

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT ADELL

Appeal No. 97-1473
Application 08/492,376¹

ON BRIEF

Before COHEN, ABRAMS and FRANKFORT, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 9. Claim 10, the only other claim remaining in the application, has been objected to by the examiner as being dependent upon a rejected base claim,

¹Application for patent filed June 19, 1995.

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but has been indicated as being allowable subject to being rewritten in independent form.

Appellant's invention relates to a lottery number picker and to a method of assembling a lottery number picker. Independent claims 1 and 8 are representative of the subject matter on appeal and a copy of those claims, as found in the Appendix to appellant's brief, is attached to this decision.

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

Albright et al. (Albright) 1985	4,533,143	Aug. 06,
Stebing 1991	5,011,148	Apr. 30,
Adell 1995	5,454,567	Oct. 03,

Claims 1 through 7 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 15 of U.S. Patent No. 5,454,567 in view of Albright.

Claim 8 and 9 stand rejected under 35 U.S.C. §103 as being unpatentable over Stebing in view of Albright.

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The examiner's statement of the rejections and response to appellant's arguments appears on pages 3 through 5 of the examiner's answer (Paper No. 8, mailed August 14, 1996).

Appellant's viewpoints concerning the examiner's rejections of the appealed claims are found in the brief (Paper No. 7, filed May 17, 1996) and in the supplemental brief (Paper No. 12, filed April 7, 1998).

OPINION

In arriving at our decision in this appeal, we have carefully considered appellant's specification and claims, the applied references, and the respective viewpoints of appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

Turning first to the examiner's rejection of claims 1 through 7 under the judicially created doctrine of obviousness-type double patenting, we understand the examiner's position to be that the compact case set forth in

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claims 1 and 15 of appellant's prior U.S. Patent No. 5,454,567 is fully responsive to the lottery number picker defined in claims 1 through 7 on appeal, except that the compact case of claims 1 and 15 of appellant's prior patent does not include numbered disks (e.g., 34) which have numbers on both the upper and lower faces thereof

as required in the claims presently on appeal. To account for this deficiency the examiner looks to Albright, urging that Albright teaches that it is known in the lottery picker art to mark random lottery pieces (e.g., 20) with lottery numbers on all faces of each of the pieces. In the examiner's opinion, based on the teachings of Albright, it would have been obvious to one of ordinary skill in the art to provide lottery numbers on both faces of the disks set forth in claims 1 and 15 of appellant's prior U.S. Patent No. 5,454,567 in order to assemble the lottery number picker more conveniently.

After reviewing claims 1 and 15 of U.S. Patent No. 5,454,567 and the teachings of Albright, we, like appellant,

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are of the view that the examiner has engaged in an impermissible hindsight reconstruction in attempting to modify the compact case set forth in patent claims 1 and 15, in light of the distinctly different random number selection device of Albright, so as to provide numbers on both faces of the disks in the compact case of patent claims 1 and 15. While it is essential that the cubes (20) of Albright, which are suspended and freely movable in a random manner in the fluid (23) of the container (2), have numbers on all of the faces of the cubes so as to provide a complete number

in the window area (5) so that a six digit lottery number may be selected, we observe that no such requirement is present or necessary with regard to the disks (34) in the compact case of appellant's prior U.S. Patent No. 5,454,567. In contrast to the cubes of Albright, the disks of the '567 patent are constrained to move in a single plane in the space (32) between the platform (31) and the cover (35) and thus only one face of the disks, on the side adjacent the transparent cover (35), would require a number thereon. Given the distinctly different structural and functional relationships involved

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with regard to the numbered pieces of the device in Albright and that of appellant's prior patent claims 1 and 15, we consider that the combination proposed by the examiner would not have been obvious to one of ordinary skill in the art absent the hindsight benefit of appellant's own teachings in the present application before us on appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 through 7 under the judicially created doctrine of obviousness-type double patenting.

Next we look to the examiner's rejection of claims 8 and 9 under 35 U.S.C. § 103 based on the combined teachings of Stebing

and Albright. In this instance, appellant asserts that Stebing discloses circular disks (e.g., 16) which have numbers on only one side of the disks, and lacks any motivation for numbering the opposite sides of the disks therein. In addition, appellant has provided two affidavits from persons skilled in

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the art (i.e., Pat O'Bryan and Tod H. Dereadt, who are said to be "experts") who have opined, after reviewing both Stebing and Albright, that appellant's feature of marking numbers on opposite sides of each disk is not obvious, primarily due to increased costs in the manufacturing of such disks. In reaching their opinions, both Mr. O'Bryan and Mr. Dereadt characterize Stebing as having numbers on only one face of each disk. See paragraph 8 of the O'Bryan affidavit and paragraph 7 of Mr. Dereadt's affidavit.

We have carefully reviewed the complete disclosure of the Stebing patent, and due to the express teaching found at column 5, lines 26-28, therein, we find appellant's arguments and the opinions of Mr. O'Bryan and Mr. Dereadt to be entirely unpersuasive. The teaching at column 5, lines 26-28 of Stebing indicates that when the base (20) and top surface (22) of cover (14) of the lottery number picker therein are transparent "disc 16 preferably has two faces 50 with symbols apparent," that is,

opposite faces (50) of the disc seen in Figure 6 of Stebing

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would have symbols (e.g., numbers) on those faces and such numbers/symbols would be viewable from the top surface (22) and from the base side of the lottery number picker. Given this teaching in Stebing, we find the examiner's use of the Albright patent to be mere surplusage and sustain the § 103 rejection of claims 8 and 9 on the basis of Stebing alone. As has been made clear by our reviewing Courts on numerous occasions, anticipation or lack of novelty is the ultimate or epitome of obviousness. See, in this regard, In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641 (CCPA 1974).

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection against claims 1 through 7 on appeal.

Claims 1 through 7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 through 4, 11, 13 and 15 of U.S. Patent No. 5,454,567 in view Stebing. The compact case of the enumerated claims in the '567 patent is the same as that set forth in claims 1 through 7 on appeal, with the exception that

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the claims of appellant's prior patent are silent as to whether the numbered disks set forth therein actually include numbers on both of the opposite sides or faces of the disks. However, given that the case as defined in these claims is completely transparent, that is, it has a first transparent cover, a transparent platform, and a second transparent cover, we consider that the teachings of Stebing at column 5, lines 26-28 (noted above) would have made it obvious to one of ordinary skill in the art to provide the numbered disks of the case defined in claims 1 through 4, 11, 13 and 15 of the '567 patent with identical numbers on the opposite faces of each disk.

While we recognize that the lottery number picker of the enumerated claims in appellant's prior patent is intended to receive a thin card in the lower space therein, we also note that the lottery number picker does not include such a card in the lower space during its manufacture, shipping or distribution, and that the insertion of such a card, even after purchase, is entirely optional with the purchaser. Thus, in at least some cases, the card would not be inserted

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in the lower space and the numbered disks would be usable and viewable from both faces of the lottery number picker, and as suggested in Stebing should

therefore advantageously include a number/symbol on the opposite faces of each disk. It matters not that the reason for combining the teachings as noted above is not the same as appellant's reason for the noted modification. The law is clear that the

purpose proposed as to the reason why an artisan would have found the claimed subject matter to have been obvious under 35 U.S.C. § 103 need not be identical to the purpose or problem which the patent applicant indicates to be the basis for having made the invention. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) and In re Dillon, 919 F.2d 688, 693, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990). Moreover, it is not required that the prior art teachings relied upon disclose the same advantage that appellant alleges, all that is required is that there is a reasonable suggestion to do what the claimed subject matter encompasses. See In re Kronig, 539 F.2d 1300, 1304, 190 USPQ 425, 428 (CCPA 1976) and Ex parte Obiaya,

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227 USPQ 58 (BPAI 1985). In the present case, we find a reasonable suggestion to do what appellant's now claimed subject matter encompasses.

Regarding the requirement of appellant's claim 7 on appeal that the numbered disks be "about 6mm in diameter and about 1.5mm thick," we consider such sizing to be a mere matter of design choice, especially since appellant's specification (page 5)

indicates that such sizing is only exemplary and since we find nothing in the specification which indicates that this sizing solves any particular problem or provides some unexpected result.

To summarize our decision, we have reversed the examiner's rejection of claims 1 through 7 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 15 of U.S. Patent No. 5,454,567 in view of Albright. We have affirmed the examiner's rejection of claims 8 and 9 under 35 U.S.C. §103 based on Stebing and Albright. In addition, pursuant to 37 CFR § 1.196(b), we have

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entered a new ground of rejection against claims 1 through 7 on appeal under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 through 4, 11, 13 and 15 of U.S. Patent No. 5,454,567 in view Stebing.

In accordance with the foregoing, it is clear that the decision of the examiner has been affirmed-in-part.

In addition to affirming the examiner's rejection of one or more claims, 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, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

37 CFR § 1.196(b) also provides that the appellant, WITHIN

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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 (37 CFR § 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. . . .

Should appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is

deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application,

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abandonment or a second appeal, this case should be returned to us for final action on the affirmed rejection, including any timely request for reconsideration thereof.

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)

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
)	
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	

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Alex Rhodes
Suit 460
30100 Telegraph Road
Bingham Farms, MI 48025