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The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD SPECTOR

Appeal No. 96-1766
Application 08/218,822¹

ON BRIEF

Before KRASS, JERRY SMITH and LEE, Administrative Patent Judges.

LEE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 3, 4 and 7-10. Claims 2, 5 and 6 have been canceled. No claim has been allowed.

References relied on by the Examiner

Maurer

3,301,626

Jan. 31, 1967

¹ Application for patent filed March 28, 1994.

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"A well known photographic technique in view of the
acknowledged prior art."

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The Rejections on Appeal

Claims 1, 3, 4 and 7-10 stand finally rejected under 35 U.S.C. § 103 as being unpatentable over Maurer.

The following three new grounds of rejection were entered in the examiner's answer:

(1) Claims 1, 3, 4 and 7-10 are rejected under 35 U.S.C. § 103 as being unpatentable "over a well known photographic technique in view of the acknowledged prior art";

(2) Claims 1, 3, 4 and 7-10 are rejected under 35 U.S.C. § 112, first paragraph, as lacking "support" in the specification.

(3) Claims 1, 3, 4 and 7-10 are 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.

The Invention

The invention is directed to a method for producing animated films. Specifically, cartoon characters are created in real time by living actors wearing suits which are invisible to the camera because of matte cinema photography which excludes surfaces colored by a particular color, and a

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painting of the cartoon characters are drawn on the body suits in colors that are visible to the camera. Independent claim 1 is reproduced below:

1. A technique for producing an animated film whose cartoon character and its movements are impersonated by a living actor, having a particular appearance, said technique comprising the steps of:

A. enveloping the actor in a body suit dyed a specific solid color which totally covers the actor from head to toe except for small openings permitting the actor to see and breathe;

B. painting on the surfaces of the body suit in colors other than the specific color a drawing of said cartoon character whose appearance is that of the cartoon character and is unrelated to the appearance of the actor; and

C. photographing the body-suit covered actor with a special-effects, matte cinematography system adapted to exclude surfaces colored with the specific color from the camera filming the cartoon character, thereby rendering the covered actor invisible to the camera, the filmed cartoon character being animated in real time by the invisible actor's movements, said specific color being blue and the cinematography system is of the blue-screen type, said system yielding a film which is a composite of the animated cartoon character and background scenes appropriate to the character.

Opinion

We reverse.

The obviousness rejections

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According to claim 1, a living actor is enveloped, except for small openings to enable the actor to see and breathe, in a body suit dyed in a specific blue color excluded from a special-effects, blue-screen type, matte cinemaphotography system used to photograph the body-suit covered actor, **"thereby rendering the covered actor invisible to the camera."** What is visible to the camera, instead, is **"painting on the surfaces of the body suit in colors other than the specific color a drawing of said cartoon character whose appearance is that of the cartoon character and is unrelated to the appearance of the actor."**

With regard to the above-noted features of claim 1, the specification explains on page 9, lines 20, to page 10, line 2:

It is important to bear in mind that in this technique, the actor is not dressed and made up to resemble a cartoon character for there is a highly perceptible difference between a drawing of a cartoon character and [an] individual made up to resemble a cartoon character. Thus in the movie "Popeye," the actor Robin Williams who clenches a corncob pipe in his teeth was made up to resemble the Popeye of the classic Popeye animated films. But Popeye, the actor, could never be confused with Popeye, the cartoon character, for a cartoon character drawing is an abstraction of an animal-like or humanoid figure.

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In our view, the examiner has failed to give proper weight to the claim requirement that the cartoon character painting is unrelated to the appearance of the actor. In the context of claim 1, the actor is completely covered by a body-suit whose color is invisible to the photographing apparatus. Thus, the drawings made on the body suit, in colors which are visible to the camera, indeed do not relate to the appearance of the actor. If there is any resemblance between the cartoon character and the actor inside the body-suit, the resemblance is purely by happenstance and not by design. It is unreasonable for the examiner to say the two are related simply because some cartoon characters take on a humanoid form and the actor or actress inside the body-suit is a human. That kind of generic or overall likeness in the number of limbs, a torso and a head is not the type of "related appearance" pertinent to the claimed invention. Claims must be reasonably interpreted in light of the specification. The above-quoted portion of the specification makes clear what is meant by "not related" to the appearance of the actor or actress. At issue is the personal features of the person, not features common to all humans.

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Maurer would not have reasonably suggested the appellant's inventive concept because Maurer's method contemplates drawing directly on the face of an actress (column 2, lines 33-35). Even though care is taken to minimize 3-dimensional shading, the pictures taken relate very much to the specific contours and outline of the particular actor or actress playing the role of the cartoon character. Moreover, Maurer's method of painting directly on the face of the actor or actress is antithetical to enveloping the actor or actress in a body-suit except for small openings to permit the actor or actress to see and breathe. Note that claim 1 specifically recites the step of:

A. enveloping the actor in a body suit dyed a specific solid color which totally covers the actor from head to toe except for small openings permitting the actor to see and breathe.

For the foregoing reasons, we do not sustain the rejection of claims 1, 3, 4 and 7-10 as being unpatentable over Maurer.

Beginning on the last paragraph commencing on page 5 of the examiner's answer to line 7 on page 6, the examiner describes what he regards as "[a] notoriously old and well known photographic technique in the field of cinematography."

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The sole difference between that and the appellant's claimed invention, according to the examiner, is that the body suit is dyed cobalt blue and the enveloped actor or actress is filmed with a blue-screen type cinemaphotography system. That difference is made up by reliance on the appellant's admission that blue-screen type cinema photograph is well known in the art. The problem with the examiner's position is that nothing has been cited, on this record, to support his assertion that the photographic technique, of covering an actor in a black body-suit with small openings for him or her to see and breathe and painting a skeletal figure on the black body suit in colors other than black, such as white, is notoriously old and well known. In the reply, the appellant properly points out this inadequacy in the examiner's new ground of rejection.

In a supplemental answer on page 3, the examiner states:

However, the Examiner, an avid television viewer, is aware of and has seen numerous television programs and movies employing this "well known photographic technique." To the best of Examiner's knowledge, an episode of the very popular "The Little Rascals" series employed this technique. Examiner would also like to add that he has personally seen the type of animation described in the new grounds of rejection in a "Las Vegas" style stage show.

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The above-quoted representation by the examiner does not constitute evidence, very much like the notion that mere counsel's argument does not take the place of evidence. It is the initial burden of the examiner to establish a case of prima facie obviousness based on evidentiary facts, not speculations or vague recollections. Because the appellant has attacked the lack of foundation of the examiner's position as to what is notoriously well known, it is incumbent upon the examiner to produce evidentiary proof of his factual assertions and determinations, such as an affidavit under 37 CFR § 1.107(b), which states:

(b) When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

The examiner has produced no such affidavit to support the position relied on. Moreover, even if similar statements were repeated in an affidavit by the examiner, they would not be sufficiently specific so as to constitute meaningful evidence. The examiner has not identified any specific episode of the show "Little Rascals" or the particular "Las Vegas" stage show

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referred to by the examiner in the supplemental answer. Absent such specific identification, not only does the appellant not have an opportunity to contradict the representations, there is nothing sufficiently specific to contradict in a meaningful manner. On this record, there is insufficient support for the examiner's finding. Accordingly, we do not sustain the obviousness rejection of claims 1, 3, 4, and 7-10 as being unpatentable over "a well known photographic technique in view of the acknowledged prior art."

The § 112, First ¶ Rejection

According to the examiner (answer at 7), the specification "does not provide support for the claim limitation of 'said cartoon character whose form is unrelated to the appearance of the actor.'" It is not clear whether the examiner is referring to the enabling disclosure requirement or the written description requirement of 35 U.S.C. § 112, first paragraph. The two requirements are distinct from each other. This lack of specificity is itself sufficient basis for reversing the rejection. In any event, in our view the specification is neither unenabling nor without written

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description for the particular claim feature identified by the examiner.

On page 8 of the specification, it is described that an actor is enveloped from head-to-toe in a body suit 10 and the fabric is dyed cobalt blue or whatever other shade of blue which is appropriate to the blue-screen matte system 11 being used to photograph the actor. Also, it is described that no part of the actor is exposed except for eye openings 12, nostril openings 13 and a mouth opening 13. On page 10 of the specification, it is described that the eye, nose, and mouth openings are integrated into the character drawing painted on the exterior of the suits that they are obscured. On the same page, it is further described that thus the living actor is "invisible" to the blue-screen matte camera photographing the character.

Thus, the particular and personal features of the actor inside the body suit are entirely unrelated to the cartoon character drawing painted on the outside of the body suit. While the painted cartoon character may generally exhibit a humanoid form, in the context of this invention that does not render the character's appearance "related" to the appearance

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of the actor inside the body suit. Note that claim language must not be interpreted in a vacuum, but must be accorded a reasonable interpretation in light of the specification.

For the foregoing reasons, we do not sustain the rejection of claims 1, 3, 4 and 7-10 under 35 U.S.C. § 112, first paragraph as lacking support in the specification.

The § 112, Second ¶ Rejection

On page 8 of the answer, the examiner states:

The limitation of "said cartoon character whose form is unrelated to the appearance of the actor" is indefinite. That is, the metes and bounds of this limitation can not be determined since the specification fails to define or describe the difference(s) that must exist in order for the cartoon character to have a form that "is unrelated to the appearance of the actor." In addition, it should be noted that the specification and drawings fail to describe or show the "appearance of the actor," thus, the comparison set forth in the claim is difficult if not impossible to determine.

In our view, it is reasonably clear from the specification, pertinent portions of which have been cited and reproduced above, that the unrelatedness as required by the claim refers to a masking or obscuring of the personal and particular features of the actor such that their personal features are made completely invisible to the camera. The specification describes that the actor is covered from head-

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to-toe in a body suit dyed with a color not visible to the camera, and only the openings of the eyes, nostrils, and mouth are exposed to allow the actor to see and breathe. Any generic resemblance of the cartoon painting to a humanoid form does not constitute a sufficient relationship with respect to the personal and particular features of the actor. The examiner has failed to appreciate a distinction between a general resemblance to a humanoid form and particular resemblance to the personal and specific features of the actor. In the context of the rejected claims, reasonably construed in light of the appellant's specification, the "unrelated" appearance requirement concerns only a lack of resemblance with respect to the personal features of the actor or actress inside the body suit. Moreover, a resemblance merely by coincidence or happenstance and not by design is still within the confines of the unrelatedness recited in these claims. In the context of this invention, actual comparison between the cartoon character and the actor is necessary to determine that the cartoon's appearance is unrelated to the appearance of the actor.

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For the foregoing reasons, we do not sustain the rejection of claims 1, 3, 4 and 7-10 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim subject matter which the applicant regards as his invention.

Conclusion

The rejection of claims 1, 3, 4 and 7-10 under 35 U.S.C. § 103 as being unpatentable over Maurer is reversed.

The rejection of claims 1, 3, 4 and 7-10 under 35 U.S.C. § 103 as being unpatentable "over a well known photographic technique in view of the acknowledged prior art" is reversed.

The rejection of claims 1, 3, 4 and 7-10 under 35 U.S.C. § 112, first paragraph, as lacking "support" in the specification is reversed.

The rejection of claims 1, 3, 4 and 7-10 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to

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particularly point out and distinctly claim the subject matter
which the applicant regards as the invention is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
JERRY SMITH)	
Administrative Patent Judge)	APPEALS AND
)	
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