

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES A. ASHBey

Appeal No. 94-2500
Application 07/399,471¹

HEARD: May 10, 1995

MAILED

JUN 29 1995

PAT.&T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before CARDILLO, JERRY SMITH, and BARRETT, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 8-10 and 14. Claims 11 and 13, the remaining claims in the application, have been indicated to be

¹ Application for patent filed September 18, 1989, entitled "Interactive Video System Having Frame Recall Dependent Upon User Input And Current Displayed Image."

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allowable if rewritten in independent form (Examiner's Answer, page 2).

The invention is directed to an interactive video system, an understanding of which can be obtained from claim 8, reproduced below.

8. A video system comprising:

a video playback device for reproducing sequentially a plurality of images stored on a record medium, said images forming a moving picture sequence;

a display device for reproducing a video picture from the video playback device;

an input device for enabling a user to indicate desired movement;

a framestore coupled between said video playback device and said display device, said framestore being capable of storing an image substantially larger than that currently displayed on said display device; and

control means for controlling reading of video information from the framestore, said control means being operable to select a desired image from said plurality of images and a desired portion of said selected image in dependence on (i) the output of said input device and (ii) the image and image portion currently being displayed on the display device.

THE REFERENCES

The examiner relies upon the following prior art:

Girault et al. (Girault) 4,360,876 November 23, 1982

The following reference of record is applied in a new ground of rejection under 37 CFR § 1.196(b):

Blanton et al. (Blanton) 4,752,836 June 21, 1988

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THE REJECTION

Claims 8-10 and 14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Girault.

OPINION

We reverse the rejection over Girault, but enter a new ground of rejection under 37 CFR § 1.196(b).

"Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention." RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.), cert. dismissed, 468 U.S. 1228 (1984).

With respect to claim 8, appellant argues (Brief, pages 8-9) that Girault fails to disclose (emphasis by appellant):

- (1) "reproduc[ing] 'sequentially a plurality of images stored on a record medium, said images forming a moving picture sequence'";
 - (2) "an input device for enabling a user to indicate desired movement"; and (3) selecting a desired image "in dependence on (i) the output of said input device."
- With respect to claim 14, appellant argues (Brief, page 10) that Girault fails to disclose (emphasis by appellant): (1) "reproducing images which form a moving picture sequence"; (2) "reading images forming said picture sequence"; (3) "storing successive images of said picture sequence"; (4) "providing and monitoring a signal from a user

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input device to indicate desired movement"; and (5) "control and choice of the selected image displayed 'in dependence upon: (i) the signal supplied by the user input device. . . .'" In summary, the factual questions are whether Girault discloses: (1) a moving picture sequence; (2) a user input device; and (3) the selection of a desired image in dependence on the user input device.

We agree with the examiner's findings that the aircraft control constitutes a user input device, as broadly claimed, and that the sequence of map images is selected in dependence on the input device. However, we conclude that the examiner erred in finding that the images in Girault are images which form "a moving picture sequence," as recited in claims 8 and 14, and thus the anticipation rejection must be reversed. A "motion picture" is defined as "a series of pictures projected on a screen in rapid succession with objects shown in successive positions slightly changed so as to produce the optical effect of a continuous picture in which the objects move." Websters' New Collegiate Dictionary (G.&C. Merriam Co. 1977) (Webster's). This is the same meaning appellant asserts in his arguments. The sequence of images in Girault do not move, because the cartographic features of the map are fixed and have no relative motion with each other. It is the plane's position in Girault

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that moves against the static map background to produce an illusion of motion.

The examiner discounts appellant's argument that "moving picture sequence" should be interpreted as "the term is conventionally used in cinematography" (Brief, page 8) because "'cinematography' is not recited in the claims and cannot be read into the claims" (Examiner's Answer, page 3). "Cinematography" is defined as "the art or science of motion-picture photography," Webster's, and thus is defined in terms of motion picture. The moving picture aspect is already in the claims, so adding "cinematography" to the claims is unnecessary. The examiner states that "even if 'cinematography' is read into the claims, the sequences of pictures noted above in Girault . . . would represent a 'moving picture sequence' as defined by appellant, given a sufficiently fast aircraft speed" (Examiner's Answer, page 4). We disagree, because the sequence of images in Girault do not represent a moving picture. The plane moving against the map background does not meet the claim limitation of "images forming a moving picture sequence."

The examiner states that "the claims are read for what they say in light of the specification, including equivalents to defined elements" (Supplemental Examiner's Answer, page 1). Appellant states that "Appellant does not understand the Examiner's newly raised emphasis upon 'equivalents'"

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(Supplemental Reply Brief, page 1), because neither 35 U.S.C. § 112, sixth paragraph, equivalents nor the "Doctrine of Equivalents" are applicable. We, too, are unsure what the examiner is trying to say. Means-plus-function limitations under 35 U.S.C. § 112, sixth paragraph, cover structure disclosed in the specification and equivalents; however, the claim limitations here are not in means format. The usual meaning of "Doctrine of Equivalents" refers to an equitable doctrine which permits disregard of claim limitations to a degree in an issued patent, which obviously does not apply here. However, historically, the doctrine of equivalents also applied to patentability. See 1 Deller, Walker on Patents § 40 (Baker, Voorhis & Co. 1937) (the substitution of equivalents is not "invention"); 1 Robinson, The Law of Patents for Useful Inventions §§ 245-258, § 246 (Little, Brown, and Company 1890) ("In its second and more technical sense it ['equivalent'] signifies the interchangeability of agencies which are known in the arts to be capable of serving the same purpose as integral parts of some particular invention."). This is undoubtedly the reason why equivalents under the doctrine of equivalents in infringement litigation do not cover equivalents in the public domain, i.e., found in the prior art. See, e.g., Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 870, 228 USPQ 90, 96 (Fed. Cir. 1985). If the examiner's position is that the illusion of

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relative motion caused by a plane moving over the map surface in Girault is equivalent to a sequence of images forming a moving picture sequence, we must disagree with this finding because the motion is not produced in substantially the same way. Moreover, non-§ 112, sixth paragraph, equivalents are really an obviousness concept because whereas a "means" clause, by statutory definition, covers equivalents, a regular structural limitation does not. The proper rejection is that substitution of an art-recognized equivalent for structure in the prior art would have been an obvious modification to one of ordinary skill in the art; this legal conclusion, of course, must be based on a correct factual finding of equivalents. We find that the image sequences in Girault are not equivalent to images forming a moving picture sequence, as claimed.

The rejection of claims 8-10 and 14 as anticipated by Girault is reversed.

NEW GROUND OF REJECTION UNDER 37 CFR § 1.196(b)

Claims 8-10 and 14 are rejected under 35 U.S.C. § 102(b) as anticipated by Blanton et al. (Blanton), U.S. Patent 4,752,836, of record. Blanton discloses an interactive video playback device, video disc player 23 in figure 8, having images stored on a video disc record medium. The sequences of stored images in Blanton simulate paths of movement through a multi-dimensional space and, thus, undoubtably form "moving picture sequences," as

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claimed. The video processor 35, color monitor 52 and associated circuitry in figure 8 of Blanton are the "display device for reproducing a video picture." In Blanton, "only a window or portion of an entire video frame is reproduced on the display" (column 9, lines 37-38; see figures 7 and 10). The video frame is stored in line buffers 110, 112 (figure 9; specification, column 18, lines 39-62) or an entire frame buffer (specification, column 19, lines 33-34) or a "full frame buffer" (column 12, line 68); these are all framestores as claimed. Thus, the framestore in Blanton is "capable of storing an image substantially larger than that currently displayed on said display device," as claimed. "The system further includes operator controls 60 such as a joystick, elevator controls or pedals, throttle, and the like, . . . so that appropriate commands may be generated to retrieve and display video images, to select an apparent path within the space, to interact with overlay graphics created by the overlay graphics processor, to rotate the image for banking, etc." (column 13, lines 5-15). Thus, Blanton has an "input device for enabling a user to indicate desired movement" and "to select a desired image . . . and a desired portion of said selected image in dependence on (i) the output of said input device," as recited in claim 8. The desired image in Blanton is selected "in dependence on . . . (ii) the image and image portion being displayed on the display

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device," as recited in claim 8, because the sequence of images is dependent on the present image displayed; that is (column 14, lines 24-29):

[E]ach frame is logically connected to the next frame in the branch sequence, for example with a doubly-linked list structure, so that the control computer is always able to determine the next frame to be accessed from the video disc based on information pertaining to the current frame being displayed.

With regard to claim 9, Blanton has alternative sequences of images and the images are interleaved as shown by the frame numbers in the sequences in figure 15. With regard to claim 10, the sequence is dependent on the user input device, which is used to "select an apparent path within the space" (column 13, lines 12-13), and on the image and image portion currently being displayed because the sequence is constrained to move along branch paths in "data space" which depend on the current image.

The limitations of method claim 14 correspond to the apparatus limitations of claims 8 and 10, discussed above.

CONCLUSION

The rejection of claims 8-10 and 14 under 35 U.S.C. § 102(b) over Girault is reversed.

A new ground of rejection of claims 8-10 and 14 under 35 U.S.C. § 102(b) over Blanton is entered pursuant to 37 CFR § 1.196(b).

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based

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