

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM R. FONTANA

Appeal No. 98-1017
Application 08/585,472¹

ON BRIEF

Before CALVERT, FRANKFORT and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

William R. Fontana appeals from the final rejection of claims 1 through 7, all of the claims pending in the application. We reverse and enter a new rejection of claim 7 pursuant to 37 CFR

¹ Application for patent filed January 16, 1996. According to appellant, the application is a division of Application 08/338,045, filed November 14, 1994, now abandoned, which is a continuation in part of Application 08/182,229, filed January 18, 1994, now abandoned.

§ 1.196(b).

The invention relates to a method of playing a board game “which combines the skill features of chess with the excitement of a game simulating military maneuvers” (specification, page 1). Claim 1 is illustrative and reads as follows:

1. A method of playing a board game, the board game having a playing board and a playing area comprising the steps of;

dividing said playing area into a plurality of squares of alternating color;

placing a plurality of playing pieces initially in predetermined ones of said squares for a first and second player, the game's pieces of said first and second player comprising four separate categories, the first category comprising one playing piece, the second category comprising three playing pieces, the third category comprising four playing pieces and the fourth category comprising four playing pieces, the position of said pieces for said first and second player being initially a mirror image;

moving the pieces of said first and second player in a predetermined sequence, more than one piece being movable by each player in a turn of play, a first piece of said first player occupying a first square of said playing board throughout the game, a second piece of said second player occupying a second square of said playing board throughout the game; and

operating a device to determine the number of total squares the pieces are to be moved in each turn of play, said first player winning the game if one of that player's pieces occupies said second square before one of said other player's pieces occupies said first square.

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

Dozorsky	4,982,965	Jan. 8, 1991
Andre	904,669	Nov. 13, 1945

(French Patent Document)²

Claims 1 through 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Andre in view of Dozorsky.

Reference is made to the appellant's brief (Paper No. 7) and to the examiner's answer (Paper No. 8) for the respective positions of the appellant and the examiner with regard to the merits of this rejection.

Andre, the examiner's primary reference, pertains to board games having military themes. The embodiment relied upon by the examiner (see Figures 21 through 31 and pages 19 through 26 of the translation) includes a checkerboard playing area having squares designating ground, fortified positions and a river and a variety of playing pieces whose capacity to move, capture and destroy is dictated by their relationship with the board and the other playing pieces.

As conceded by the examiner (see page 4 in the answer), Andre fails to meet the limitations in claim 1 requiring the step of placing a plurality of playing pieces initially in predetermined ones of squares of a playing board for a first and a second player with the position of the pieces for the first and second players being initially a mirror image. In this regard, Andre teaches that "[a]t the beginning of

² The record indicates that an English language translation of this reference was mailed to the appellant with the examiner's answer.

the game each player arranges his pieces at will, in his area” (translation, page 24).

Dozorsky discloses a military-type board game which is described in the following terms:

a game between opposing players having sets of 30 pieces, each set consisting of one capital, two generals, eleven ambients, nine regulars and seven patrols. Each set arranged in identical starting formation on a rectangular game board of 126 checkered square[s]. Each of the sets has one capital which occupies the central square of the end row of 9 squares, and which can be captured by any opposing-set piece that approaches within unobstructed capturing range, and which once captured cannot be retaken, and which cannot itself move or capture any piece but must be protected by the pieces of its own set. All of the other pieces can optionally move, capture opposing-set pieces, or be captured. Each such piece has its allowable range of movement and range of ability to capture other pieces, depending on its type. A piece moves by traveling from one square to another. A capturing piece always displaces the captured piece from its square, and the captured piece is excluded from the field of play. The objective in winning the game is to be the first to capture the capital of the opposing set, while successfully preventing the capture of the capital of one’s own set. The players use single alternate moves to proceed with the game [Abstract].

In combining Andre and Dozorsky to reject claim 1, the examiner submits that

[i]n view of [Dozorsky’s] teaching, it would have been obvious to modify Andre’s game rules by requiring the players to initially position their playing pieces in a predetermined mirror image on the playing board. This modification would have eliminated any strategic advantage a player may have at the start of Andre’s game, and thus giv[es] each player, at the start of Andre’s game, an equal or fair chance at winning Andre’s game [answer, pages 4 and 5].

We agree with the appellant, however, that the collective teachings of Andre and Dozorsky would not have suggested this modification.

The game disclosed by Andre is much more realistic in terms of simulating military action than the game disclosed by Dozorsky. This is perhaps best demonstrated by the more sophisticated game

board and playing piece capabilities employed by Andre. An integral part of this realism is the strategy afforded by Andre's step of allowing each player to arrange his or her pieces at will within designated areas of the board at the beginning of the game. The examiner's proposed modification of Andre's game to require the pieces of the opposing players to be initially positioned in mirror image runs counter to the realistic tone sought by Andre. Moreover, the teachings of the references do not justify the examiner's implication that the initial playing piece arrangement step taught by Andre provides an undesirable or unfair strategic advantage. In this light, we are constrained to conclude that the only suggestion for combining Andre and Dozorsky in the manner proposed by the examiner stems from an improper hindsight reconstruction of the claimed invention.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103 rejection of claim 1 or of claims 2 through 7 which depend therefrom.

The following rejection is entered pursuant to 37 CFR § 1.196(b).

Claim 7 is rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification which fails to comply with the written description requirement of this section of the statute.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ

1089, 1096 (Fed. Cir. 1983). The content of the drawings may also be considered in determining compliance with the written description requirement. Id.

Here, the disclosure of the application as originally filed would not reasonably convey to the artisan that the appellant had possession at that time of a method wherein a player loses any

additional moves the player may have upon landing upon a square occupied by a piece of the other player as is now recited in claim 7. The relevant portion of the original disclosure provides that

[w]hen a token captures an enemy token it cannot be moved from the square that was occupied by the enemy token. A player must wait for his or her next turn of play to move it from that square, even though the player may still have additional moves to make [specification, page 6, emphasis added].

There is nothing in this passage, or in any other part of the original disclosure, which indicates that a player loses any additional moves upon landing on an occupied square.

In summary:

- a) the decision of the examiner to reject claims 1 through 7 under 35 U.S.C. § 103 is reversed;
- and
- b) a new 35 U.S.C. § 112, first paragraph, rejection of claim 7 is entered pursuant to 37 CFR 1.196(b).

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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. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark 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).

REVERSED; 37 CFR § 1.196(b)

IAN A.CALVERT)

Appeal No. 98-1017
Application 08/585,472

Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	APPEALS AND
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