

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ROGER J. LENKOFF

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Appeal No. 1998-2386  
Application No. 08/757,749<sup>1</sup>

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HEARD: November 18, 1999

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Before COHEN, ABRAMS, and GONZALES, Administrative Patent Judges

GONZALES, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the examiner's refusal to allow claims 1 through 8, as amended subsequent to the final rejection. Claim 9, the only other claim in the application,

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<sup>1</sup> Application for patent filed November 26, 1996.

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has been allowed (see Paper No. 10).

We REVERSE.

The subject matter on appeal is directed to a combined sticker and invisible ink game including a booklet [3] having at least one sheet containing an overall image printed thereon, the overall image including a first visibly printed portion [9] and a continuous second invisibly printed portion [11], a contact pen [7] for developing the invisible image portion to a visible image, and a third visible image portion [17], e.g., a sticker, which can be located and associated with the developed second overall image portion [11].

A copy of the appealed claims is appended to the Brief (Paper No. 13).

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

Engel et al. (Engel)	4,714,275	Dec. 22,
1987		
Kawashima	5,215,956	Jun.
01, 1993		

Claims 1 through 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Engel in view of Kawashima.

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The full text of the examiner's rejection and the responses to the arguments presented by appellant appear in the Answer mailed March 10, 1998 (Paper No. 14), while the complete

statement of appellant's arguments can be found in the Brief filed February 17, 1998 (Paper No. 13).

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 conclude that the

§ 103 rejection cannot be sustained.

Claim 1, the only independent claim, calls for an association and location identification game comprising: at least one sheet of material having a first portion of less than an overall image visibly printed thereon and "a second portion physically associated as a continuity with said first

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portion of said overall image forming part thereof to assist in completion of said overall image invisibly printed thereon as a latent image"; marking means for developing the second latent image portion; and a compatible visible image third portion to be selected and movably associated with the developed second image portion.

In rejecting claims under 35 U.S.C. 103 the examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met does the burden of coming forward with evidence or argument shift to the applicant. Id. If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In order to establish the prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 985, 180 USPQ 580, 583

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(CCPA 1974). Appellant argues (Brief, pages 3 and 4) that Engel and Kawashima, taken alone or in combination, neither teach nor suggest a sheet of material having a first portion of less than an overall image visibly printed thereon and a second portion physically associated as a continuity with the first portion of the overall image forming part thereof to assist in completion of the overall image invisibly printed on the sheet of material as a latent image and

a compatible visible image third portion to be selected and movably associated with the developed second image portion.

The examiner, on the other hand, maintains that Engel teaches a game book containing at least one sheet [18, Figure 2] having a character or first image "portion" [20] and a plurality of half tone images or second image "portions" [24, Figure 7] printed in areas [22] which "may be broadly interpreted as a continuity with the first portion" and a sticker or third image "portion" [12, Figures 3 and 4] which the examiner contends is "broadly physically associated" with the first image "portion" [20] (Answer, page 5).

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Claim 1 calls for "a first portion of less than an overall image visibly printed" on a sheet of material and a "second portion physically associated as a continuity with said first portion of said overall image forming part thereof to assist in completion of said overall image invisibly printed [on the sheet of material] as a latent image" (emphasis added). While it is true that claims are to be given their broadest reasonable interpretation in proceeding before the PTO, this interpretation must be consistent with the specification and construed as those

of ordinary skill in the art would construe them. See In re Bond, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990); Specialty Composites v. Cabot Corp., 845 F.2d 981, 986, 6 USPQ2d 1601, 1604 (Fed. Cir. 1988) and In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). Here, we believe one of ordinary skill in the art would interpret the "physically associated as a continuity with said first portion of said overall image forming part thereof to assist in

completion of said overall image" language of claim 1 as requiring that the second image portion be a continuous or uninterrupted part of the overall image.<sup>2</sup> While we appreciate that Engel's disclosure is highly relevant to the game set forth in appellant's claims, it is our view, based on the above interpretation, that the half tone images [24] of Engel are not continuous or uninterrupted parts of the character [20] which assist in completion of the overall image. Instead, as Engel explains, the character [20] is a cartoon corresponding to the theme of the album (col. 2, lines 27-29) while half tone images [24] may be scenes in a story told in album [10] with each half tone image [24] being different from the other, but with each corresponding to a full color scene [26] printed on one of the various stickers [12] (id. at 34-40). The fact that the characters [20] and half tone images [24] are printed on the same sheet does not justify a finding that the characters [20] and half tone images [24] of Engel

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<sup>2</sup> The American Heritage Dictionary of the English Language (3rd ed. 1992) defines "continuity" as "1.The state or quality of being continuous. 2.An uninterrupted succession or flow; a coherent whole."

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satisfy the "continuity" and "assist in completion of said overall image" limitations of claim 1. The examiner's determination to the contrary is based on an unreasonable interpretation of the claim language, in our view.

While not mentioned in the examiner's explanation of the rejection, we note that Engel does teach that the sheet [18] also includes a drawing [66] which "may also be a picture with portions obscured by a pattern 30 and by using viewer portion 42, the child can see the complete picture" (col. 6, lines 12-15). However, Engel does not teach or suggest a third portion, e.g., a sticker, which is selected and movably associated with the obscured image portion of drawing [66].

We have also reviewed the Kawashima reference additionally relied upon by the examiner in the rejection of claims 1 through 8, but find nothing therein that makes up for the deficiencies of Engel discussed above.

Since all the claim limitations are not taught or suggested by the applied prior art, the examiner has failed to establish a prima facie case of obviousness. Accordingly, we will not sustain the standing § 103 rejection of claims 1

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through 8.

The decision of the examiner is reversed.

REVERSED

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

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