

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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEOFFREY W. PETERS

Appeal No. 2002-1598
Application No. 09/596,975

ON BRIEF

Before ABRAMS, STAAB, and McQUADE, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 21-27 and 31-40, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to controlling toy vehicles. An understanding of the invention can be gained from a reading of exemplary claim 21, which has been reproduced below.

The single prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Booth <u>et al.</u> (Booth)	4,986,187	Jan. 22, 1991
-----------------------------	-----------	---------------

The examiner's rejections are as follows:

Claims 21-27 and 31-40 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention, i.e., new matter.

Claims 21-27 and 31-40 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Claims 21-27, 31-36, 39 and 40 stand rejected under 35 U.S.C. § 103 as being unpatentable over Booth in view of the Official Notice taken that using a controller such as a switch to control a vehicle/train is conventional.

Claims 37 and 38 stand rejected under 35 U.S.C. § 103 as being unpatentable over Booth and the Official Notice raised with regard to claim 21, taken further with Official Notice that providing an airwave link between two antennas is conventional.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 11) and the final rejection (Paper No. 6) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 10) and Reply Brief (Paper No. 12) for the appellant's arguments thereagainst.

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 make the determinations which follow.

The appellant's invention is directed to a method of controlling a toy vehicle. The invention is set forth in claim 21 in the following manner:

A method comprising:

receiving video from a toy vehicle;

automatically identifying an image element in said video; and

using said image element to automatically control the vehicle.

The Rejection Under The First Paragraph Of Section 112

This rejection is based upon the examiner's conclusion that the term "automatically," which was added to the claim during prosecution, constitutes new matter, and therefore the claimed invention was not in the possession of the appellant when the application was filed (Paper No. 6, page 2). The appellant argues in response that this is not the case, for "automatically" appears in two places in the specification as filed. The first is on page 7, where it is stated that the control of the vehicle "may be implemented by the user, physically or automatically, using software operating on the control station 24" (lines 21-24), and the second on page 10, where it is explained that the vehicle may "automatically go around the cones [in a racetrack] in response to processor-based system control which recognizes the cones and their locations" (lines 14-16). In response to this assertion in the Brief, the examiner further states in the Answer that while "automatically" appears in the specification, it does not provide support for automatically identifying an image element and automatically using it to control the vehicle, as stated in claim 21.

We find ourselves in agreement with the appellant that the presence of the disputed term in these two places provides the necessary support for the steps of claim 21. Specifically, it is explained on page 7 that the camera in the vehicle recognizes patterns and colors, from which the system can control the car manually or automatically, and on page 10 that it recognizes cones on a racetrack and controls the car to go around them. These instances clearly provide support for the two steps of the

method to which the examiner referred, and thus it is our conclusion that this is evidence that the disputed information was in the appellant's possession at the time the application was filed.

The rejection under 35 U.S.C. § 112, first paragraph is not sustained.

The Rejection Under The Second Paragraph Of Section 112

The examiner raises four matters in this indefiniteness¹ rejection. The first is that claim 21 is indefinite because it is not clear how "automatically" as now inserted in the claim "is intended to further limit the method" (Paper No. 6, page 2). As was argued by the appellant, this term distinguishes the method from non-automatic techniques, and we agree that its use does not cause the claim to be indefinite.

The second issue raised by the examiner is that it is not clear in claim 39 whether or not "a vehicle" in line 2 is the same vehicle recited in claim 21. The appellant has pointed out that claim 39 was amended to change "a" to "the" in this instance, which would remove any semblance of a problem in interpreting the claim. We agree.

¹The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. *In re Johnson*, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. *Id.*

As to the assertion that the language in claim 39 is confusing with regard to the vehicle following another vehicle, such a technique is disclosed on pages 6 and 7 of the specification, and it is our view that one of ordinary skill in the art therefore would have understood the language of the claim.

We reach the same conclusion with regard to the examiner's rejection of claim 40 because it is not clear how a video guides the vehicle. This is the basic concept of the appellant's invention, and is explained in detail in the specification, beginning on page 3 with the first embodiment and continuing throughout as each of the other embodiments is presented. We do not agree that the language in issue is indefinite.

The rejection under 35 U.S.C. § 112, second paragraph, is not sustained.

The Rejections Under Section 103

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or

from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

The first of these rejections is that claims 21-27, 31-36, 39 and 40 are unpatentable over Booth in view of Official Notice that using a controller such as a switch to control a vehicle/train is conventional. The examiner's theory is that Booth discloses all of the structure recited in claim 21 except for the controller, but that it would have been obvious to one of ordinary skill in the art to provide the Booth system with a controller, on the basis of Official Notice that this is a known feature in the art.

Booth discloses a toy electric train that runs along a track. The engine is equipped with an "optical sensing means" that detects images or scenes that appear in front of the engine, which are reproduced on a television monitor for viewing by the operator. There is no mention in Booth of utilizing this video presentation for anything other than enhancing the attractiveness of operating the train. While we would agree with the examiner that controllers for toy vehicles are known in the art, we fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to provide the Booth system with a controller that automatically identifies the image element in the video and then uses that video image to automatically control the vehicle.

It therefore is our conclusion that the evidence adduced by the examiner fails to establish a prima facie case of obviousness with regard to the subject matter recited in claim 21, and we will not sustain the rejection of claim 21 or, it follows, of claims 22-27, 31-36, 39 and 40, all of which are dependent from claim 21.

Claims 37 and 38 stand rejected as being unpatentable over the evidence provided against claim 21, taken further with Official Notice that providing an airlink between two antennas is conventional. Be that as it may, the second Official Notice does not alleviate the deficiency in the references applied against claim 21, from which claims 37 and 38 depend. This being the case, we will not sustain this rejection.

CONCLUSION

None of the rejections are sustained.

The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES
)
)
)
)
)
)

NEA/lbg

Appeal No. 2002-1598
Application No. 09/596,975

Page 10

TROP, PRUNER & HU, P.C.
8554 KATY FREEWAY, STE 100
HOUSTON, TX 77024-1805

APPEAL NO. 2002-1598 - JUDGE ABRAMS
APPLICATION NO. 09/596,975

APJ ABRAMS

APJ STAAB

APJ McQUADE

DECISION: **REVERSED**

Prepared By: LESLEY BROOKS

OB/HD

GAU: 3700

3 MEM. CONF. Y N

DRAFT TYPED: 09 Oct 03

FINAL TYPED: