

DECISION OF THE COMMISSIONER

- (1) STATUTORY - S. 2d: New arrangement of Printed or Design Matter.
- (2) OBVIOUS: Arrangement of Printed Matter Met by Prior Art.
- (1) A new arrangement of printed matter is statutory if it subserves some functional limitation in a combination as opposed to solely its intellectual, literary or artistic connotations.
- (2) The arrangement of printed matter is shown in the prior art and any difference is solely in the meaning to be given the respective indicia.

FINAL ACTION: Affirmed in part

IN THE MATTER OF a request for a review by the Commissioner of Patents of the Examiner's Final Action under Section 46 of the Patent Rules.

AND

IN THE MATTER OF a patent application serial number 040,799 filed January 22, 1969 for an invention entitled:

GAME

Agent for Applicant

Messrs. Gowling & Henderson
Ottawa, Ontario.

This decision deals with a request for review by the Commissioner of Patents of the Examiner's Final Action dated May 3, 1971 refusing to allow application 040,799.

Application 040,799 was filed on January 22, 1969 in the name of Allan Cowan and refers to a "Game".

In the prosecution terminated by the Final Action the examiner refused the single claim on two grounds. First, the claim is directed to a game piece whose structure is simply an equilateral triangle met by the prior art; and secondly, the claim describes printed matter which is unpatentable, and the use of the game piece in playing the game is also unpatentable.

In the Final Action the examiner applied the following references:

United States Patents		
1,564,443	Dec. 8, 1925	Rabold
647,814	Apr. 17, 1900	Dorr
487,797	Dec. 13, 1892	Thurston

The examiner maintained the stand that the game piece in which the structure is simply an equilateral triangle is not patentable especially in view of the Rabold and Dorr patents. He also maintained that the printed matter is unpatentable. In this action the examiner stated:

British courts have consistently rejected printed matter as suitable subject matter for a patent, and that is the policy of the Canadian Patent Office. The "Clusters of numbers" which the applicant stresses as novel are obviously nothing more than printed matter, just as the indicia on the single game piece of the claim are printed matter.

As pointed out in the Office Action of March 16, 1971, the applicant's arrangement of indicia is, in any case, a mere design change with some advantages and some disadvantages, as pointed out in the case of a plurality of players surrounding the game location. The location of the indicia near the corners of the triangular game pieces follows the usual domino concept of placing the indicia adjacent the mating edges.

The rejection of the claim, and of the application, is therefore repeated on both grounds, i.e. that changes in printed matter to facilitate a method of playing a game do not add patentability to an old structural element, and that the differences defined herein are merely design differences which do not constitute patentable invention over the applied references.

In applicants response to the Final Action, dated August 3, 1971, he states:

Under British law, it is established that arrangements of printed matter are patentable where the arrangement serves a mechanical purpose. See, for example, Cooper's Application 19 R.P.C. 53, Fishburn's Application 57 R.P.C. 245, and Alderton's Application 59 R.P.C. 56 at 59; these cases are referred to on page 24 of "Patent for Inventions" (3rd Edition) by T.A. Blanco-White. One mechanical purpose which has been accepted as giving patentable utility is where an arrangement of printed matter on cards allows the cards to be used together in a game so as to cooperate in a synergistic manner. (Cobianchi's Application 1953 70 R.P.C. 199).

Applicant has explained in detail throughout the prosecution of this application that a new result is achieved by the unique arrangement disclosed in applicant's specification and claimed in applicant's only remaining narrowly drawn claim. As indicated in Figure 3 of the applicant's drawing, a cluster of numbers presented by the game pieces shown therein can be aligned to read radially outwardly from the meeting point of the several game pieces. Also, as indicated in Figure 5, the numbers can be aligned to read from a common direction. Each of these numerical arrangements would have functional significance during the course of a game. However, such a variance in arrangements is only possible due to the placement of the Arabic numbers in the corner most tips of the triangular game pieces with the alignment of all the numbers of each piece to read only from one direction.

The applicant believes that the synergistic interaction of the game pieces embodied within the applicant's invention falls within the definition of patentable subject matter referred to on page 24 of the fourth edition of Canadian Patent Law and Practice, by Fox, and further defined by the decision in Cobianchi's case.

Additionally, applicant strenuously asserts, that, since the differences between the applicant's arrangement and the prior art are precisely the differences which permit applicant's arrangement to achieve a new result, unobtainable by the prior art, such differences cannot be merely of a design nature but are functional in the art to which the invention pertains. Such a functional nature is not so apparently utilitarian in the game art as it would be in the industrial machine arts; nevertheless, the utilitarian nature and the synergistic functioning of the applicant's arrangement are clear.

After reviewing the grounds for rejection set forth by the examiner, as well as the arguments set forth by the applicant, I am satisfied that the rejection is well founded on one of the grounds but not the other.

The application refers to a "Game". Claim 1 reads as follows:

A game piece comprising a planar body configured as an equilateral triangle to define three acutely angular corner positions, a face surface of said body being marked with three Arabic numeric indicia, one of each said indicia being disposed in one of each of said corner positions, all of said indicia being alligned in the same direction to orient the same for reading thereof from a common location, each of said indicia being disposed wholly within a cornermost location

immediately adjacent a tip edge of said triangle, the overall area of said face surface being several times larger than the sum of the areas displaying said indicia to define unmarked areas along each edge of said body between two of said indicia located at opposite terminal ends of said edge, said unmarked areas being several times larger than the sum of the areas displaying said two indicia, whereby several of said game pieces are operable to visually completely isolate a variety of cluster-like geometric patterns in response to the positioning of the indicia of one piece immediately adjacent matching indicia of another piece in accordance with game rules.

The consideration of prime importance to the outcome of this decision is the question of invention with respect to an arrangement of printed matter, on which the Final Action is predicated.

I find that the position of the examiner needs some clarification. The examiner stated that British Courts have consistently rejected printed matter as suitable subject matter for a patent. The examiner should have referred to "... mere printed matter". Under British law it is well established that a new arrangement of printed or design matter may form the subject matter of a patent if it performs a mechanical function or purpose in consequence of use. That is, if novelty lies solely in the meaning of printed words or the aesthetic appeal of printed or design matter, it is not considered patentable subject matter.

Therefore, I am satisfied that if a new arrangement of printed matter imports some functional limitation in a combination so as to produce a synergistic result, which is useful in some practical way, as opposed to intellectual, literary or artistic connotations, it may be considered as suitable subject matter for a patent.

The examiner has also refused the claim and the application on the grounds that the patents to Rabold and Dorr both show game pieces having the same structure including indicia thereon, stating that a change in indicia is a mere design change.

The patent to Rabold discloses a triangular piece with different colored indicia on each corner plus numeric indicia on one of the corners. The patent to Dorr shows triangular pieces with different indicia in the form of different numbers of dots in the respective corners. I find the structure of the game piece is met by this prior art.

Applicant has discussed different points as indicating an improvement over the cited prior art. With respect to these points the patent to Thurston shows playing pieces with indicia in the form of numbers in various locations, and a plurality of

pieces when assembled having all numbers readable from a common direction. Also in the disclosure of the patent to Rabold, page 2, line 20 reads, "... the three corners of each common piece are colored or otherwise made identifiable to indicate different principal activities ...". The otherwise referred to could cover numeric and other forms of indicia. This patent also refers to bonus scores, page 3, line 7 reads, "... sixteen pieces, each having a similar colored corner may justify 125 points ...". The patent to Dorr shows a change in the indicia of separate pieces to cover many variations.

I note that the physical arrangement of the indicia in this application is the same as that disclosed in the patent to Rabold, and thus the only basic difference over this reference is in the form of indicia used, which forms are shown in the other references. As a matter of interest, if the claim of the application was changed to read colored indicia instead of numeric indicia, the subject matter of the claim would read substantially on the patent to Rabold.

In view of the above and the previous discussion on the patentability of printed matter, I am satisfied that no new arrangement of printed matter is disclosed and any difference lies solely in the meanings that may be given to the indicia which depends on the rules of games to be played. It is well established that rules of play may not be used to substantiate invention.

I am satisfied that the particular layout may be meritorious, but I fail to see that it merits the distinction of invention or claim to a patent monopoly. Therefore I recommend that the decision of the examiner, to refuse the claim and the application as met by the prior art, be upheld. However, I also recommend that the ground of rejection with respect to lack of patentable subject matter in reference to all printed matter, be withdrawn.

R.E. Thomas,
Chairman, Patent Appeal Board.

I concur with the decision of the Patent Appeal Board and refuse the grant of a patent. The applicant has six months in which to appeal this decision in accordance with Section 44 of the Patent Act.

Decision accordingly,

A.M. Laidlaw,
Commissioner of Patents.

Dated at Ottawa, Ontario
this 13th day of October 1971.