

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BARBARA ROSS BERLIN and DAVID W. BERLIN

Appeal No. 1997-1436
Application No. 08/419,174¹

ON BRIEF²

Before CALVERT, MEISTER, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 13 and 14, which are all of the claims pending in this application.³

¹ Application for patent filed April 10, 1995.

² On June 1, 1999, the appellants filed a request (Paper No. 21) to cancel the oral hearing scheduled for June 7, 1999. Such request has been granted.

³ Claims 13 and 14 were amended subsequent to the final rejection. While the examiner has approved entry of the

(continued...)

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We REVERSE.

³(...continued)
amendment (Paper No. 8, filed February 6, 1996), we note that
this amendment has not been clerically entered.

BACKGROUND

The appellants' invention relates to the combination of a stuffed doll and an audio device. An understanding of the invention can be derived from a reading of exemplary claim 13, which appears in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Hall Vandis 1987	4,710,145	Dec. 1,
Koguchi et al. (Koguchi) 3, 1990	4,913,676	Apr.
Stone 1991	5,059,149	Oct. 22,

Claim 13 stands rejected under 35 U.S.C. § 103 as being unpatentable over Hall Vandis in view of Koguchi.

Claim 14 stands rejected under 35 U.S.C. § 103 as being unpatentable over Hall Vandis in view of Koguchi as applied to claim 13, and further in view of Stone.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 14, mailed June 27, 1996) and response to reply brief (Paper No. 16, mailed September 27, 1996) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 13, filed May 6, 1996) and response to examiner's answer (i.e., reply brief) (Paper No. 15, filed August 27, 1996) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 13 and 14 under

35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

With respect to the rejection of claim 13, the examiner determined (answer, p. 4) that

[i]t would have been obvious to one of ordinary skill in the art to have provided a Hall Vandis doll with the function of sound activated recording, as taught by Koguchi, in order to create an eavesdropping device to monitor child or other peoples' private word and actions. The controls disclosed by Hall Vandis can easily be modified and control of such an additional function for the same electronic assembly would have been well within

the skill of one of ordinary skill and would not have required undue experimentation to achieve.

These same determinations are incorporated by the examiner in the rejection of claim 14 (answer, p. 4).

The appellants argue (brief, pp. 6-9, and reply brief, pp. 1-4) that the combination of Hall Vandis and Koguchi would not produce the subject matter of claims 13 and 14. We agree for the reasons set forth below.

On page 3 of the answer, the examiner set forth the following factual inquiries from Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are to be applied for establishing a background for determining obviousness under 35 U.S.C. § 103:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

While the examiner did broadly determine the scope and content of Hall Vandis and Koguchi, the examiner did not ascertain the

differences between Hall Vandis and claim 13. Accordingly, we will do so.

Hall Vandis discloses a therapeutic doll figure having a doll body with at least a head section 10 and a torso section 12. Hall Vandis teaches that a transport, such as a tape transport 50, with a recordable medium, such as a tape cassette, is located within the doll body and is capable of having a message recorded thereon and which message may also be reproduced therefrom. A speaker 80 is located within the doll for generating the reproduced message. A microphone 82 can be located on the doll and connected to the tape transport for recording a message on the tape cassette. Further, a manually actuated on-off switch 66, a record switch 84 and a play switch 86 are provided for the tape transport. Hall Vandis further discloses that the tape transport 50 including the associated electrical circuitry 64 can be conveniently mounted within a rectangularly shaped casing 70 located within the torso section 12 of the doll body toward the rearward portion thereof. Hall Vandis also teaches that the tape transport 50 including the circuitry 64 can be

conveniently powered by conventional batteries 74, such as C-cell 1.5 volt batteries, located within another rectangularly shaped compartment or casing 76 formed in the torso section 12 of the doll body near the rearward portion thereof.

Based on our analysis and review of Hall Vandis and claim 13, it is our opinion that the only difference is the limitation that the audio device include "a sound activated switch connecting said source of power and said first means." In that regard, the remaining limitations of claim 13 are readable on Hall Vandis' doll figure as follows:

The combination of a stuffed doll having an exterior covering and an interior space (Hall Vandis' doll figure and casing 70), and an audio device (Hall Vandis' tape transport 50, etc.) comprising, an audio device mounted within said interior space (Hall Vandis' tape transport 50 is mounted within casing 70), said audio device comprising a first means to record sounds (Hall Vandis' record switch 84 and microphone 82), a second means to

play aloud those sounds recorded by said first means (Hall Vandis' play switch 86 and speaker 80), said first means including means for receiving data for playing sounds aloud on said second means (Hall Vandis' tape transport 50 plays previously recorded tape cassettes), said audio device including a source of power (Hall Vandis' batteries 74), and said audio device having a master control switch having operative and inoperative positions (Hall Vandis' on-off switch 66) to selectively control said first and second means, whereby sounds recorded by said first means will be played aloud only when said master control switch is manually moved to said operative position (sounds recorded by Hall Vandis' tape transport 50 through microphone 82 can only be played through speaker 80 when the on-off switch 66 is manually moved to the on position).

Koguchi discloses a moving animal toy 1 wherein when a motor 22 is started upper and lower beaks 4 are pivoted up and down simultaneously to widely open and close the beaks, and at the

same time a head 3 is slowly rotated, twisting the head sideways. When a voice is uttered against the toy, it is received through a microphone 135 by a voice recording and reproducing device 134 contained on printed circuit board 133 and after a specified recording time elapses, the voice is reproduced by a speaker 138.

Koguchi teaches (column 7, lines 40-68) that when a switch knob 19 is turned from the off position to the on position, a switch mechanism is turned on, however, with no voice entered to the microphone 135, the voice recording and reproducing device 134 prevents the motor 22 from being energized and the motor is in a standby condition. When a voice higher than a specified level is uttered toward the toy 1, it enters the microphone 135 and is recorded in the voice recording circuit for a preset recording time of, say, several seconds. As the preset recording time is up, the voice recording circuit is stopped and the voice reproducing circuit is energized. At the same time the motor 22 is also started by the motor control circuit. The voice reproduced by the voice reproducing circuit is generated through the speaker 138 at the abdominal portion of the toy 1. The voice or sound is

reproduced by the speaker 138 for the same length of time that it was recorded. Then when the voice reproduction is finished, the voice recording circuit inhibits input of any voice from microphone 135 until the motor 22 comes to a complete stop in order to prevent erroneous operations. Several seconds after

the motor 22 has stopped, the microphone 135 returns to the standby mode for receiving a voice.

From the teachings of Koguchi, we conclude that Koguchi would not have suggested providing Hall Vandis with a sound activated switch connecting Hall Vandis' batteries (i.e., the source of power) and Hall Vandis' recording means (i.e., the first means). We reach this conclusion based upon the failure of Koguchi to teach or suggest a sound activated switch connecting his batteries and his recording means.

The examiner's determination that the limitation that the audio device include "a sound activated switch connecting said

source of power and said first means" would have been suggested by (1) Koguchi's recording circuit which is activated when the switch knob 19 is in the on position and when a voice higher than a specified level is uttered toward the toy 1, and (2) the ability of one of ordinary skill to have modified the controls disclosed by Hall Vandis to control an additional function is not supported by evidence. Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg. v. SGS Imports Intern., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157

F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977).

For the reasons set forth above the examiner has not established that it would have been obvious to provide Hall Vandis' doll figure with "a sound activated switch connecting said source of power and said first means" as set forth in claims 13 and 14. Accordingly, the decision of the examiner to reject claims 13 and 14 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 13 and 14 under 35 U.S.C. § 103 is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	
)	
)	BOARD OF PATENT
JAMES M. MEISTER)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
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APPLICATION NO. 08/419,174

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DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 16 Jun 99

FINAL TYPED: