

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MITCHELL J. FRANCIS and GARY H. PACKMAN

Appeal No. 97-1142
Application 08/260,831¹

ON BRIEF

Before ABRAMS, FRANKFORT and STAAB, *Administrative Patent Judges*.
STAAB, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-4, all the claims currently pending in the application.

Appellants' invention pertains to an amusement ride which includes a digital video player that projects a 3-D image onto a

¹ Application for patent filed June 16, 1994.

Appeal No. 97-1142
Application 08/260,831

screen. A basic understanding of the invention can be derived from a reading of exemplary claim 1, which reads as follows:

1. An amusement ride apparatus comprising:

a motion base with up to six degrees of freedom of motion including a plurality of actuators supporting a platform;

a passenger holding means secured to said platform and including a plurality of seats;

a 3-D video image means including a screen and a digital video player and projector attached to move with said platform wherein said digital video player projects a 3-D picture on said screen; and

a control system including a computer which receives digital signals encoded on a digital storage medium for moving said platform in correspondence with the projected image.

In rejecting appellants' claims under 35 U.S.C. § 103, the examiner relies upon the reference listed below:

Trumbull (Trumbull '256)	4,066,256	Jan. 3, 1978
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The following references of record are relied upon by this merits panel of the Board in support of new rejections made pursuant to our authority under 37 CFR § 1.196(b):

Hayes et al. (Hayes)	4,855,842	Aug. 8, 1989
Noble	4,907,860	Mar. 13, 1990
Trumbull (Trumbull '670)	5,433,670	Jul. 18, 1995
		(filed Feb. 5, 1993)

The Rejection

Claims 1-4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Trumbull '256. The examiner concedes that

Appeal No. 97-1142
Application 08/260,831

Trumbull '256 does not specifically teach a 3-D digital video image means as set forth in claim 1. The examiner has taken the position, however, that "laser video disc players to produce 3-D pictures are already commercially available and very well known in the art" (final rejection, page 3). In this regard, the examiner further states:

[A]ttention is directed to page 1 of this application, [sic, .] Applicants admitted that the use of 3-D technology is well known in the art and that is [the] reason why the examiner did not cited [sic] a reference teaching of such technology. Also, it is well known in the art that the 3-D video player utilizes digital technology. Therefore, it is submitted that the Trumbull ['256] reference and the disclosure of this application are clearly suggestive of the claimed invention for the reasons as set forth above. This [is] all that is required to support a *prima facie* legal conclusion that the claimed invention would have been obvious to one of ordinary skill in the art. [final rejection, page 4]

Appellants' Position

Appellants contend that the examiner's assertion that laser video disc players to produce 3-D pictures are commercially available and very well known in the art

is neither supported by the disclosure of Trumbull nor . . . by cited prior art. In fact, the Examiner has made a fully unsupported assertion of obviousness . . . and refuses to cite prior art supporting the assertion of obviousness.

Appeal No. 97-1142
Application 08/260,831

Specifically, without citing a single piece of prior art in support of the contention, the Examiner has broadly asserted that the use of two laser disc players creating three-dimensional images is well known [During prosecution, appellants] respectfully requested that the Examiner provide prior art supporting the assertion that such technology is well known The Examiner refused to comply. [brief, pages 5-6]

Appellants assert that "the failure to cite prior art supporting the modification of Trumbull is fatal to the Examiner's rejection" (brief, page 7).

Opinion

Appellants' point is well taken. The examiner's reliance on prior art discussed on page 1 of the specification of the present application in support of the rejection is improper and inappropriate since the prior art in question is not included in the list of prior art relied upon in the rejection and is not included in the statement of the rejection. If prior art is relied upon in any capacity to support a rejection, it should be positively included in the statement of the rejection. See Manual of Patent Examining Procedure (M.P.E.P.) 706.02(j); *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970) and *Ex parte Raske*, 28 USPQ2d 1304-05 (BPAI 1993). Furthermore, the examiner's failure to cite a reference to support his position regarding that which is well known and conventional when

Appeal No. 97-1142
Application 08/260,831

seasonably challenged by appellants is also improper. See M.P.E.P. 2144.03 (" . . .the examiner should not be obliged to spend time to produce documentary proof [of facts which are capable of instant and unquestionable demonstration as being "well-known" in the art]. . . . If the applicant traverses such an assertion *the examiner should cite a reference in support of his or her position.*"(emphasis added)).

In the present instance, the examiner has failed to provide a sufficient factual basis to support his conclusion that the claimed subject matter would have been obvious to one of ordinary skill in the art. We are therefore constrained to reverse the standing § 103 rejection. *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968).

New Rejections Pursuant to 37 CFR § 1.196(b)

Claims 1, 2 and 4 are rejected under 35 U.S.C. § 103 as being unpatentable over Trumbull '256 in view of Noble and Hayes.

With respect to claim 1, Trumbull '256 discloses a motion base including a plurality of actuators 24, 26, 28 supporting a platform 120, a passenger holding means 12 secured to the platform, video image means including a screen 20 and a motion picture projector 18 attached to the platform for projecting an image on the screen, and a control system (Figure 6) for

Appeal No. 97-1142
Application 08/260,831

receiving signals from storage medium 78 for moving the platform in correspondence with the projected image. Trumbull '256 does not disclose that the video image means is a 3-D video image means, nor that the video image means included is a digital video player.

Noble is cited as evidence that 3-D video image producing means were known in the art at the time of appellants' invention. In this regard, Noble teaches that 3-D video image means may produce an image that is viewable on a film projection screen (column 3, lines 17-20). Hayes is cited as evidence that digital image producing means in the form of laser video disc players were known in the art at the time of appellants' invention.

Applying the test for obviousness set forth in *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981), which is what the combined teachings of the prior art would have suggested to those of ordinary skill in the art, it would have been obvious to one of ordinary skill to provide the Trumbull '256 apparatus with video image means that produce a 3-D image, and to utilize a laser (i.e., digital) video disc player in so doing, in view of the teachings of Noble and Hayes. Suggestion for the above modifications is found in the recognition by Trumbull '256 at column 6, lines 63-65 that other imaging systems may be utilized,

Appeal No. 97-1142
Application 08/260,831

and in the self-evident advantages 3-D imaging (e.g., enhanced realism) and digital video player technology (e.g., improved image quality) provide, which the ordinarily skilled artisan would have readily appreciated. In this regard, the artisan would have viewed the proposed modification of Trumbull '256 as a straightforward trade-off between the use of the relatively inexpensive imaging technology of Trumbull '256 (column 1, lines 26-29) and the more sophisticated and expensive imaging technology taught by Noble and Hayes.

As to claim 2, the housing means of Trumbull '256 encloses the seats and the image means. See Figure 4.

In regard to claim 4, the use of a separate laser video disc player to produce each image component of the 3-D image would have been obvious to one of ordinary skill, it being noted that Hayes, in effect, teaches that separate images for the left and right eye are utilized to produce the 3-D effect.

Claim 3 is rejected under 35 U.S.C. § 103 as being unpatentable over Trumbull '256 in view of Noble and Hayes and further in view of Trumbull '670. In view of the teaching of Trumbull '670 at column 6, lines 32-37 of limiting the overall height of the simulator system theater thereof to enable its location within a building having a conventional ceiling height

Appeal No. 97-1142
Application 08/260,831

of about 14.5 ft., it would have been obvious to dimension the motion base and housing of Trumbull '256 to allow it to be installed and fully operational in a building with 15 foot ceilings.

Summary

The standing rejection under 35 U.S.C. § 103 is reversed. New rejections pursuant to 37 CFR § 1.196(b) have been made.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

Appeal No. 97-1142
Application 08/260,831

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

REVERSED, 37 CFR 1.196(b)

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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CHARLES E. FRANKFORT)	BOARD OF PATENT
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Appeal No. 97-1142
Application 08/260,831

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