

DECISION OF THE COMMISSIONER

STATUTORY: New Arrangement of Printed or Design Matter

UNOBVIOUS: In view of Several Citations

A new arrangement of printed or design matter which imparts functional limitations as on the elements of a true combination, and which does not rely for novelty solely on the intellectual connotations of the printed or design matter, may be patentable.

The Commissioner was satisfied that the prior art did not suggest the particular arrangement of claimed subject matter.

FINAL ACTION: Reversed; Directed policy changed.

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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 055,210 filed June 24, 1969 for an invention entitled:

GOLF GAME

Agent for Applicant

Messrs. Smart & Biggar  
Ottawa, Ontario.

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This decision deals with a request for review by the Commissioner of Patents of the Examiner's Final Action dated July 27, 1971 on application 055,210. This application was filed in the name of Louis Boileau and refers to "Golf Game".

In the prosecution terminated by the Final Action the examiner refused to allow the application and the grounds for refusal are:

- (a) That the disclosure of this application is directed to a game without restriction to any novel structural features. Games and game boards which do not involve novel structures are unstatutory matter, and (b) that the subject matter disclosed does not involve any inventive step over the following applied references.

The references applied are as follows:

United States Patents:		
1,529,598	Mar. 10, 1925	Lee
1,638,365	Aug. 9, 1927	Ryan
2,180,049	Nov. 14, 1939	Hall

In this action the examiner stated: (in part)

The Ryan reference describes a similar game wherein sets of dice are used instead of the single die used in Lee's game, and as in the present game a different die is used for different shots. Also, Ryan provides for both premiums and penalties, as in the present game, rather than penalties only, as in Lee.

The sole concept not shown, by either Lee or Ryan lies in the separate sets of indicia adjacent the tee and the green respectively, the sets being visually distinguishable from each other. However, there is no defined cooperation between these sets of indicia other than that provided by the players in placing play pieces in accordance with the rules of play. Such an arrangement per se is shown in the Hall reference, in any case. While it is conceded that a true combination may not be rejected on the basis of a mosaic of references, it is held that no such combination is disclosed herein. A game board which has no cooperating mechanical elements, but only an arrangement of printed matter, is not patentable merely because no single prior reference shows all of the features claimed. A design registration may be made of such subject matter, but a patent may not be obtained. It is held that no inventive ingenuity is involved in combining well known features of prior art game boards into an arrangement of printed matter merely because it is different from any single reference.

In applicant's response of October 26, 1971 he stated: (in part)

The present invention is directed to a novel game which includes the combination of three components which cooperate to produce a unitary result, namely a game board having a particular marking thereon, game pieces adapted to be moved manually in a unique manner, and a plurality of dice which are adapted to cooperate with the game board to provide a unitary result.

Applicant also objected to the ground that the invention is not directed to a novel and proper combination in that he maintains the claims refer to a true combination producing a unitary result. Applicant also expressed the view that he is not claiming the golf course simulation and indicia in the form of printed matter nor is he claiming the method of playing the

game. Applicant also maintained that the element of a combination need not cooperate in a mechanical way to produce a unique result and finally the applicant strongly objected to the stand of the examiner with respect to lack of an inventive step over the prior art.

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

A golf game, comprising the combination of the following elements:

- (a) a game board laid out as a scaled-down facsimile replica of a "real" golf course and including thereon two sets of indicia disposed adjacent the tee and the green respectively, the indicia in each set being visually distinguishable from each other, the indicia of each set having a common characteristic which renders them visually distinguishable from the indicia of the other set, thereby to provide a plurality of positively premarked and predetermined positions representative of the positions of a golf ball during "real" play of the game of golf, and designating unique positions for the disposition of all game pieces;
- (b) game pieces representative of golf balls adapted to be moved manually to be disposed at a unique directed one of said plurality of positively premarked and predetermined positions on said game board in a manner analogous to that of the disposition of golf balls during the "real" play of the game of golf; and
- (c) a plurality of dice, each die bearing indicia on the faces thereof different from those on conventional dice but being identical with those of a different one of said sets of indicia on said game board, the casting of a single selected die directing the manual placing of the game pieces to a position which is representative of a "real" golf stroke.

Having considered the first ground of rejection; "the disclosure of this application is directed to a game without restriction to any novel structural features", I find that this stand was generally in conformance with Patent Office guidelines at the Final Action was written. However, it has since been decided 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. Therefore, under the circumstances, this is not a proper ground of rejection since I am satisfied that if a new arrangement of

printed matter imports some functional limitation in a combination so as to produce a unitary result, which is useful in some practical way, as opposed to solely intellectual, literary or artistic connotations, it may be considered as suitable subject matter for a patent.

The second ground of rejection is based on the premise that the subject matter disclosed does not involve any inventive step over the cited prior references. First, I find that applicant has claimed the subject matter in a true combination and it is clearly established that the essence of any patentable combination may reside in the combination itself, and not in the individual elements of which it is composed. The focus of attention must be directed to the whole, and not to the parts.

In line with this I find the examiner has not applied a basic reference, that is, a reference which substantially teaches the subject matter as claimed. The reference to Lee does not disclose, "a game board which includes two sets of indicia disposed adjacent the tee and the green respectively, the indicia in each set being visually distinguishable from each other". Further, Lee does not, "provide a plurality of dice, each die bearing indicia on the faces thereof different from those on conventional dice but being identical with those of a different one of the sets of indicia on the game board".

The reference to Tyan does not include, on his game board, "two sets of indicia disposed adjacent the tee and the green respectively". Ryan does not disclose, "a plurality of dice, each die bearing indicia on the faces thereof different from those on conventional die but being identical with those of a different one of the sets of indicia on the game board." Furthermore, the dice are used in sequential order as opposed to that disclosed by Ryan where the three dice are used at the same time.

The examiner stated that the sole concept not shown by either Lee or Ryan lies in the separate sets of indicia adjacent the tee and the green respectively, the sets being visually distinguishable from each other. It is true that Hall shows two sets of indicia, however, these are really the same type of indicia except one is measured in yards from the tee and the other measured in yards from the green. Therefore, I am of the opinion that this is not equivalent to the separate sets of indicia used in the present application. It is also noted that different sets of dice are used by applicant for the different indicia, whereas in Hall the same set of dice is used in continual play for each set of indicia which also indicates the indicia is substantially the same.

I am satisfied that the references do not suggest the particular arrangement of claimed subject matter. I also find that applicant is not relying solely on the intellectual connotations of the printed matter for novelty since the form of play restrictions in the claims imparts a functional cooperation of the elements in the combination.

I recommend that the decision of the examiner, to refuse the application on the grounds stated, be withdrawn.

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

I concur with the findings of the Patent Appeal Board and withdraw the Final Action and return the application to the examiner for resumption of prosecution.

Decision accordingly,

A.M. Laidlaw,  
Commissioner of Patents.

Dated at Ottawa, Ontario,  
this 22nd day of December,  
1971.