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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* COLIN HIGBIE

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Appeal 2015-005506  
Application 13/922,491  
Technology Center 3700

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Before EDWARD A. BROWN, RICHARD H. MARSCHALL, and  
FREDERICK C. LANEY, *Administrative Patent Judges*.

BROWN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Colin Thigbie (Appellant)<sup>1</sup> appeals under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 46–49. Appeal Br. 6.<sup>2</sup> We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

CLAIMED SUBJECT MATTER

Claim 46, reproduced below, is representative of the claimed subject matter.

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<sup>1</sup> The Appeal Brief identifies Appellant as the real party in interest. Appeal Br. 4.

<sup>2</sup> Claims 1–32 have been cancelled, and claims 33–45 and 50–52 withdrawn from consideration. Appeal Br. 7.

46. An attack and defend interaction card system comprising:  
an attack card comprising:  
an illustration of an attack object;  
a quantity of interaction data having data values of the attack object; and  
at least one window positioned through the attack card; and  
a defend card comprising:  
an illustration of a defending object; and  
a quantity of interaction data having a plurality of data values of the defending object, wherein the plurality of data values are spatially arranged on a surface of the defend card; and  
an interaction card comprising an interaction data portion having a quantity of numerical cross-interaction data;  
wherein the attack card is stacked on top of the defend card, wherein at least one of the data values of the defend card is visible through the at least one window of the attack card, and wherein the interaction card is positioned beside the stacked attack and defend cards, wherein the numerical cross-interaction data is in alignment with the at least one data value of the defend card and the at least one window of the attack card.

Appeal Br. 27–28.

#### REJECTION

Claims 46–49 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Black (US 5,435,568, issued July 25, 1995) and Conger (2,652,635, issued Sept. 22, 1953).

#### ANALYSIS

As to claim 46, the Examiner finds Black discloses a defend card 32, an attack card 20, 30, 34, and an interaction card 28, but not that the attack card comprises “at least one window positioned through the attack card.” Final Act. 3 (citing Figs. 2–6). The Examiner relies on Conger in relation to this missing feature in Black. *Id.* at 4 (citing Figs. 4, 5). The Examiner

concludes that it would have been obvious to modify Black's attack card to include a window, as taught by Conger. *Id.*

The Examiner construes the "wherein clause" recited in claim 46 as defining "the function/method of playing the game." *See* Final Act. 5 (italics omitted); *see also* Ans. 8. The Examiner finds that "[w]ith respect to *the method of playing the game*," the modified structure of Black "is *fully capable of performing the same function* as claimed, since his device is equipped with the same features as the claim[ed] subject matter." *Id.* at 4 (emphases added). The Examiner also indicates that "*the apparatus/system claims are being examined based on their structure and none of the limitations regarding the function/method of playing the game is given any patentability weight.*" *Id.* at 5.

Appellant contends, *inter alia*, that the claimed wherein clause limitation is not a "functional" limitation as "it contains no steps, actions, or functions of the cards, nor does it define what the cards do, nor does it define any capability or purpose of the cards." Appeal Br. 18. Rather, the claim limitation "defines specific alignments of the cards in static positions relative to one another." *Id.*

We agree with Appellant that the Examiner has improperly construed the claimed wherein clause. Claim 46 is directed to "[a]n attack and defend interaction *card system*" (emphasis added), and not to a method of playing a card game. Claim 46 recites that "the attack card *is stacked on top of* the defend card," and "the interaction card *is positioned beside* the stacked attack and defend cards." (Emphasis added). The wherein clause does not recite terms, such as, for example, "stackable" or "positionable" that can be construed as functional. Based on the recitation of the limitations "is

stacked on top of” and “is positioned beside,” we agree with Appellant that the wherein clause defines alignments of the attack card, defend card, and interaction card relative to one another, and not functions of these cards. These claimed specific physical alignments of the attack card, defend card, and interaction card relative to one another define structural limitations of the card system.

The Board “determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (citing *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)). Here, we note that the alignments of the attack card, defend card, and interaction cards relative to each other recited in the wherein clause correspond identically to the static alignments of the interaction card 900 (“attack card”), cross-interaction card 1000 (“defend card”), and interaction card 1100 (“interaction card”) relative to each other, shown in Figure 12 of Appellant’s application. *See also* Spec. para. 141–145. We also note paragraphs 144–145 of the Specification describe the alignments of the cards shown in Figure 12 with language that is similar to, and consistent with, the language of the wherein clause. Accordingly, Appellant’s construction of the claimed “wherein” clause is supported by this description.

Appellant also asserts, “since the noted claim passage is non-functional, the Examiner’s rejection based on Black being capable of meeting the claimed requirements [] is erroneous.” Appeal Br. 18.

We agree with Appellant. According to the Examiner, “[t]he structural limitations are merely *two cards* which the applied art teaches.” Ans. 8 (emphasis added). However, this statement appears to indicate the Examiner incorrectly considered only two of the three different claimed cards as a structural limitation. Also, the Examiner incorrectly failed to give the structural limitations of the wherein clause *any* patentable weight. *See* Final Act. 5. The Examiner’s erroneous claim construction led to further errors. For example, the Examiner fails to articulate an adequate reason with some rational underpinning for modifying Black’s “attack card” (i.e., land unit card 20, naval card 30, and assault card 34) to include a window, and then further modifying Black’s “attack card,” “defend card” (i.e., fortification card 32), and “interaction card” (i.e., personality card 28) to result in the specific structural alignments of the attack card, defend card, and interaction card relative to one another as required by the proper construction of the “wherein” clause.

We do not sustain the rejection of claim 46, and claims 47–49 depending therefrom, as unpatentable over Black and Conger.

#### DECISION

The Examiner’s decision to reject claims 46–49 is REVERSED.

REVERSED