Paper No. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte ERIC OSTENDORFF, HELENA BARTOR and NATHAN C. PROCH

_____

Appeal No. 2000-0212
Application 08/914,477

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ON BRIEF

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Before CALVERT, ABRAMS, and NASE, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 16, all the claims in the application.

The claims on appeal are drawn to a toy vehicle, and are reproduced in the appendix of appellants' brief.[1]

[1] In claim 1, line 2, we note that "front" should be --frontal--, to provide proper antecedent basis.

The references applied in the final rejection are:

Travers	3,192,664	Jul. 6, 1965
Terzian	3,733,739	May 22, 1973
Oda	4,213,270	Jul. 22, 1980
George et al (George)	5,727,985	Mar. 17, 1998 (filed Mar. 8, 1996)

The appealed claims stand finally rejected under 35 U.S.C. § 103(a) as follows:

(1) Claims 1 to 4, 9 and 16, unpatentable over Travers in view of Oda.

(2) Claims 10 to 13, unpatentable over Travers in view of Oda and Terzian.

(3) Claims 1 to 6, 9 and 14 to 16, unpatentable over Travers in view of George.

(4) Claims 7, 8 and 10 to 13, unpatentable over Travers in view of George and Terzian.

Rejection (1)

Travers discloses a toy vehicle having a pair of drive wheels 6 near the front of the body, and a wheel-less trailing end, the wheels being driven through reduction gears 12, 13, etc., by motor 9, which may be electric (col. 3, lines 45 to

47). The vehicle is weighted eccentrically of its longitudinal axis, so that when the motor is activated, it will follow an "undefined and unpredictable" path (col. 3, lines 41 to 43).

Oda discloses at col. 1, lines 12 to 18, that:

> In the field of remotely controlled battery operated wheel toys, it has been the practice to employ two small motors, one connected to drive the front right wheel of the wheel toy, and the other connected to drive the front left wheel of the wheel toy, the speed of rotation of the motors being controlled by a two channel transmitter, one channel for each motor.

A toy automobile having such an arrangement is shown in Fig. 2, each front wheel 21, 29 being driven by a separate motor 41, 39 through reduction gearing 35, 37. The examiner takes the position that (answer, page 4):

> it would have been obvious to have provided [the Travers toy car with] any well known self-propulsion drive for toy cars, including the independent and remotely controlled front drive motors of Oda's figure 2. Such a remotely controlled car would allow for more realistic car motion requiring no physical user input/contact, adding to the amusement for the child user.

We will first consider the rejection with regard to independent claim 9.

Appellants first argue that "elimination of the rear

wheels from the prior art device is [sic:in] Figure 2 of Oda as urged by the examiner is contrary to the teaching of Oda" (brief, page 7). However, this statement mischaracterizes the examiner's position, which is not that it would have been obvious to eliminate the rear wheels of the Oda Fig. 2 vehicle, but rather, as indicated

above, that it would have been obvious to provide the Travers toy car with the drive system shown in Oda's Fig. 2.

Appellants further argue that Travers' disclosure of a front bumper extending beyond the vehicle wheels, and of interiorly mounted wheels, "is a teaching which leads one of ordinary skill in the art away from the present invention not toward it" (id.). This argument is not persuasive, because claim 9 does not contain any limitations requiring that the body not protrude in front of the wheels, or that the wheels be exteriorly mounted, and it is fundamental that under § 103 the question to be determined is whether "what is claimed would have been obvious from the combined teachings of the references." In re Sovish, 769 F.2d 738, 743, 226 USPQ 771,

774 (Fed. Cir. 1985). Having fully considered the record in light of the arguments of appellants and the examiner, we conclude that, for the reasons stated by the examiner, it would have been obvious to modify the Travers toy car by using a separate remotely-controlled motor for each wheel in view of Oda's disclosure thereof as being a conventional arrangement for toy automobiles. The thus-modified Travers toy car would meet all the limitations recited in claim 9.

We therefore will sustain rejection (1) as to claim 9, and as to claims 1 to 4, which appellants group with claim 9 on page 5 of their brief.

Appellants separately argue rejection (1) as to claim 16, which reads:

16. A toy vehicle comprising:

an elongated body having a frontal end and a trailing end, said trailing end being free of wheels;

a pair of wheels rotatably supported by said body substantially closer to said frontal end than said trailing end such that said toy vehicle rests upon said wheels and said trailing end; and

a pair of reversible motor drive units for applying a torque to each of said wheels and an opposite-direction reaction torque to said body, said reaction torque acting to flip said body pivoting said trailing end over said wheels when said motor drive units reverse the torque applied to said wheels.

Appellants assert that claim 16 additionally distinguishes over the prior art in that it requires a toy vehicle having an elongated body with a pair of rotating wheels and a pair of reversible motors for applying torque to the wheels and an opposite reaction torque to the body.

We agree with appellants to the extent that we find no disclosure or suggestion in the combination of Travers and Oda that the motors would produce sufficient torque to act to flip the body of the Travers toy car, pivoting the trailing end over the wheels, as recited in claim 16. Rejection (1) of claim 16 accordingly will not be sustained.

Rejection (2)

The claims to which this rejection applies having been grouped together by appellants (brief, page 5), we select claim 10 from the group and will decide rejection (2) based thereon. 37 CFR 1.192(c)(7).

Claim 10 recites:

10. The remotely controlled toy vehicle set forth in claim 9 wherein said body is buoyant in water and wherein said wheels define outer surface contours for propelling said toy vehicle through water.

Terzian discloses a toy vehicle which can be operated in water as well as on land. The wheels 14, 16 have "outer surface contours" (ribs or fins) 110, 112 on them to propel the vehicle through the water, the wheels giving sufficient buoyancy to allow the vehicle to float (col. 3, lines 6 to 11). The examiner states that (answer, page 5):

> Terzian teaches the concept of providing a vehicle body and wheels which together are buoyant so that the vehicle can be propelled through water. It would have been obvious to have provided the body and wheels of [the toy car of Travers, modified in view of] Oda as individually positively buoyant or compositely buoyant so that the car could travel into and through water, extending the usefulness and enjoyment of the RC car toy.

With regard to the applicability of Terzian, appellants argue at page 10 to 12 of the brief that (i) Terzian teaches away from appellants' claimed invention because Terzian's vehicle is self-righting, and Terzian teaches that no portion of the vehicle body extends beyond the periphery of the wheels, and (ii) the Terzian toy is non-inverting. These

arguments are not persuasive, because they do not relate to the invention claimed in claim 10, nor do they address the basis of the rejection stated by the examiner. Nothing in claim 10 or its parent claim 9 requires the claimed vehicle to be invertible, or precludes it from being self-righting. We agree with the examiner that one of ordinary skill would derive from Terzian a teaching of making a toy vehicle operable on water as well as land by making it buoyant and providing means on its drive wheels to propel it in water, and that it would have been obvious to apply that teaching to other toy vehicles, such as the toy car of Travers.

Rejection (2) will therefore be sustained.

Rejection (3)

George, like Oda, discloses a remotely controlled toy vehicle in which each drive wheel 18, 20 is driven by a separate drive motor 22, 24, and for reasons similar to those discussed in relation to rejection (1), supra, we consider that the subject matter of claim 9 would have been obvious over the combination of Travers and George.

Appellants argue that "Travers clearly rejects toy

vehicles utilizing remote controlled or electro-mechanical guidance systems," citing col. 1, lines 26 to 35. The cited portion of Travers does disclose that toy vehicles having, e.g., "intricate electro-mechanical guidance systems to control the direction of the vehicle" are unsatisfactory. However, we do not consider that this would have dissuaded one of ordinary skill from modifying the Travers vehicle as proposed by the examiner, since we do not believe that at the time the present invention was made remote-controlled motors as disclosed by George would have been considered an "intricate" system.

We accordingly will sustain the rejection of claim 9, as well as the rejection of claims 1 to 4, appellants having grouped those claims with claim 9.

Claim 14 requires that "said wheels extend beyond said frontal end [of the body]." The examiner asserts that such a modification of the toy car of Travers would have been obvious in view of George's disclosure of forwardly-extending wheels so that the vehicle can bounce off of a wall or obstacle and climb up a near vertical wall (answer, pages 5 and 6), but we

do not agree. In the first place, the Travers toy is intended to resemble "any actual commercial vehicle" (col. 2, line 5), such as "real automobiles" (col. 2, line 27); it would not do so if modified so that its wheels projected beyond the front of the body. Secondly, the Travers and George vehicles are so different in their intended manner of operation that we do not consider that one of ordinary skill would have taken George's disclosure of forwardly-projecting wheels, to allow it to climb walls, etc., as a suggestion to provide that feature on the toy car of Travers.

We therefore will not sustain the rejection of claim 14, or of claim 15 dependent thereon. Also, since claim 5 also requires forwardly projecting wheels, we will not sustain the rejection of that claim, or of dependent claim 6.

Rejection (3) of claim 16 will be sustained. George discloses that motors 22, 24 have sufficient torque to invert the vehicle (col. 5, line 65, to col. 6, line 10). Therefore, when utilizing such motors in the Travers toy car, they presumably would have sufficient reaction torque to flip the body, pivoting the trailing end of the body over the wheels.

We recognize that the Travers car probably would not invert in this manner because the front bumper would contact the ground, but claim 16 does not contain any limitations, such as those recited in claims 5 and 14, which would allow the body to flip in the manner claimed; all it recites is the reaction torque "acting to flip said body" (emphasis added). Modification of the toy car of Travers using the motors suggested by George would result in a vehicle which would meet this limitation.

Rejection (4)

This rejection will not be sustained as to claims 7 and 8, since those claims are ultimately dependent on claim 5, and the Terzian reference does not overcome the deficiencies of the Travers/George combination noted above with regard to claim 5.

Rejection (4) will be sustained as to claims 10 to 13, for the same reasons as stated above with regard to rejection (2).

Conclusion

The examiner's decision to reject claims 1 to 16 is

affirmed as to claims 1 to 4, 9 to 13 and 16, and reversed as to claims 5 to 8, 14 and 15.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

IAN A. CALVERT)
Administrative Patent Judge)
)
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) BOARD OF PATENT

NEAL E. ABRAMS Administrative Patent Judge	)	APPEALS AND
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