

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte D & D Gaming Patents Inc.

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Appeal No. 98-2255  
Reexamination Control No. 90/003,842<sup>1</sup>

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HEARD: December 7, 1998

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Before FRANKFORT, NASE, and CRAWFORD, Administrative Patent Judges.

NASE, Administrative Patent Judge.

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<sup>1</sup> Reexamination for U.S. Patent No. 5,288,077, issued February 22, 1994. U.S. Patent No. 5,288,077 issued from Application No. 07/800,631, filed November 27, 1991. According to the appellant, that application was a continuation-in-part of Application No. 07/361,276, filed June 5, 1989, which was a division of Application No. 07/214,934, filed July 5, 1988, which was a continuation-in-part of Application No. 07/182,374, filed April 18, 1988. Request for reexamination filed May 25, 1995.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 6 through 21. Claims 1 through 5 have been confirmed.

We AFFIRM-IN-PART, however, for reasons explained infra, we denominate the affirmance part of this decision a new ground of rejection under 37 CFR § 1.196(b). In addition, we enter other new grounds of rejection pursuant to 37 CFR § 1.196(b).

BACKGROUND

The appellant's invention relates to a method of progressive jackpot twenty-one. An understanding of the invention can be derived from a reading of exemplary claim 6, which is reproduced in the opinion section below.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Scarne, John "Chapter 2 Draw Poker and Chapter 3 Stud Poker"  
Scarne's Encyclopedia of Games, Harper & Row (1973) pp. 6-53  
(Rules of Poker)

Scarne, John "Chapter 16 Banking Card Games" Scarne's Encyclopedia of Games, Harper & Row (1973) p. 286 (Pontoon)

Scarne, John "Chapter 20 Miscellaneous Card Games" Scarne's Encyclopedia of Games, Harper & Row (1973) p. 381 (Three-In-One)

Big Field Rules and Directions<sup>2</sup> (Big Field)

Reference made of record by this panel of the Board is:  
Tripoley, "How to Play," Cadaco, Inc., 1968 (Tripoley)

Claims 6 and 14 stand rejected under 35 U.S.C. § 102(b)  
as being anticipated by Rules of Poker.

Claims 6 and 14 stand rejected under 35 U.S.C. § 102(b)  
as being anticipated by Three-In-One.

Claims 6 and 14 stand rejected under 35 U.S.C. § 102(b)  
as being anticipated by Big Field.

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<sup>2</sup> A declaration of Jim Kilby dated May 9, 1995, was utilized by the examiner as averring the date of this publication as circa September 1984.

Claims 6 through 21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Pontoon.

Claims 7 through 13 and 15 through 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Big Field in view of Pontoon.

Claims 6 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Rules of Poker.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 19, mailed March 17, 1998) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 18, filed January 28, 1998) and reply brief (Paper No. 22, filed August 24, 1998) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Before addressing the examiner's rejections based upon prior art, it is an essential prerequisite that the claimed subject matter be fully understood. Analysis of whether a claim is patentable over the prior art under 35 U.S.C. §§ 102 and 103 begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. See Smithkline Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988). Accordingly, we will initially direct our attention to appellant's claims 6 and 14 to derive an understanding of the scope and content thereof.

Claim 6 recites:

A method of including a jackpot component in a live casino table game comprising the steps of:  
(a) a player wagering at least one first gaming token to participate in the live casino table game,  
(b) a player wagering at least one second gaming token to participate in the jackpot component,  
(c) a dealer dealing a hand of playing cards to the player,  
(d) if the player's hand comprises a predetermined arrangement of cards, the player wins a predetermined fixed amount.

Claim 14 recites:

A method of including a jackpot component in a live casino table game comprising the steps of:  
(a) a player wagering at least one first gaming token to participate in the live casino table game,  
(b) a player wagering at least one second gaming token to participate in the jackpot component,  
(c) a dealer dealing a hand of playing cards to the player,  
(d) if the player's hand consists of a predetermined arrangement of cards, the player wins a predetermined fixed amount.

The appellant argues in the brief (1) that the method steps must be interpreted pursuant to 35 U.S.C. § 112, sixth paragraph, (pp. 4-6); (2) that the prior art does not meet the required order of steps (pp. 13-14); and (3) the meaning of the phrase "live casino table game" (pp. 14-19).

35 U.S.C. § 112, sixth paragraph, in effect provides that an element in a combination method or process claim may be recited as a step for performing a specified function without the recital of acts in support of the function. Being drafted with the permissive "may," the statute does not require that steps in a method claim be drafted in step-plus-function form but rather allows for that form. A step for accomplishing a particular function in a process claim may be claimed without invoking section 112, paragraph 6. Thus, it is inappropriate to construe every process claim containing steps described by an "ing" verb, such as wagering, winning, etc. into a step-plus-function limitation. See O.I. Corp. v. Tekmar Co., 115 F.3d 1576, 1583, 42 USPQ2d 1777, 1782 (Fed. Cir. 1997).

Applying the rationale set forth in O.I. Corp. to the steps recited in claims 6 and 14, we conclude that the recited steps are not step-plus-function limitations subject to the requirements of 35 U.S.C. § 112, sixth paragraph. In that regard, as in O.I. Corp. the claimed steps of wagering, dealing and winning are not individually associated in the

claims with functions performed by the steps of wagering,  
dealing or winning.

As stated in Ex parte Jackman, 44 USPQ 171, 173 (Bd. App.  
1938):

[i]t has frequently been held in connection with claims  
of this type [method claims] that there is no presumption  
of any definite sequence unless the claims are so limited  
as to require it.

Applying the above-noted principle set forth in Jackman  
to the steps recited in claims 6 and 14, we conclude that  
claims 6 and 14 require the specific sequence of steps to be  
performed in the order indicated. We reach this conclusion  
based upon the following factors: (1) a sequence of steps is  
indicated by the appellant's use of (a), (b), (c) and (d); (2)  
the recitations that a player wagers "at least one **first**  
gaming token to participate in the live casino table game" and  
wagers "at least one **second** gaming token to participate in the  
jackpot component" indicates a specific order; and (3) the  
recitation in step (d) that if the player's **hand** comprises or  
consists of "a predetermined arrangement of cards, the player

wins a predetermined fixed amount" indicates that this step is preceded by step (c) (i.e., the step of "dealing a hand of playing cards to the player").

It is axiomatic that claims in reexamination proceedings are to be given their broadest reasonable interpretation consistent with the specification. In re Yamamoto, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984). When so read, the meaning of the phrase "live casino table game" means a typical casino or cardroom table game such as poker or Twenty-One.<sup>3</sup> We note, however, that the claimed method does not require the steps to be performed in a casino.

With these understandings of the subject matter recited in claims 6 and 14, we turn to the rejections raised by the examiner.

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<sup>3</sup> While the patent under reexamination only describes the game Twenty-One, it does refer to U.S. Patent No. 4,861,041, which describes the invention as being applied to a typical casino or cardroom table game such as poker or Twenty-One. See column 1, line 12, to column 2, line 9, of U.S. Patent No. 4,861,041.

**Rejections based upon Rules of Poker**

We will not sustain the rejection of claims 6 and 14 under 35 U.S.C. § 102(b) as being anticipated by or under 35 U.S.C.

§ 103 as unpatentable over Rules of Poker.

We agree with the appellant's arguments that Rules of Poker does not anticipate or render obvious the subject matter of claim 1 (brief, pp. 7-10 and 25). In that regard, it is our determination that Rules of Poker does not teach or suggest the following elements of claims 6 and 14 for the reasons set forth by the appellant in the brief: (1) including a jackpot component in a live casino table game; (2) a player wagering at least one second gaming token to participate in the jackpot component; and (3) if the player's hand comprises or consists of a predetermined arrangement of cards, the player wins a predetermined fixed amount.

**Rejections based upon Big Field**

We will not sustain the rejection of claims 6 and 14 under 35 U.S.C. § 102(b) as being anticipated by Big Field or the rejection of claims 7 through 13 and 15 through 21 under 35 U.S.C. § 103 as unpatentable over Big Field in view of Pontoon.

We agree with the appellant's argument (brief, pp. 19-20 and reply brief, pp. 5-8) that Big Field is not prior art. In that regard, it is our determination that clearly Big Field was printed/published on or after September 1991 for the reasons outlined by the appellant. In addition, the declaration of Jim Kilby dated May 9, 1995, does not establish a date of printing/publication of Big Field prior to September 1991. While the declaration of Jim Kilby may establish that the game of "big field" existed in 1984, it fails to establish that the publication Big Field, relied upon by the examiner, existed prior to the critical date (i.e., July 5, 1988).<sup>4</sup>

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<sup>4</sup> In a reexamination proceeding, only patents and printed publications may be utilized in rejections under 35 U.S.C. § 102 or § 103. 35 U.S.C. §§ 301-303.

**Rejection based upon Pontoon**

We will not sustain the rejection of claims 6 through 21 under 35 U.S.C. § 102(b) as being anticipated by Pontoon.

We agree with the appellant's arguments that Pontoon does not anticipate the subject matter of claims 6 and 14 (brief, p. 21 and reply brief, pp. 10-13). In that regard, it is our determination that Pontoon does not teach or suggest the following element of claim 6 and 14 for the reasons set forth by the appellant in the brief and reply brief: a player wagering at least one **second** gaming token to participate in the jackpot component after wagering at least one **first** gaming token to participate in the live casino game. In Pontoon, a single wager (i.e., the initial bet, the doubling of the bet, or the redoubling of the bet) permits the player to participate in both the live casino game (i.e., Black Jack) and the jackpot component (i.e., the bonus payments).

**Rejection based upon Three-In-One**

We sustain the rejection of claims 6 and 14 under 35 U.S.C. § 102(b) as being anticipated by Three-In-One.

The teachings of Three-In-One are set forth on pages 12-13 of the brief.

We agree with the appellant's argument (brief, pp. 13-14) that the examiner's rationale in applying Three-In-One with regard to claims 6 and 14 (answer, p. 6) does not provide correspondence with the subject matter of claims 6 and 14 since the examiner's interpretation of the claim ignored the required order of steps. However, it is our determination that Three-In-One does anticipate<sup>5</sup> claims 6 and 14 since the required order of steps is present in Three-In-One for the reasons set forth below.

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<sup>5</sup> A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987).

Three-In-One discloses a card game in which a hand has three stages.<sup>6</sup> Three-In-One also discloses that the initial hand is followed by subsequent hands (having the same three stages) until the game breaks up. Three-In-One teaches that when the game breaks up and there are still chips (i.e., gaming tokens) left in any of the layouts, a round of cold hands in poker is dealt with the winner taking all the chips on the board. Thus, the Three-In-One card game encompasses multiple hands.

Claims 6 and 14 read on Three-In-One as follows:

A method of including a jackpot component (stage one of Three-In-One) in a live casino table game (stage 2 of Three-In-One since poker is a live casino game) comprising the steps of:

(a) a player wagering at least one first gaming token to participate in the live casino table game (in stage two of the first hand of Three-In-One the player must put a chip in the pot),

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<sup>6</sup> The three stages are as follows: the first stage is collecting on the sequence card(s), the second stage is a round of closed poker, and the third stage is a game of Michigan.

(b) a player wagering at least one second gaming token to participate in the jackpot component (at the start of the second hand of Three-In-One the player must ante a total of six chips on the layout, one chip next to the ace, jack and ten, two chips next to the king-queen combination, and one chip next to the sequence of seven, eight and nine),

(c) a dealer dealing a hand of playing cards to the player (the dealer deals the second hand to the player),

(d) if the player's hand comprises/consists of a predetermined arrangement of cards, the player wins a predetermined fixed amount (in stage one of the second hand of Three-In-One if the player's hand contains any of the predetermined arrangement of cards set out on the layout (e.g., the king-queen combination), the player wins all the chips associated therewith).

The appellant's argument (brief, pp. 14-19) that Three-In-One is not a casino game is unpersuasive since it is not commensurate in scope with the claimed invention. In that regard, the claims only require that a jackpot component be

included in a live casino table game. The claims do not require the method to be preformed in a casino. Since poker is a live casino table game, stage 1 of Three-In-One adds a jackpot component to a live casino table game.

New grounds of rejection

I. In view of the fact that our rationale for affirming the rejection based on Three-In-One under 35 U.S.C. § 102(b) is different from that applied by the examiner, we denominate the affirmance of this rejection a new ground of rejection under 37 CFR § 1.196(b).

II. Claims 6 and 14 are rejected under 35 U.S.C. § 103 as being unpatentable over Tripoley.

Claims 6 and 14 read on Tripoley as follows:

A method of including a jackpot component (pay cards of Tripoley) in a live casino table game (poker of Tripoley since poker is a live casino game) comprising the steps of:

(a) a player wagering at least one first gaming token to participate in the live casino table game (each player at

the start of each hand in Tripoley must put a chip in the pot),

(b) a player wagering at least one second gaming token to participate in the jackpot component (each player at the start of each hand in Tripoley must put one chip next to each of the ace, king, queen, jack, ten, the king-queen combination, and the sequence of eight, nine and ten (i.e., the pay cards of Tripoley)),

(c) a dealer dealing a hand of playing cards to the player (the dealer deals the hand to the player),

(d) if the player's hand comprises/consists of a predetermined arrangement of cards, the player wins a predetermined fixed amount<sup>7</sup> (in the hearts portion (i.e., pay cards) of Tripoley if the player's hand contains any of the predetermined arrangement of cards (i.e., the ace, king, queen, jack, ten, the king-queen combination, or the sequence of eight, nine and ten), the player wins all the chips associated therewith).

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<sup>7</sup> Id.

Based on our analysis and review of Tripoley and claims 6 and 14, it is our opinion that the only difference<sup>8</sup> is the limitation that the player wagers at least one second gaming token to participate in the jackpot component after having wagered at least one first gaming token to participate in the live casino table game. Tripoley only teaches that the wagering to participate in the jackpot component (i.e., hearts/pay cards) and the live casino table game (i.e., poker) takes place prior to dealing the hand. Thus, Tripoley is silent as to the relative order of betting.

With regard to this difference, we reach the conclusion that it would have been prima facie obvious<sup>9</sup> to one of ordinary skill in the art at the time the invention was made

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<sup>8</sup> After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

<sup>9</sup> The conclusion of obviousness may be made from "common knowledge and common sense" of the person of ordinary skill in the art (see In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)). Moreover, skill is presumed on the part of those practicing in the art. See In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

to bet the chip for poker prior to betting the chips for hearts/pay cards since the order of betting (placing each players chips in the respective area (e.g., pot, kitty, etc.)) would have been recognized by one of ordinary skill in the art as being a matter of choice for the player.

III. Claims 9 and 17 are rejected under 35 U.S.C. § 103 as being unpatentable over Tripoley in view of Three-In-One.

Claims 9 and 17 depend respectively from claims 6 and 14 and add to their parent claim the limitation that "the predetermined arrangement of cards includes at least one 7."

We reach the conclusion that it would have been further prima facie obvious to one of ordinary skill in the art at the time the invention was made to replace Tripoley's pay sequence of eight, nine and ten with the known alternative pay sequence of seven, eight and nine taught by Three-In-One.

CONSIDERATION OF EVIDENCE OF NONOBVIOUSNESS

Having arrived at the conclusion that the teachings of the prior art are sufficient to establish a prima facie case of obviousness with respect to the new grounds of rejection set forth above, we recognize that the evidence of nonobviousness submitted by the appellant must be considered en route to a determination of obviousness/nonobviousness under 35 U.S.C.

§ 103. See Stratoflex Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). Accordingly, we consider anew the issue of obviousness under 35 U.S.C. § 103, carefully evaluating therewith the objective evidence of nonobviousness supplied by the appellant. See In re Oetiker, 977 F.2d 1443, 1445-46, 24 USPQ2d 1443, 1444-45 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984).

In this case the appellant has directed our attention to the evidence of nonobviousness as set forth on pages 25-28 of the brief. We do not believe that the evidence establishes copying of the subject matter of claims 6, 9, 14 and 17 or

commercial success of the invention recited in claims 6, 9, 14 and 17.

With regard to copying, the evidence fails to establish that the subject matter of either claims 6, 9, 14 or 17 was copied. We note additionally that more than the mere fact of copying is necessary to make that action significant because copying may be attributable to other factors such as a lack of concern for patent property or contempt for the patentee's ability to enforce the patent. See Cable Elec. Prods, Inc. v. Genmark, Inc., 770 F.2d 1015, 1028, 226 USPQ 881, 889 (Fed. Cir. 1985). Alleged copying is not persuasive of nonobviousness when the copy is not identical to the claimed product, and the other manufacturer had not expended great effort to develop its own solution. See Pentec, Inc. v. Graphic Controls Corp., 776 F.2d 309, 317, 227 USPQ 766, 771 (Fed. Cir. 1985). See also Vandenberg v. Dairy Equip. Co., 740 F.2d 1560, 1567, 224 USPQ 195, 199 (Fed. Cir. 1984)(evidence of copying not found persuasive of nonobviousness) and Panduit Corp. v. Dennison Mfg. Co., 774 F.2d 1082, 1099, 227 USPQ 337, 348-49 (Fed. Cir. 1985),

vacated on other grounds, 475 U.S. 809, 229 USPQ 478 (1986),  
on remand, 1 USPQ2d 1593 (Fed. Cir. 1987)(evidence of copying  
found persuasive of nonobviousness where admitted infringer  
failed to satisfactorily produce a solution after ten years of  
effort and expense).

With regard to commercial success, the evidence does not  
provide any data concerning the market share of the subject  
matter of claims 6, 9, 14 and 17. Although the evidence  
certainly indicates that many dollars have been generated in  
revenue, it provides no indication of whether this represents  
a substantial quantity in this market. Our reviewing court  
has noted in the past that evidence related solely to the  
number of units sold provides a very weak showing of  
commercial success, if any. See In re Huang, 100 F.3d 135,  
137, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996); Cable Elec.  
Prods., Inc. v. Genmark, Inc., 770 F.2d 1015, 1026-27, 226  
USPQ 881, 888 (Fed. Cir. 1985) (finding that sales of 5  
million units represent a minimal showing of commercial  
success because "[w]ithout further economic evidence . . . it  
would be improper to infer that the reported sales represent a

substantial share of any definable market"); see also In re Baxter Travenol Lab., 952 F.2d 388, 392, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991) ("[I]nformation solely on numbers of units sold is insufficient to establish commercial success."); Kansas Jack, Inc. v. Kuhn, 719 F.2d 1144, 1151, 219 USPQ 857, 861 (Fed. Cir. 1983) (determination of obviousness not erroneous where evidence of commercial success consisted solely of number of units sold and where no evidence of nexus). On the basis of the limited information provided, we conclude that the appellant has failed to establish commercial success.

Even assuming that the appellant had sufficiently demonstrated commercial success, that success is relevant in the obviousness context only if it is established that the sales were a direct result of the unique characteristics of the claimed invention, as opposed to other economic and commercial factors unrelated to the quality of the claimed subject matter. See Cable Elec., 770 F.2d at 1027, 226 USPQ at 888. In other words, a nexus is required between the sales and the merits of the claimed invention. In proceedings

before the Patent and Trademark Office, an appellant must show that the claimed features were responsible for the commercial success of an article if the evidence of nonobviousness is to be accorded substantial weight. Merely showing that there was commercial success of an article which embodied the invention is not sufficient. See Ex parte Remark, 15 USPQ2d 1498, 1502-03 (Bd. Pat. App. & Inter. 1990). Compare Demaco Corp. v. F. Von Langsdorff Licensing Ltd., 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir.), cert. denied, 488 U.S. 956 (1988). See also Pentec, Inc. v. Graphic Controls Corp., 776 F.2d 309, 227 USPQ 766 (Fed. Cir. 1985) (commercial success may have been attributable to extensive advertising and position as a market leader before the introduction of the patented product); In re Fielder, 471 F.2d 640, 176 USPQ 300 (CCPA 1973) (success of invention could be due to recent changes in related technology or consumer demand; here success of claimed voting ballot could be due to the contemporary drive toward greater use of automated data processing techniques).

The appellant has failed to submit any factual evidence that would demonstrate the required nexus between the claimed

invention and the evidence of commercial success. In sum, the appellant simply has not carried his burden to establish that a nexus existed between any commercial success and the novel features claimed in the application (i.e., claims 6, 9, 14 and 17).

In the final analysis, evidence of nonobviousness, although being a factor that certainly must be considered, is not necessarily controlling. See *Newell Companies, Inc. v. Kenney Manufacturing Co.*, 864 F.2d 757, 768, 9 USPQ2d 1417, 1426 (Fed. Cir. 1988).

In view of the foregoing, we are satisfied that when all the evidence and arguments are considered, the evidence of nonobviousness fails to outweigh the evidence of obviousness as in *Richardson-Vicks Inc. v. Upjohn Co.*, 122 F.3d 1476, 44 USPQ2d 1181 (Fed. Cir. 1997) and *EWP Corp. v. Reliance Universal, Inc.*, 755 F.2d 898, 225 USPQ 20 (Fed. Cir. 1985). Accordingly, we conclude that claims 6, 9, 14 and 17 would have been obvious under 35 U.S.C. § 103 as set forth above.

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CONCLUSION

To summarize, the decision of the examiner to reject claims 6 and 14 under 35 U.S.C. § 102(b) as being anticipated by Rules of Poker is reversed; the decision of the examiner to reject claims 6 through 14 under 35 U.S.C. § 102(b) as being anticipated by Three-In-One is affirmed, however, for reasons explained supra, we have denominated this affirmance a new ground of rejection under 37 CFR § 1.196(b); the decision of the examiner to reject claims 6 and 14 under 35 U.S.C. § 102(b) as being anticipated by Big Field is reversed; the decision of the examiner to reject claims 6 through 21 under 35 U.S.C.

§ 102(b) as being anticipated by Pontoon is reversed; the decision of the examiner to reject claims 7 through 13 and 15 through 21 under 35 U.S.C. § 103 as being unpatentable over Big Field in view of Pontoon is reversed; and the decision of the examiner to reject claims 6 and 14 under 35 U.S.C. § 103 as being unpatentable over Rules of Poker is reversed. In addition, new grounds of rejection of claims 6, 9, 14 and 17 under 35 U.S.C.

§ 103 have been added pursuant to provisions of 37 CFR

§ 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

AFFIRMED-IN-PART; 37 CFR § 1.196(b)

|                             |   |                 |
|-----------------------------|---|-----------------|
| CHARLES E. FRANKFORT        | ) |                 |
| Administrative Patent Judge | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
|                             | ) | BOARD OF PATENT |
| JEFFREY V. NASE             | ) | APPEALS         |
| Administrative Patent Judge | ) | AND             |
|                             | ) | INTERFERENCES   |
|                             | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
| MURRIEL E. CRAWFORD         | ) |                 |
| Administrative Patent Judge | ) |                 |

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APPEAL NO. 98-2255 - JUDGE NASE  
REEXAMINATION NO. 90/003,842

APJ NASE

APJ CRAWFORD

APJ FRANKFORT

DECISION: **AFFIRMED-IN-PART,**  
**37 CFR § 1.196(b)**

Prepared By: Gloria

Henderson

**DRAFT TYPED:** 21 Dec 98

**FINAL TYPED:**

**HEARD: 07 Dec 98**

**THREE JUDGE CONF.**