

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN C. LAYER, GREGORY J. GUZEWICH and LARRY D. HALL

Appeal No. 96-3744
Application No. 08/173,764¹

ON BRIEF

Before PATE, STAAB, 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 1 through 16, which are all of the claims pending in this application.²

¹ Application for patent filed December 27, 1993.

² Claim 16 was amended subsequent to the final rejection.

Appeal No. 96-3744
Application No. 08/173,764

We REVERSE and enter a new rejection pursuant to 37 CFR
§ 1.196(b).

BACKGROUND

The appellants' invention relates to a fail-safe ride simulator. An understanding of the invention can be derived from a reading of exemplary claim 1, 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:

Gwinnett 1931	1,789,680	Jan. 20,
Trumbull 1978 (Trumbull '256)	4,066,256	Jan. 3,
Trumbull et al. 1989 (Trumbull '162)	4,874,162	Oct. 17,

Claims 1, 3 through 11 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Trumbull '256.

Claim 2 stands rejected under 35 U.S.C. § 103 as being unpatentable over Trumbull '256 in view of Trumbull '162.

Claims 12 through 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Trumbull '256 in view of Gwinnett.

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. 10, mailed January 22, 1996) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 9, filed September 29, 1995) and reply brief (Paper No. 11, filed March 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 appealed claims. Accordingly, we will not

sustain the examiner's rejection of claims 1 through 16 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 the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual 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). Rejections based on

§ 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

With this as background, we analyze the prior art applied by the examiner in the rejection of the independent claims on appeal (i.e., claims 1 and 16).

Trumbull '256 discloses an amusement ride. As shown in Figure 1, the amusement ride 10 includes a passenger-holding frame 12, a rear projection screen 16, and a motion picture projector 18. The particular reel of film or record 22 which is being used in the projector, contains scenes representing the view from a rapidly moving vehicle, with the particular

image shown at 20 representing the view seen from a race car which is traveling on a road that curves to the right as indicated by arrow 23. In order to enhance the entertainment effect, the passenger-holding frame 12 is supported on three hydraulic rams 24, 26, 28 that support three locations 30, 32, 34 spaced about the passenger frame. The rams can tip the frame, either to one side or to the front or back, and can also rapidly raise and lower the frame. Figure 6 illustrates a portion of the control system which controls movement of the three rams 24 - 28. The motion picture image is created by an image portion 72 of a film 22 that is contained in the projector. The film includes a sound track 76 along one edge and a motion control track 78 along the opposite edge. Three sensors 80, 82, and 84 respectively sense opposite edges of the track and the density along the center of the track, and deliver corresponding signals to a control circuit 86. Each of the sensors 80 - 84 detects signals representing the position of a different one of the three rams 24 - 28. The control circuit 86 delivers signals corresponding to those detected by the sensors 80 - 84 to three valves 90, 92, 94

that control the passage of pressured oil from an accumulator 96 to the three rams 24 - 28. Three ram position sensors 100, 102, 104 are also provided, each sensing the height of a corresponding one of the rams, and with each position sensor being coupled to the control circuit 86. Thus, a feedback circuit is provided to enable close control of the position of each ram. Each of the rams has a fluid outlet connected through a corresponding valve 110, 112, 114 which leads to a reservoir 106 that stores hydraulic fluid. A pump 108 pumps fluid from the reservoir to the accumulator 96 to maintain a high pressure in the accumulator, so that pressured hydraulic fluid is always available. Each of the outlet valves 110, 112, 114 is electrically energized from the control circuit 86.

Trumbull '256 teaches that each of the inlet valves 90-94 is constructed so that it remains closed when no current is applied to it, and so that it can be opened only upon the application of current. On the other hand, each outlet valve such as 110 is constructed so that it remains open when no current is applied to

it, and can be closed only upon the application of current thereto. As a result, in the event of electrical failure of the system wherein no current is produced by the control circuit 86, the inlet valves 90-94 will be closed while the outlet valves 110-114 will be open. This results in all hydraulic rams 24-28 losing oil so that their pistons move down to the lowest possible elevation. This facilitates the exit of passengers in case of failure, by lowering the frame to a level orientation and at the lowest elevation. If such a system were not utilized and failure occurred while the vehicle was tilted or raised, there could be danger not only in attempting to remove passengers from an elevated and tilted floor, but also there could be danger to workmen helping in the removal of passengers if the frame suddenly descended.

With respect to independent claims 1 and 16, the examiner determined (answer, pp. 4-5) that Trumbull '256 does not specifically teach the functions of the "fail-safe means" recited in claim 1 or the "causing" step recited in claim 16. The examiner then concluded that these limitations are merely desired functions and that the control circuit 86 of Trumbull

'256 is certainly capable of being programmed to perform any desired functions.

We do not agree.

We agree with the appellant's argument (brief, pp. 8-12) that there is no reason or motivation in the applied prior art for one of ordinary skill in this art to modify Trumbull '256 in the manner suggested by the examiner. It appears to us that the examiner has resorted to speculation, unfounded assumption or hindsight reconstruction to supply the above-noted deficiency in Trumbull '256. We have also reviewed Trumbull '162 and Gwinnett but find nothing therein which makes up for the deficiency of Trumbull '256 discussed above. Accordingly, we cannot sustain any of the examiner's rejection of appealed claims 1 through 16 under 35 U.S.C. § 103.

New ground of rejection

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claims 1 through 16 are rejected under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed. In claim 1, the "fail-safe means operatively arranged . . . to cause said platform to move automatically toward a predetermined position relative to said base in the event of any unsafe and uncontrolled condition in said actuation mechanism resulting in . . . **exceeding a predetermined velocity**" is not supported by the original disclosure. In claim 16, the step of "causing said platform to move automatically toward a predetermined position relative to said base, . . . , whenever said servoactuators . . . **exceed a predetermined velocity**" is not supported by the original disclosure.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or

absence of literal support in the specification for the claim language. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

In applying the above-noted test, we conclude that the language at issue (i.e., "exceeding a predetermined velocity" in claim 1 and "exceed a predetermined velocity" in claim 16) is not supported by the original disclosure. The language at issue was added to claims 1 and 16 by the amendment filed on January 9, 1995 (Paper No. 3). On page 5 of that amendment, the appellants stated that the language added is fully supported by the original disclosure and does not constitute "new matter." The appellants directed attention to page 6, lines 32 et seq. for support of the language at issue. Page 6, lines 32 et seq. provide that the electrodynamic braking, which is introduced by the fail-safe system, will limit the actuator velocity. In our view, this does not provide support for causing the platform to move automatically toward a predetermined position relative to the base whenever the

actuation mechanism/servoactuators exceed a predetermined velocity as recited in claims 1 and 16.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 16 under 35 U.S.C. § 103 is reversed and a new rejection of claims 1 through 16 under 35 U.S.C. § 112, first paragraph, has been added pursuant to provisions of 37 CFR § 1.196(b).

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. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. 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 appellants, 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. . . .

(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)

WILLIAM F. PATE, III)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
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APPLICATION NO. 08/173,764

APJ NASE

APJ STAAB

APJ PATE

DECISION: **REVERSED;**
37 CFR § 1.196(b)

Prepared By: Delores A. Lowe

DRAFT TYPED: 04 May 98

FINAL TYPED: