

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ROBERT JACOBS

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Appeal No. 97-2886  
Application 08/441,493<sup>1</sup>

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ON BRIEF

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Before MEISTER, GARRIS 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 and 3 through 20, all of the claims remaining in the application. Claim 2 has been canceled.

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<sup>1</sup>Application for patent filed May 15, 1995.

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Appellant's invention relates to an apparatus and method for playing an anagram-type word game in a computer game and/or t.v. game show format. Claims 1, 9, 12, 15 and 16 are representative of the subject matter on appeal and a copy of those claims may be found in the Appendix to appellant's brief.

The sole prior art reference of record listed by the examiner (answer, pages 2-3) as relied upon in the rejection of the claims under appeal is:

Cunningham et al. (Cunningham)      5,041,992      Aug. 20, 1991

As stated by the examiner on page 3 of his answer, claims 1 and 3 through 20 stand rejected under 35 U.S.C. § 103 "as being unpatentable over Cunningham."

It is, however, immediately apparent from the examiner's somewhat meager explanation of the rejection on page 3 of the answer (addressing only claim 1 on appeal) that he is in fact relying upon certain admitted prior art set forth in appellant's specification regarding a known anagram-type game called REVELATION™ and also on other known prior art the examiner

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describes as "'drag' modes known on computer interfaces," along with the teachings of the Cunningham patent, in formulating the 35 U.S.C. § 103 rejection of appellant's claims on appeal. Moreover, as noted by appellant in the reply brief (Paper No. 9), the examiner in his "Response to Argument" section of the answer (pages 4-10) also relies upon other prior art, such as the "file Manager" applications in Windows, highlighting features in Windows applications, Solitaire in Windows applications, and the t.v. game shows "Jeopardy" and "Wheel of Fortune."

Rather than reiterate the examiner's understanding of the above-noted rejection and the conflicting viewpoints advanced by the examiner and appellant regarding the rejection, we make reference to the examiner's answer (Paper No. 8, mailed June 10, 1996) for the examiner's reasoning in support of the rejection, and to appellant's brief (Paper No. 7, filed May 14, 1996) and reply brief (Paper No. 9, filed July 30, 1996) for appellant's arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to

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the applied prior art, and to the respective positions articulated by 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 independent claim 1 under 35 U.S.C. § 103, we note that this claim requires, *inter alia*, that each of the characters of the unsolved arrangement of the one or more anagrams in the unsolved area of the game board have "a path defined by a predetermined plurality of points from said character's initial position to said character's final position" in the solution area of the game board, and that the apparatus include "character moving means for moving each of said characters along its respective path... in response to selection of said character." As explained in the paragraph bridging pages 4 and 5 of the specification, this aspect of appellant's invention contributes to easy visualization of the progress of the puzzle from the time the puzzle is originally presented until the time the puzzle is completely solved and distinguishes appellant's game from the known previous version of REVELATION™ wherein the letters/characters of the anagrams apparently just disappeared from their initial position

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in the unsolved area of the game board and reappeared in their final position in the solution area of the game board. See Figures 4, 5 and 8 through 12 of the application drawings for a showing of the respective paths (136, 140, 142, 144).

To address this difference between the known previous version of the anagram game REVELATION™ and appellant's claimed apparatus, the examiner urges that the recited movement of characters is "considered to be old and well known to the 'drag' modes known on computer interfaces" (answer, page 3). In addition, the examiner points to the teaching in Cunningham of arcade games (col. 1, line 13) and the teaching at column 1, line 38, of Cunningham, and concludes that

To have provided computer outlines in "a path of predetermined plurality of points" with a "means for moving" as required by claim 1 would have been obvious to provide a more easily understood interface.

On page 5 of the answer, the examiner also points to the "File Manager" applications in Windows, urging that "[i]cons of the files can be directly 'dragged' from on [sic, one] disk drive to another along a path of a predetermined plurality of points"

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and that clearly, this "drag" feature on computer interfaces "is used so that one can follow an icon from a source to a destination (or a letter from a source to a destination as in the instant invention)."

Like appellant, we find nothing in the teachings of Cunningham referred to by the examiner, or in the "drag" mode of known computer interfaces relied upon by the examiner, which would have led one of ordinary skill in the art to modify the previously known version of the anagram game REVELATION™ described in appellant's specification so as to arrive at the particular apparatus set forth in appellant's claim 1 on appeal. Neither Cunningham, nor the known "drag" modes we are aware of, provide any teaching or suggestion of 1) moving characters of an anagram-type game along "a path defined by a predetermined plurality of points from said character's initial position to said character's final position" or 2) a "character moving means for moving each of said characters along its respective path... in response to selection of said character," as defined in appellant's claim 1. In contrast with the examiner's characterization of the "drag" mode used in the "File Manager"

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application in Windows, we agree with appellant that movement of an icon using the "drag" mode in the "File Manager" application is not along "a path defined by a predetermined plurality of points..." as in appellant's claim 1 on appeal, but instead allows the selected icon to be "dragged" by the user along any path he/she chooses.

Moreover, we do not see how Cunningham in any way "clearly teach [sic] and bridges any gap between the game of Revelations [sic] and known computer display manipulations," as urged by the examiner on page 8 of the answer. Even if one would have gleaned from Cunningham that arcade games played on a computer are known to use "drag" features, as the examiner believes, we do not see how this fact alone, or in combination with the "drag" mode in the "File Manager" application of Windows, would have led one of ordinary skill in the art to modify the previously know version of the game of REVELATION™ in the manner urged by the examiner so as to arrive at the particular apparatus set forth in appellant's claim 1 on appeal. Again, we note that there is no teaching or suggestion in the applied prior art of moving a character of an anagram from its initial position in the unsolved area of the

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game board to said character's final position in the solution area of the game board along a predefined path of the type set forth in appellant's claim 1.

For the above reasons, the examiner's rejection of appellant's independent claim 1 under 35 U.S.C. § 103 will not be sustained. The examiner's rejection under 35 USC § 103 of claims 3 through 8, which depend from claim 1, will likewise not be sustained. In this regard, we note particularly that the examiner's interpretation of the "substantially identical" portions of the paths in appellant's claim 3 on appeal (answer, pages 5-6) is clearly not a "reasonable" interpretation of the claim requirements given appellant's disclosure (specification, pages 4-5) regarding such "substantially identical" path portions. In this regard, we note that it is well settled that, during the prosecution of a patent application, claims are to be given their broadest reasonable interpretation consistent with the specification. See, In re Sneed, 710 F.2d 1544, 218 USPQ 385 (Fed. Cir. 1983); In re Tanaka, 551 F.2d 855, 193 USPQ 138 (CCPA 1977).

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Looking next at independent claim 9 on appeal, we note that this claim defines an apparatus for playing an anagram-type game, wherein the apparatus includes, *inter alia*, "character moving means" for moving each of said characters from its respective initial position to its respective final position, and

outline means for displaying on [sic, an] outline of each of said characters in its initial position after said character is moved from its initial position, whereby said outline can be viewed together with adjacent characters or outlines in said unsolved area."

On pages 4-6 of the specification, appellant again emphasizes that these aspects of the invention assist the viewer in studying and concentrating on the unsolved anagram, thereby making it easier for the viewer and players to play and follow the game and therefore necessarily adds considerable enjoyment.

On page 6 of the answer, the examiner has indicated that an outline like that required in appellant's claim 9 is "considered old to computer manipulations" and that applying such a known outline to a game of REVELATION™ would have been obvious to mark the location of the source of an image after it has been translated to its destination. Like appellant, we find the

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examiner's bare assertion in this regard to be without any factual underpinnings in the applied prior art and not otherwise explained with any reasonable degree of specificity. It is by now well settled that a rejection based on § 103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the examiner has the initial duty of supplying the factual basis for the rejection he advances. He may not, because he doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. See In re Warner, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967). Absent the required factual basis on the examiner's part, we refuse to sustain the rejection of appellant's claim 9 under 35 U.S.C. § 103. It follows that the examiner's rejection of claims 10 and 11, which depend from claim 9, will also not be sustained.

Independent claim 12 on appeal defines an apparatus for playing an anagram-type game, wherein the apparatus includes, *inter alia*, "character moving means" for moving each of said characters from its respective initial position to its respective

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final position, and "indicator means for directing the attention of players of said game to a selected one of said unsolved areas before a player guesses the solution of the anagram in said unsolved area." Page 6, lines 19-25, of appellant's specification discusses the indicator means and notes that in the disclosed anagram game such indicator means allows everyone to focus their attention on the area of the game board where movement of characters will take place in the then immediate future.

In rejecting claim 12 under 35 U.S.C. § 103, the examiner has urged (answer, page 6) that highlighting features are old to direct image manipulations. In this regard, the examiner suggests that we note any Windows application where an icon is highlighted upon being selected prior to any manipulation. While it is certainly true that highlighting features in computer systems of the type referred to by the examiner are known, we are of the opinion that the proposed combination of such known highlighting features with the previously known anagram game of REVELATION™ in the particular manner now posited by the examiner so as to arrive at the apparatus required in appellant's claim 12 on appeal is based on impermissible hindsight derived from

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appellant's own disclosure and not from any fair teaching or suggestion found in the applied prior art itself.

In this regard, we consider that the examiner has used appellant's own disclosure and the claimed invention itself as a blueprint for piecing together elements in the prior art so as to defeat patentability of the apparatus defined in appellant's claim 12. Moving a mouse indicator arrow to an icon and clicking on the icon to highlight the selected icon prior to activation thereof, as suggested by the examiner, is far different than the operation of the indicator means disclosed by appellant and as required in claim 12 on appeal. The indicator means of claim 12 is provided for directing the attention of players and viewers of an anagram game to "a selected one of said unsolved areas" before a player guesses the solution of the anagram in said unsolved area. By contrast, the highlighting feature alluded to by the examiner where an icon is highlighted by a user, is the result of the user already being focussed on a particular icon of interest and then moving the mouse arrow to the desired icon which is thereafter highlighted by the user so that it can be subsequently activated by the user.

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Since, as noted above, we consider that the examiner's combination of the prior art in this instance is motivated solely by impermissible hindsight, it follows that we will not sustain the examiner's rejection of appellant's claim 12 under 35 U.S.C. § 103. For the same reason, we will also not sustain the examiner's rejection of dependent claims 13 and 14 under 35 U.S.C. § 103.

Independent claim 15 on appeal is directed to an apparatus for playing an anagram game, wherein the apparatus includes, *inter alia*, "character moving means" for moving each of said characters from its respective initial position to its respective final position, and "random selection means for randomly selecting one of said final positions into which a predetermined one of said characters is to be moved by said character moving means." The "character moving means" is described in the paragraph bridging pages 4 and 5 of appellant's specification, while the "random selection means" is described in the paragraph bridging pages 7 and 8 of the specification. On page 7 of his answer, the examiner has taken the position that claim 15 on appeal presents

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limitations that "are considered old to game show formats in general." More specifically, the examiner is of the view that

randomly assigning point or dollar values to solution areas in a game show where that point or dollar value is awarded upon correct actions by a player are old to game show formats themselves. Jeopardy has its random "Daily Double" square that is randomly assigned.

Like appellant, we find no teaching or suggestion in the applied prior art for the specific form of "character moving means" or "random selection means" disclosed and claimed by appellant in claim 15 on appeal. In contrast with the examiner's assertions, we are not aware that the "Daily Double" square on the t.v. game show Jeopardy is "randomly assigned," and even if it were, we see no suggestion or incentive in such a teaching for modifying the previously known anagram game of REVELATION™ in a manner so as to result in the particular apparatus defined in appellant's claim 15 on appeal. The function and manner of use of the "Daily Double" square on Jeopardy is entirely different from the "random selection means" disclosed by appellant and defined in appellant's claim 15 on appeal, and is clearly not the equivalent thereof. For this reason, we will not sustain the

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examiner's rejection of appellant's independent claim 15 under 35 U.S.C. § 103.

The last of appellant's independent claims for our consideration on appeal is method claim 16. This claim sets forth a method for playing an anagram-type game, which method includes, *inter alia*, the steps of "randomly selecting one of said anagrams" and "moving the characters of said selected anagram... in response to the solution of said anagram being guessed by said player." The step of "moving the characters of said selected anagram" is described in the paragraph bridging pages 4 and 5 of appellant's specification, while the step of "randomly selecting one of said anagrams" is described in the paragraph bridging pages 7 and 8 of the specification. After considering the examiner's position as set forth on page 7 of the answer, we, like appellant, find no teaching or suggestion in the applied prior art concerning the last two recited steps of claim 16 on appeal.

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In contrast with the examiner's assertions, we are not aware that the typical format of the previously known REVELATION™ game included the specific step of randomly selecting one of the anagrams as required in appellant's claim 16 on appeal, or that such prior game involved the particular step of "moving the characters of said selected anagram" as set forth in appellant's claim 16. In this regard, we note that neither appellant nor the examiner has clearly defined exactly what apparatus and method steps were involved in playing the previously known version of the REVELATION™ game, as compared to appellant's improved version thereof, and that consequently any understanding of that prior art game involves a degree of speculation which we find unacceptable. Given the lack of an adequate factual basis to support the examiner's conclusion of obviousness with regard to claim 16 on appeal, especially the last two steps thereof, we will not sustain the rejection of this claim under 35 U.S.C. § 103. We will likewise not sustain the rejection of claims 17 through 20, which depend from independent claim 16, under 35 U.S.C. § 103.

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As should be apparent from the foregoing, the decision of the examiner rejecting claims 1 and 3 through 20 of the present application under 35 U.S.C. § 103 is reversed.

REVERSED

JAMES M. MEISTER	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
BRADLEY R. GARRIS	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
	)	
	)	
	)	
CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	

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Beehler & Pavitt  
100 Corporate Pointe  
Culver City, CA 90230