

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WARREN WOODWARD

Appeal No. 96-1827
Application 08/112,576¹

HEARD: December 11, 1998

Before FRANKFORT, PATE and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Warren Woodward appeals from the final rejection of claims 1 through 20, all of the claims

¹ Application for patent filed August 25, 1993.

pending in the application.

The invention relates to “a set of pieces for playing a modified form of chess” (specification, page 1). Claim 1 is illustrative and reads as follows:

1. A set of pieces for a modified version of chess for two players in which ownership of the pieces may change throughout the course of the game, comprising two subsets of pieces for ownership initially by respective players, wherein each piece has an upright stem portion having a shape which indicates the denomination of the piece and direction indicating means for indicating the orientation of the piece relative to a player and hence the ownership of the piece throughout the course of the game.

The references relied upon by the examiner as evidence of anticipation and obviousness are:

Wade	Des. 169,230	Mar. 31, 1953
Samuels	3,947,040	Mar. 30, 1976

“Shogi,” Waddington’s Illustrated Encyclopedia of Games, pages 50-51, Pan Books, London, 1984 (Waddington)

The appealed claims stand rejected as follows:

a) claims 1 through 20 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention;

b) claims 1, 4 through 6, 9, 10 and 13 through 16 under 35 U.S.C. § 102(b) as being anticipated by Samuels;

c) claims 2, 3, 11, 12 and 17 through 19 under 35 U.S.C. § 103 as being unpatentable over Samuels in view of Waddington; and

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d) claims 7, 8 and 20 under 35 U.S.C. § 103 as being unpatentable over Samuels in view of Wade.

Reference is made to the appellant's corrected brief (Paper No. 19) and to the examiner's final rejection and answer (Paper Nos. 7 and 14) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

As a preliminary matter, it is noted that the appellant has raised as an issue in this appeal the refusal of the examiner to enter the amendment filed subsequent to final rejection on January 9, 1995 (see page 4 in the brief). It is well settled, however, that the refusal of an examiner to enter an amendment after final rejection is a matter of discretion which is reviewable by petition to the Commissioner rather than by appeal to this Board. In re Mindick, 371 F.2d 892, 894, 152 USPQ 566, 568 (CCPA 1967). Accordingly, we shall not review or further discuss this matter.

Turning now to the standing 35 U.S.C. § 112, second paragraph, rejection, the examiner considers claims 1 through 20 to be indefinite because

[in] Claim 1, the language to "ownership of the piece" without the board is confusing. The claim is incomplete and inoperative without the board. In claims 1 and 13 "relative to a player" is indefinite in that persons may not be positively recited in a claim. Claim 18, in line 2, "one kings" is confusing. Claim 20 must end with a period [final rejection, page 2].

It is not apparent, however, nor has the examiner cogently explained, why the reference to

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“ownership of the piece” in claim 1 is confusing, or why this claim, which is directed to “A set of pieces for a modified version of chess” is incomplete and inoperative without the recitation of a board. Moreover, and contrary to the examiner’s determination, the language “relative to a player” in claims 1 and 13 does not incorporate players or persons as part of the claimed subject matter. Finally, although the examiner’s criticisms of claims 18 and 20 are well taken, they involve mere typographical errors which, while certainly deserving of correction, are not serious enough to render the scope of these claims unclear.

Accordingly, we shall not sustain the standing 35 U.S.C. § 112, second paragraph, rejection of claims 1 through 20.

As for the standing 35 U.S.C. § 102(b) rejection of claims 1, 4 through 6, 9, 10 and 13 through 16 as being anticipated by Samuels, anticipation is established when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be

found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Samuels pertains to “an instructional indicia carrying member which can be removably mounted on a chess piece such that pertinent information concerning the chess piece is readily visible to the player” (column 1, lines 6 through 10). Such members may be formed from a “[c]ard 10 . . . divided into thirty-two sections, each of which corresponds to one of the thirty-two pieces in the chess set” (column 2, lines 65 through 67). As described by Samuels with regard to a first embodiment shown in Figures 3 and 4,

[a] conventional chess piece has a base thereon with two flanges 13, 15 separated by a recessed portion. An opening 16 is formed in the body of the member which is approximately equal in the size to the circumference of the chess piece at the recess. This opening 16 may be formed in the member by perforating the member as shown in FIG. 2 such that when a member is [re]moved from the card 10 the player can separate the perforated portion 16 from the remainder of the body of the member thereby forming an opening therein of appropriate size. Subsequent to the formation of the opening, the member is placed around the base of the chess piece 14 such that the opening 16 engages the recess in the base [column 3, lines 29 through 43].

In an alternative embodiment shown in Figure 5, “a pressure sensitive adhesive is used to affix the member to the underside of the base of the chess piece. The pressure sensitive adhesive may be coated on the area opening 16 of the previous embodiment” (column 4, lines 4 through 8). As conceded by the appellant, “Samuels is intended to be used with conventional black and white chess pieces where the color of the piece indicates ownership” (brief, page 9).

The appellant submits that the subject matter recited in claims 1, 4 through 6 and 10 is not anticipated by Samuels because this reference does not meet the intended use limitations in these claims or the recitation in parent claim 1 of “direction indicating means for indicating the orientation of the piece relative to a player and hence the ownership of the piece throughout the course of the game.”

Considering the latter point first, the “direction indicating means” recitation is a means plus function limitation which must be construed in accordance with the sixth paragraph of 35 U.S.C. § 112, second paragraph, as covering the corresponding structure in the specification and equivalents thereof. See In re Donaldson Co. Inc., 16 F.3d 1189, 1194, 29 USPQ2d 1845, 1849-50 (Fed. Cir. 1994).

One of the structures in the appellant’s specification which corresponds to this “means” is a base 10 having a front 14 and rear 16 which are mutually asymmetrical (see pages 3 and 4). Samuels’ instructional indicia carrying member, which as shown in Figures 2 and 4 has a front and rear which are mutually asymmetrical, embodies such a base. Moreover, due to its asymmetrical shape, the Samuels instructional indicia carrying member is clearly capable, under principles of inherency, of indicating the orientation of the piece relative to a player and hence the ownership of the piece throughout the course of the game as recited in claim 1. Thus, Samuels’ instructional indicia carrying member constitutes a direction indicating means to the extent that such is recited in claim 1 and further defined in dependent claims 4 through 6.

As for the intended use limitations in claims 1, 4 through 6 and 10, it is not apparent, nor has the

appellant explained, why the chess pieces disclosed by Samuels are not inherently capable of being so used. That Samuels does not expressly teach such use is of no moment. The recitation of a new intended use of an old product does not make a claim to that old product patentable. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). See also LaBounty Mfg. Inc. v. United States Int’l Trade Comm’n, 958 F.2d 1066, 1075, 22 USPQ2d 1025, 1032 (Fed. Cir. 1992) (“[t]he use for which the [anticipatory] apparatus was intended is irrelevant, if it could be employed without change for the purposes of the patent”); In re Swinehart, 439 F.2d 210, 213, 169 USPQ 226, 229 (CCPA 1971) (“the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art”); In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967) (“[t]he manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself”).

Thus, the appellant’s position that the subject matter recited in claims 1, 4 through 6 and 10 distinguishes over Samuels is not persuasive. Therefore, we shall sustain the standing 35 U.S.C. § 102(b) rejection of these claims.

Since the appellant has grouped claims 9 and 13 through 16 with various ones of claims 1, 4, 5 and 10 for purposes of this appeal pursuant to 37 CFR § 1.192(c)(7) (see pages 6 and 7 in the brief), we also shall sustain the standing 35 U.S.C. § 102(b) rejection of claims 9 and 13 through 16 as being

anticipated by Samuels.

Turning now to the standing 35 U.S.C. § 103 rejection of claims 2, 3, 11, 12 and 17 through 19, the Waddington reference contains a discussion of Shogi, the Japanese version of chess. According to Waddington, all of the shogi pieces in a game are the same shape and color and are distinguished only by size and indicia. Each player initially owns a set of pieces including a king, a rook, a bishop, two gold generals, two silver generals, two knights, two lances, and nine pawns. The pieces of the players are differentiated on the board by being pointed toward the opposing player. One feature of the game is that captured pieces may be returned to the board as members of the capturing side.

In proposing to combine Samuels and Waddington, the examiner states merely that “[i]n order to play shogi, it would have been obvious to provide the pieces of Waddington” (final rejection, page 3). Suffice it to say that this statement fails to give any meaningful indication of the precise manner in which the two references are intended to be combined. Our own review of Samuels and Waddington shows that they are completely lacking in suggestion or motivation to combine them in any way relevant to the issues present in this appeal.

Be this as it may, however, claim 2 is broad enough to read on Samuels alone. More particularly, the recitation in claim 2 of two subsets of pieces which do not vary from each other in

colour reads, for example, on any two subsets of Samuel's black or white pieces, respectively. Thus, the subject matter recited in claim 2 lacks novelty. Since lack of novelty is the ultimate or epitome of obviousness (see In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982)), we shall sustain the standing 35 U.S.C. § 103 rejection of claim 2, and of claims 3 and 19 which have been grouped therewith pursuant to 37 CFR § 1.192(c)(7) (see page 6 in the brief).

We shall not sustain, however, the standing 35 U.S.C. § 103 rejection of claims 11, 12, 17 and 18. For the reasons discussed above, Waddington does not cure the failure of Samuels to teach or suggest the particular game pieces required by these claims.

Finally, we shall sustain the standing 35 U.S.C. § 103 rejection of claims 7, 8 and 20 as being unpatentable over Samuels in view of Wade. The appellant does not dispute the examiner's conclusion that it would have been obvious to one of ordinary skill in the art to provide Samuels' chess pieces with facial characteristics in view of the teachings of Wade. Rather, the appellant submits the proposed combination would not meet the limitations in claims 7 and 8 because "[t]he fact that Wade's faces might be used to indicate direction does not teach using them to indicate direction. It is only with

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the hindsight provided by the instant disclosure that one might consider using the faces to indicate direction” (brief, page 21). This line of argument is not convincing because it is predicated on an intended use of the faces. Here again, it is not evident why the faces disclosed by the prior art would not be inherently capable of indicating direction. Thus, the combined teachings of Samuels and Wade would have suggested the set of pieces recited in claims 7 and 8. Claim 20 falls with claim 8 due to its grouping therewith pursuant to 37 CFR § 1.192(c)(7) (see page 7 in the brief).

In summary, the decision of the examiner to reject claims 1 through 20 is affirmed with respect to claims 1 through 10, 13 through 16, 19 and 20 and reversed with respect to claims 11, 12, 17 and 18.

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AFFIRMED-IN-PART

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