose or suggest this claimed limitation (see the Brief and Reply Brief in their entirety).

Appeal No. 2004-1218
Application No. 09/956,195

card viewer of Morse or make it collapsible "since it has generally been recognized that to make components separable involves only routine skill in the art" and "it is well-known that items or elements stored in a flat container are more easily transported" (Answer, page 4; Paper No. 6, page 2). The examiner cites Conville and Chapman as "evidentiary support" for this conclusion, finding that Conville discloses that it was well-known in the gaming art that games can be disassembled and packaged in flat containers for shipping while Chapman discloses that even games with a mirror can be disassembled for packing into flat boxes for shipping (Answer, page 4).

Appellant's sole argument is that, despite appellant's challenge to the examiner's factual assertion, the examiner has failed to provide documentary evidence in support of this factual assertion that it only requires routine skill in the art or it is well known to make optical devices collapsible or disassembled (Brief, pages 4-5). This argument is not persuasive since the examiner has presented "documentary evidence" in the form of Chapman and Conville to support the factual assertion presented in the final Office action of Paper No. 6 (Answer, page 4). Chapman teaches that a game containing a "secured" mirror 14 may be disassembled and packed within a box (page 1, ll. 69-81). Conville

Appeal No. 2004-1218
Application No. 09/956,195

teaches that it is advantageous for a game to be "folded" (collapsible or disassembled) into a flat, very low profile shipping or storage orientation for efficient bulk shipping and storage (col. 2, ll. 55-61; col. 3, ll. 43-49). Therefore we determine that the examiner has presented sufficient evidence to support the disputed assertion.²

We additionally note that the limitation "wherein said tray *may be collapsed and packaged in a flat container when disassembled*" (emphasis added) as recited in claim 1 on appeal only requires a *capability* of the tray to be collapsed or disassembled but does not positively state that such action has occurred. See *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997); *In re Casey*, 370 F.2d 576, 579-80, 152 USPQ 235, 238 (CCPA 1967). Appellants have not provided any reasoning or evidence establishing that the card viewer of Morse was not capable of being collapsed or disassembled.

²Appellant strongly disputes the examiner's citation of Conville and Chapman for the first time in the Answer, without denominating the rejection as a new ground of rejection or reopening prosecution (Reply Brief, page 2; see the Answer, paragraph bridging pages 4-5). However, this issue is *petitionable* and not before us on appeal. See 37 CFR § 1.191(c)(2000); *Manual of Patent Examining Procedure*, §§§ 1002.02(d), 1208.01, and 2144.03, 8th ed., Aug. 2001.

Appeal No. 2004-1218
Application No. 09/956,195

For the foregoing reasons and those set forth in the Answer, we determine that the examiner has established a *prima facie* case of obviousness in view of the reference evidence. Based on the totality of the record, including due consideration of appellants' arguments, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of section 103(a). Accordingly, the rejection of claims 1-9 and 11 under 35 U.S.C. § 103(a) over Morse in view of Chapman and Conville is affirmed.

Appeal No. 2004-1218
Application No. 09/956,195

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

AFFIRMED

CHUNG K. PAK)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
THOMAS A. WALTZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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ROMULO H. DELMENDO)	
Administrative Patent Judge)	

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Appeal No. 2004-1218
Application No. 09/956,195

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