

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEROME H. LEMELSON

Appeal No. 2000-2232
Application 08/483,928

HEARD: January 23, 2002

Before HAIRSTON, KRASS, and FLEMING, **Administrative Patent Judges**.

FLEMING, **Administrative Patent Judge**.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 21-37, all of the claims pending in the present application.

Claims 1-20 have been canceled.

The invention relates generally to a portable camera and recording unit capable of recording motion pictures and still

image signals, and still images on hard copies¹. In particular, the portable unit (figure 2, item 10) comprises a hand-held, box-like housing (figure 2, item 11) supporting a camera (figure 1, item 32), a video recorder and reproduction device (figure 1, item 24), a video-signal display unit (figure 1, item 27), and a printer (figure 5, item 80; specification, page 26). The portable unit also includes a manually operated selection switch (figure 5, item 82) which couples either the camera output or the video recorder and reproducer output to the video-signal display unit, and a manually operated printing trigger (figure 5, item 80c).

Independent claim 21 is reproduced as follows²:

21. A portable video unit comprising:

(a) a hand-held, box-like housing supporting:

(i) a camera having an output for electrical video

¹Specification, page 1, lines 2-5.

²We note that the copy of claim 28 in Appellant's Appendix A is incorrect as it does not contain the changes made in Appellant's Amendment C (paper no. 9). In subparagraph (c) of this claim, at line 1 the words "manually operated" are not deleted, and the words "by a camera operator" are not inserted after the word "activated". Our decision considers this claim as presented in Amendment C and not as set forth in Appellant's Appendix A.

picture signals representative of image phenomena
occurring outside said housing,

(ii) a video recorder and reproduction device
electrically coupleable to the output of the
camera and

having an output for picture signals reproduced from a
record member supported in said housing,

(iii) a video-signal display unit including a
display screen viewable from the exterior of said
housing, and

(iv) a printer electrically coupled to the video
recorder and reproduction device;

(b) a manually operated selection switch having two
positions, wherein, without operating any other
switch, in the first position, the video-signal display
unit is coupled to the output of said camera and, in the
second position, the video-signal display unit is coupled to
the output of said video recorder and reproduction
device; and

(c) a manually operated printing trigger that, when in a
predetermined position, causes the printer to output a
hard copy of the image displayed on the screen.

The Examiner relies on the following references:

Lemelson	3,943,563	Mar. 9, 1976
Munsey	4,057,836	Nov. 8, 1977
Camras	4,097,893	Jun. 27, 1978
Kimura	4,507,686	Mar. 26, 1985
Lemelson	4,604,668	Aug. 5, 1986
Lemelson	4,819,101	Apr. 4, 1989

Claims 21-37 stand rejected under the judicially created

Appeal No. 2000-2232
Application 08/483,928

doctrine of obviousness-type double patenting over claims 1-22 of Lemelson 4,819,101 (hereinafter "Lemelson '101") in view of Lemelson 3,943,563 (hereinafter "Lemelson '563").

Claims 21, 23-28, 30 and 32-37 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-19 of Lemelson 4,604,668 (hereinafter "Lemelson '668") in view of Lemelson 3,943,563 (hereinafter "Lemelson '563").

Claims 21-23, 25-28, 30-32 and 34-37 stand rejected under 35 U.S.C. § 103 as being unpatentable Lemelson '563 in view of Camras and Kimura.

Claims 24, 29 and 33 stand rejected under 35 U.S.C. § 103 as being unpatentable Lemelson '563 in view of Camras and Kimura and Munsey.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Brief³, Reply Brief⁴ and the

³ The Brief was received October 18, 1999.

⁴ The Reply Brief was received April 3, 2000.

Appeal No. 2000-2232
Application 08/483,928

Examiner's Answer⁵ for the respective details thereof.

OPINION

A. Rejection of claims 21-37 under the judicially created doctrine of obviousness-type double patenting over claims 1-22 of Lemelson '101 in view of Lemelson '563

We will not sustain the rejection of claims 21-37 under the judicially created doctrine of obviousness-type double patenting over claims 1-22 of Lemelson '101 in view of Lemelson '563.

The Examiner has failed to set forth a *prima facie* case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983).

Appellant argues⁶ that both the '101 and '563 patents to Appellant lack the claimed feature of supporting a printer in

⁵ The Examiner's Answer was mailed January 18, 2000.

⁶ Brief, page 14.

a common housing. In addition, Appellant cites⁷ the Examiner's statement⁸ "The proposed obviousness-type double patenting rejection over the claims of the parent '101 patent in view of Lemelson '563 does not teach or suggest the claimed features of supporting the printer in a common housing."

Appellant then asserts⁹ that the sole motivation asserted by the Examiner¹⁰ is that one of ordinary skill in the art at the time of the invention would have thought to add the printer "so that hard/copies can be given to friends and relatives for memory." Appellant states that this motivation has two problems: First, that the proposed motivation would not motivate one to include the printer in the same housing, as a printer coupled remotely would have sufficed. Second, that the Examiner merely identifies a benefit of the claimed invention, which militates in favor of patentability, rather than a motivation that the Examiner has proven was known to

⁷ Reply Brief, page 5.

⁸ Answer, page 22.

⁹ Reply brief, page 5.

¹⁰ Answer, pages 6 and 9.

ordinary skilled artisans without hindsight and would have caused such a person naturally to combine known references.

The Examiner admits¹¹ that claims 1-22 of the '101 patent do not disclose, *inter alia*, a printer electrically coupled to the video recorder and reproducing device, or a manually operated printing trigger that causes the printer to output a hard copy of the image displayed on the screen as recited in claims 21, 28 and 32. The Examiner then points¹² to Lemelson '563 for its teaching of a system for recording and reproducing video information having a printer (111) electrically coupled to the video recorder and reproduction device, and a manually operated printing trigger that causes the printer to output a hard copy of the image displayed on the screen. The Examiner then finds that it would have been obvious to one of ordinary skill in the art at the time of the invention to provide claims 1-22 of the '101 patent with the printer to output a hard copy of the image displayed on the screen so that the hard copy "can be given to friends and

¹¹ Answer, page 5.

¹² Answer, page 6.

relatives for memory".

In addition, the Examiner admits¹³ that this rejection over the claims of the parent '101 patent in view of Lemelson '563 does not teach or suggest the claimed feature of supporting a printer in a common housing. However, the Examiner asserts that whether or not the printer and printing trigger of '563 are included in the housing of '101, is merely a well known design option obvious to one of ordinary skill in the art, because maintaining parts fixed together as a single unit provides no significant functional or patentable differences.

Turning first to Appellant's claims 21, 28 and 32, we find that these claims expressly recite limitations directed to a hand-held, box-like housing"¹⁴ which supports a camera, video recorder/reproduction device, and a printer¹⁵. We agree with Examiner's finding that the proposed obviousness-type

¹³ Answer, page 22.

¹⁴ Claim 21, subsection (a); claim 28, subparagraph (a); claim 32, subparagraph (a).

¹⁵ Claim 21, section (a), subparagraph (iv); claim 28, subparagraph (h); claim 32, subparagraph (a).

double patenting rejection over the claims of the parent '101 patent in view of Lemelson '563 does not teach or suggest the claimed features of supporting a printer in a common housing.

We find that the Lemelson '563 patent is directed to¹⁶ a method for recording a large quantity of information of image frame phenomena, such as document recording in a form which is easily recorded though not visually monitorable as recorded. Its controls are operated from a console (45) and there is no teaching that the system is portable or mounted in a unitary housing. This apparatus and its use thus differs substantially from Appellant's claimed invention which is directed to a hand held portable video unit which supports a camera, video recorder/reproduction device, and a printer.

We find that the Examiner's statement of the motivation to combine the disclosed claims 1-22 of the '101 patent with the '563 printer being that a hard copy can be given to friends and relatives for memory is without basis from express teachings or suggestions found in the prior art, or by

¹⁶Column 1, lines 59-63.

Appeal No. 2000-2232
Application 08/483,928

implications contained in such teachings or suggestions. There is absolutely no suggestion in the prior art of the desirability of the Examiner's proposed modification. Furthermore, we agree with Appellant that the proposed motivation would not motivate one to include the printer in the same housing, as a printer coupled remotely would have sufficed.

We similarly find the Examiner's conclusory statement that including a printer in the housing of '101 is merely a well known design option obvious to one of ordinary skill in the art because maintaining parts fixed together as a single unit provides no significant functional or patentable differences, to be without basis from express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. Again, there is absolutely no suggestion in the prior art of the desirability of the Examiner's proposed modification.

The Federal Circuit states that "[t]he mere fact that the

Appeal No. 2000-2232
Application 08/483,928

prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." **In re Fritch**, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n. 14 (Fed. Cir. 1992), citing **In re Gordon**, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). However, "[o]bviousness may not be established using hindsight or in view of the teachings or suggestions of the invention." **Par Ordnance Mfg. v. SGS Importers Int'l**, 73 F.3d at 1087, 37 USPQ2d at 1239, citing **W. L. Gore & Assocs., Inc. v. Garlock, Inc.** 721 F.2d at 1553, 220 USPQ at 312-13.

In addition, the Federal Circuit has recently stated "This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority." It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." **W.L. Gore v. Garlock, Inc.**, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983)." **In re Lee**, ____

Appeal No. 2000-2232
Application 08/483,928

F.2d _____, _____, _____ USPQ _____ , _____ (Fed. Cir.
2002)(Appeal no. 00-1158).

We therefore agree with Appellant that the Examiner has failed to set forth a **prima facie** case. The Examiner must establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. The references of record fail to provide express teachings or suggestions to make the combinations suggested by the Examiner.

Therefore, we will not sustain the rejection of claims 21-37 under the judicially created doctrine of obviousness-type double patenting over claims 1-22 of Lemelson '101 in view of Lemelson '563.

B. Rejection of claims 21, 23-28, 30 and 32-37 under the judicially created doctrine of obviousness-type double patenting over claims 1-19 of Lemelson 4,604,668 in view of Lemelson 3,943,563

Claims 21, 23-28, 30 and 32-37 stand rejected under the judicially created doctrine of obviousness-type double

Appeal No. 2000-2232
Application 08/483,928

patenting over claims 1-19 of Lemelson '668 in view of
Lemelson '563.

Appellant's arguments¹⁷ in regard to this rejection are substantially the same as those presented by Appellant for the rejection of claims 21-37 under the judicially created doctrine of obviousness-type double patenting over claims 1-22 of Lemelson '101 in view of Lemelson '563. These arguments have been discussed in section "A" above.

Similarly, the Examiner's arguments¹⁸ in regard to this rejection are substantially the same as those presented by the Examiner for the rejection of claims 21-37 under the judicially created doctrine of obviousness-type double patenting over claims 1-22 of Lemelson '101 in view of Lemelson '563. These arguments have been discussed in section "A" above.

As claims 1-19 of the '668 patent do not teach the hand-held box-like housing which supports the printer as set forth in all of the independent claims, our reasoning and findings

¹⁷ Brief, pages 25-26.

¹⁸ Answer, pages 25-26.

set forth in section "A" apply equally to this rejection.

Therefore, we will not sustain the rejection of claims 21, 23-28, 30 and 32-37 under the judicially created doctrine of

obviousness-type double patenting over claims 1-19 of Lemelson '668 in view of Lemelson '563.

C. Rejection of claims 21-23, 25-28, 30-32 and 34-37 under 35 U.S.C. § 103 as being unpatentable over Lemelson '563 in view of Camras and Kimura

Claims 21-23, 25-28, 30-32 and 34-37 stand rejected under 35 U.S.C. § 103 as being unpatentable Lemelson '563 in view of Camras and Kimura.

Appellant argues¹⁹ that the cited references do not meet the express limitations of each of the independent claims that a single hand-held, box-like housing supports a camera, a video recorder/reproducer and a printer. Appellant asserts that the '563 patent shows no housing at all and cites the

¹⁹ Brief, pages 4-5.

Examiner's admission²⁰ that the '563 patent does not specifically disclose that all elements are built on a portable video unit.

Appellant then argues that contrary to the Examiner's finding²¹ that one "skilled in the art would have no difficulty to build the camera . . . and printer of Lemelson in the portable housing in a manner as taught in Camras . . . ", Camras teaches just the opposite. Specifically, Appellant points to Camras' hand-held recording unit²² which is in communication via a transmitter (250) to a separately housed video monitor (252) and tape recording unit (270). Appellant points out that Camras has no printer, and expressly²³ excludes the video recorder from being in the housing holding the camera, so that the camera may be readily carried without difficulty and that the camera station can be small, extremely light weight, and with a structure no larger than comparable

²⁰ Final rejection, page 11, lines 7-8.

²¹ Final rejection, page 14, lines 9-10.

²² Figure 1, item 260.

²³ Column 1, lines 19-48.

movie cameras.

In addition, Appellant argues²⁴ that Camras does not provide any motivation to combine a camera, display unit, and recording/reproduction device in a common housing.

In the rejection, the Examiner states²⁵ "It would have been obvious to one of ordinary skill in the art at the time of the invention to build all of the elements of Lemelson in a portable video recording unit in a manner as taught in Camras because Camras teaches an advantage of readily carrying about without difficulty with the portable video camera and such advantage being desirable to achieve efficient system operation in Lemelson."

In response to Appellant's arguments the Examiner asserts²⁶ that Camras teaches that "a portable camera can supporting [sic] a variety [sic] separate elements such as camera, receiver, indicating means, and a control circuit. From the teaching of Camras, one of ordinary skill in the art

²⁴ Brief, page 5.

²⁵ Answer, page 11.

²⁶ Answer, page 14.

would have no difficulty to build the camera . . . and the printer of Lemelson in the portable housing in a manner as taught in Camras in order to readily carry the apparatus of Lemelson without difficulty."

In addition, the Examiner finds²⁷ that "The artisan would have recognized the obviousness of carrying the apparatus of Lemelson without any difficulty by supporting the camera, the video recorder, the video-signal display unit and the printer in a common portable housing."

Finally, the Examiner argues that even if, arguendo, the proposed combination of the references does not teach the inclusion a printer in the camera housing, such inclusion is merely considered to be a well known design option obvious to one of ordinary skill in the art because maintaining parts fixed as a single unit provides no significant functional or patentable differences.

Turning to independent claims 21, 28 and 32, we agree with Appellant that the cited references do not meet the express limitation of each of these claims that a single hand-

²⁷ Answer, page 14.

held, box-like housing support a camera, a video recorder/reproducer and a printer. In addition, we agree with Appellant that Camras teaches away from the Examiner's proposed combination.

One important indicium of non-obviousness is "teaching away" from the claimed invention by the prior art. ***In re Dow Chemical Co.***, 837 F.2d 469, 473, 5 USPQ2d 1529, 1532 (Fed. Cir. 1988), ***In re Bell***, 991 F.2d 781, 784, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). Camras specifically divides his video recording system into a separate camera station (260) and a separate remote recorder/monitor station (270, 252) which use wireless communications²⁸. Camras states that such separate camera station may readily be carried about without difficulty²⁹, and that as a result of the arrangement the camera station may be small and extremely light weight³⁰. In addition, Camras teaches³¹ that the camera station takes the

²⁸ Column 3, lines 9-38.

²⁹ Column 1, lines 19-27.

³⁰ Column 1, lines 32-41.

³¹ Column 1, lines 41-61.

Appeal No. 2000-2232
Application 08/483,928

form of a single hand held structure no larger than a comparable movie camera, and that it is unnecessary to design the recording station as a continuously manually carried portable structure, but to design it for optimum performance.

Thus, we find that not only does Camras not provide any motivation to combine a camera, display unit, and recording/reproduction device in a common housing, but actually teaches one skilled in this art to the contrary.

We therefore agree with Appellant that the Examiner has failed to set forth a *prima facie* case. The Examiner must establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. The references of record fail to provide express teachings or suggestions to make the combinations suggested by the Examiner.

Therefore, we will not sustain the rejection of claims 21-23, 25-28, 30-32 and 34-37 under 35 U.S.C. § 103 as being

Appeal No. 2000-2232
Application 08/483,928

unpatentable Lemelson '563 in view of Camras and Kimura.

D. Rejection of claims 24, 29 and 33 under 35 U.S.C. § 103 as being unpatentable over Lemelson '563 in view of Camras and Kimura and Munsey

Claims 24, 29 and 33 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lemelson '563 in view of Camras and Kimura and Munsey.

First, we note that the Examiner has only cited Munsey for its disclosure of a digital memory³². Its application by the Examiner is irrelevant to the issues discussed above in regard to Camras, and it makes no disclosure as mounting of a video camera, recorder and printer.

Furthermore, these claims depend upon independent claims 21, 28 and 32 respectively, and contain limitations not relevant to our reasons for the reversal of the Examiner's rejection of the parent claims over Lemelson '563 in view of Camras and Kimura.

Therefore, we will not sustain the rejection of claims 24, 29 and 33 under 35 U.S.C. § 103 as being unpatentable over

³² Answer, page 13.

Appeal No. 2000-2232
Application 08/483,928

Lemelson '563 in view of Camras and Kimura and Munsey.

CONCLUSION

We have not sustained any of the rejections of claims 21-37. Accordingly, the Examiner's decision is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
ERROL A. KRASS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
MICHAEL R. FLEMING)	
Administrative Patent Judge)	

MRF:p99

Appeal No. 2000-2232
Application 08/483,928

Louis J. Hoffman
14614 N. Kierland Blv.
Suite 300
Scottsdale, Arizona 85254