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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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MICHAEL J. SUMAN,  
THOMAS L. WELLING  
ROBERT J. SCHNEIDER

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Appeal No. 96-1462  
Application 08/025,189<sup>1</sup>

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ON BRIEF

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

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

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<sup>1</sup> Application for patent filed March 2, 1993.

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This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-47, which constitute all the claims pending in the application.

The disclosed invention pertains to a system mounted to the interior roof of a vehicle for projecting television signals onto a screen which is viewable by passengers in the vehicle. The projector is fixedly mounted within a housing while the screen is movably mounted to the housing. The screen can be moved between open and closed positions.

Representative claim 1 is reproduced as follows:

1. A system for the projected display of television signals in a vehicle overhead console comprising:

a housing for mounting to the roof of a vehicle, said housing including a television signal projector fixedly mounted therein and including a lens to project a television image rearwardly with respect to the vehicle;

a cover mounted to said housing for movement between a closed position and an open position for use of said projector; and

a projection screen and means for movably mounting said screen to said housing for movement between a substantially horizontal stored position when said cover is closed and a substantially vertical position in spaced relationship to said lens when said cover is open for use of said projector.

The examiner relies on the following references:

Rose	2,482,031	Sep. 13, 1949
Peterson	4,719,513	Jan. 12, 1988
Mercedes-Benz	41 18711	Dec. 10, 1992

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(German Offenlegungsschrift)

Claims 1-3, 10, 17-20 and 22 stand rejected under 35 U.S.C. § 102(a) as being anticipated by the disclosure of Mercedes-Benz. Claims 1-47 also stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Mercedes-Benz in view of Peterson with respect to claims 1-8, 10-20, 22-25, 27-31, 33, 34, 42, 43 and 47, and adds Rose with respect to claims 9, 21, 26, 32, 35-41 and 44-46.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for the respective details thereof.

#### OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the disclosure of Mercedes-Benz does not fully meet the

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invention as recited in claims 1-3, 10, 17-20 and 22. We are also of the view that the collective evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-47. Accordingly, we reverse.

We consider first the rejection of claims 1-3, 10, 17-20 and 22 as anticipated by the disclosure of Mercedes-Benz. All of these claims except claim 22 stand or fall together [brief, page 5]. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. 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); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

With respect to independent claim 1, appellants argue that (1) the examiner has improperly treated the LCD device 19 of Mercedes-Benz as both a projector as well as a cover, (2) the examiner has not given the claimed projector the appropriate meaning as set forth in this application, (3) Mercedes-Benz does

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not have a screen positioned in spaced relationship to the lens, and (4) the Mercedes-Benz LCD screen is not fixedly mounted to the housing [brief, pages 8-10]. The examiner individually responds to each of these arguments in the answer in paragraphs respectively labeled 11.1, 11.2, 11.4 and 11.5 [answer, pages 4-6].

Although we can agree with some of the points made by the examiner, we cannot agree with the fundamental position that the Mercedes-Benz LCD is a projector and screen assembly within the meaning of claim 1. Appellants' specification specifically describes LCD panel displays and CRT television displays and the disadvantages these types of television displays have compared to a projection television display. Thus, when the specification is discussing the projection system of the invention, it is clearly excluding LCD panels and CRTs from this class. The question is whether the clear intent of appellants can be ignored by reading the claims to cover something which is clearly disclaimed by appellants' specification.

The examiner and appellants have both pointed to the definition of the word "projector" as set forth in Webster's Ninth New Collegiate Dictionary. The examiner relies on two of the definitions which would include basically any television

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receiver as a projector of an image, whereas appellants rely on a definition which is more appropriate to the conventional use of the term projection television. We find ourselves in agreement with appellants on this point.

When interpreting a claim, words of the claim are generally given their ordinary and accustomed meaning, unless it appears from the specification or the file history that they were used differently by the inventor. Carroll Touch, Inc. v. Electro Mechanical Sys., Inc., 15 F.3d 1573, 1577, 27 USPQ2d 1836, 1840 (Fed. Cir. 1993). As noted above, appellants' specification clearly indicates that CRT televisions and LCD panel televisions are not systems for projecting television signals onto a projection screen. Although claims are to be given their broadest reasonable interpretation during prosecution, it is not reasonable to read claim language in a manner which is inconsistent with the specification. Thus, we agree with appellants that the claimed "projector," "lens" and "projection screen" cannot be met by a conventional CRT or LCD flat panel. We also note that if you went into a store to buy a projection television, you would not expect to be shown CRTs or LCD flat panels. The art has come to recognize that projection television is a specific type of subclass of televisions.

We also find that the examiner has not properly interpreted the mounting recitations of claim 1. Specifically, claim 1 recites that the projector is fixedly mounted to the housing whereas the screen is movably mounted to the housing. There is no question that the projector and the screen of Mercedes-Benz are both included within the element labeled as 19. This element is movably mounted with respect to the housing in Mercedes-Benz. We do not see how the Mercedes-Benz projector can be deemed to be fixedly mounted to the housing while at the same time the screen is deemed to be movably mounted. The projector and the screen in Mercedes-Benz are fixed relative to each other so that they cannot meet the different mounting connections of claim 1.

Since we find that Mercedes-Benz does not fully meet all the recitations of independent claim 1, we do not sustain the rejection of claims 1-3, 10 and 17-20 under 35 U.S.C. § 102.

Although separately argued independent claim 22 is broader than claim 1 just discussed, claim 22 still recites a projection television system and a projector which is fixedly mounted to the housing. These features are not met by Mercedes-Benz for the same reasons discussed above with respect to claim

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1. Therefore, we also do not sustain the rejection of claim 22 under 35 U.S.C. § 102.

We now consider the rejection of claims 1-47 under 35 U.S.C. § 103. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part

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of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

We consider first the rejection of claims 1-8, 10-20, 22-25, 27-31, 33, 34, 42, 43 and 47 as unpatentable over the teachings of Mercedes-Benz and Peterson. Appellants again argue that the projection display recitations are not taught by either Mercedes-Benz or Peterson, and that there would be no basis for the artisan to combine the teachings of Peterson with those of Mercedes-Benz [brief, pages 10-13]. The examiner responds that Mercedes-Benz meets the claim language as discussed above and asserts that it would have been obvious to substitute for the LCD display of Mercedes-Benz with the CRT display of Peterson [answer, pages 6-9].

Considering the latter point raised by appellants first, we agree with appellants that the artisan would not have considered combining the teachings of Peterson with Mercedes-Benz to arrive at the claimed invention. The collapsible cart of Peterson is addressed to such a different aspect of imaging than Mercedes-Benz is that there would be no reason to seek to modify Mercedes-Benz with the suggestions of Peterson. We are unable to accept that the artisan would find any useful teachings in

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Peterson that could be applied to a compact vehicle mounted system such as disclosed by Mercedes-Benz.

Although the examiner has stated that Mercedes-Benz and Peterson are from analogous arts, this fact cannot, by itself, justify this rejection. Two references which are from analogous arts cannot be combined simply because they come from analogous arts. There must still be some teaching or suggestion in the prior art which would have led the artisan to combine the teachings. There is nothing in Mercedes-Benz or Peterson which would have led the artisan to make the modifications proposed by the examiner. The examiner's modifications come from a hindsight attempt to reconstruct appellants' invention.

With respect to appellants' first point noted above, the projection display aspects of the appealed claims are not met by the LCD panel of Mercedes-Benz and cannot be met by the CRT display of Peterson for reasons discussed above. Since this rejection is based on obviousness rather than anticipation, we must still consider the obviousness of replacing the LCD display of Mercedes-Benz with a projection television display having the claimed features. The examiner only marginally addresses the issue of modifying Mercedes-Benz to change the type of television display.

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In the rejection set forth in Paper #8, the examiner makes the following observations:

While MERCEDES-BENZ employs a liquid crystal television display, many other types of displays including cathode ray tube displays, gas-plasma displays, three beam projector displays, etc. are well known.

... it would have been obvious to one of ordinary skill in the art at the time of the present invention to replace the existing fold-down LCD panel with a CRT projection assembly as shown by PETERSON. Doing so would constitute an obvious substitution of one well known display technology for another. While the television projection display of PETERSON as shown in Figure 2 is probably too large to mount to the roof of a passenger car, one of ordinary skill in the art would have no trouble combining PETERSON's teaching of a retractable screen television display with modern television miniaturization techniques in order to produce a retractable screen television display small enough for mounting to the roof of a passenger car.

Thus, the closest the examiner comes to addressing the issue of the obviousness of substituting a projection display for the Mercedes-Benz LCD display is to assert that the Peterson CRT is a projection display or to suggest that substituting one display for another would be an obvious thing to do.

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On the first point as already noted, we find no basis for the artisan to use the teachings of Peterson to modify the system of Mercedes-Benz. They simply have nothing to do with each other. On the second point, the examiner's bald conclusion that it would have been obvious to substitute one form of television for another is unsupported by this record. Although this is a legitimate point to consider in resolving the obviousness of the claimed invention, this record is devoid of any teachings which would support this position. The examiner has not cited any reference which shows a projection television system of the type required by the appealed claims. Appellants have argued that although LCDs and CRTs have been used in vehicles, projection displays in a mountable housing have not been used in a vehicle. Just because there may be some environments where substituting one form of display for another might be obvious does not serve to make the substitution obvious in all cases. As noted above, this record does not support the examiner's position that it would have been obvious to replace the Mercedes-Benz LCD with a projection television display.

For all the reasons just discussed, we do not sustain the rejection of claims 1-8, 10-20, 22-25, 27-31, 33, 34, 42, 43 and 47 under 35 U.S.C. § 103. Although claims 9, 21, 26, 32, 35-41

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and 44-46 stand rejected under 35 U.S.C. § 103 using the additional teachings of Rose, Rose does not make up for the deficiencies in Mercedes-Benz and Peterson discussed above. Therefore, we also do not sustain the rejection of these claims.

In summary, we have not sustained any of the examiner's rejections of the claims. Accordingly, the decision of the examiner rejecting claims 1-47 is reversed.

REVERSED

	)	
JERRY SMITH	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
LEE E. BARRETT	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
JAMES T. CARMICHAEL	)	
Administrative Patent Judge	)	

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