

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD G. ROACH

Appeal No. 1997-4438
Application No. 08/173,431

ON BRIEF

Before HAIRSTON, FLEMING and GROSS, Administrative Patent Judges

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 2, 4-18, and 20. Claim 4 was amended in an Amendment After Final (paper number 19), and claims 3 and 19 have been canceled. Accordingly, claims 1, 2, 4-18, and 20 remain before us on appeal.

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The disclosed invention relates to a method and device that provides the observer of an interactive movie the option of observing the movie from the perspective of a selectable character in the movie.

Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A method for producing a user interactive movie, said method comprising:

recording visual images of a series of events from a first perspective into a digital database capable of recording visual images, said visual images forming a story comprising a sequence of timed events;

recording visual images of the series of events from a second perspective into a digital database, the events as recorded from the second perspective being timed to track the events as recorded from the first perspective;

recording instruction means into a digital database for causing a computer to retrieve and output to a user through user interfaces the visual images as recorded from either the first perspective or second perspective; and

recording instruction means into a digital database for selectively causing said computer to switch from retrieval and output of the visual images recorded from the first perspective to retrieval and output of the visual images recorded from the second perspective at any selected event in the series of events.

The examiner relies on the following references:

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Freeman
1985

4,507,680

Mar. 26,

"Seybold San Francisco '92: A Progress Report," Seybold Report on Desktop Publishing, Vol. 7, No. 3, November 2, 1992, (hereinafter "Seybold")

Boisseau, "Artist bringing unique computerized novel to market," Houston Chronicle, October 5, 1992, pp. 1B and 4B, (hereinafter "Boisseau")

"Interactive Movie Takes Top Honors at Quicktime Film Festival," Hyperbole Studios Press Release, June 3, 1992, (hereinafter "Hyperbole")

Claims 1, 2, 4-13, and 20 stand rejected under 35 U.S.C. § 102(b) based upon public use or sale of the invention as evidenced by appellant's admission (Specification, page 12, lines 27 and 28), and the Seybold, Boisseau, and Hyperbole publications.

Claims 1, 2, 4-11, and 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hyperbole.

Claims 12 and 13 stand rejected under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103 as being unpatentable over Hyperbole in view of statements made by appellant in an amendment (paper number 4).

Claims 14-16 stand rejected under 35 U.S.C. § 103 as

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being unpatentable over Freeman.

Claims 17 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Freeman in view of Boisseau.

Reference is made to the brief and the answer for the respective positions of the appellant and the examiner.

OPINION

The rejections of claims 1, 2, 4 through 13 and 20 are sustained. The rejections of claims 14-18 are reversed.

At the outset, we note that appellant states (Brief, page 10) that "[c]laims 2 and 4-9 are directed toward a computer program per se." Although we do not have a 35 U.S.C. § 101 rejection before us, appellant is reminded that computer programs per se are considered nonstatutory subject matter under 35 U.S.C. § 101.

Appellant states (Specification, page 12) that the interactive film, "The Wrong Side of Town," won Best Narrative category and Best Overall Movie at the QuickTimeFilm Festival in San Francisco in May 1992. According to the examiner (Answer, page 4), appellant's statement verifies public use of the claimed invention more than one year before the filing

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date of the subject application. The examiner states (Answer, pages 4 and 5) that the Seybold, Boisseau, and Hyperbole publications disclose public use of appellant's claimed invention prior to the critical

date of December 27, 1992. Appellant argues (Brief, page 8) that the examiner has not developed "an 'on-sale' argument." Even if the examiner has not developed an "argument" for an on-sale bar, the examiner has most certainly developed an "argument" for public use of the claimed invention. Appellant correctly concludes (Brief, page 9), however, that "[r]esolution of this issue requires an analysis of the totality of the circumstances in light of the policies behind the public use bar. See Tone Bros. v. Sysco Corp., 31 USPQ2d 1321, 1324 (CAFC 1994)."

According to the appellant (Brief, page 9), "the rejected claims were in public use in the sense of being used for a business rather than a private purpose more than a year prior to filing, because the uses were made for the purposes of gaining publicity for the inventor and his company."

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Appellant argues (Brief, page 9) that "the uses were not for the purposes of commercial exploitation of the inventions, and [that] the inventions were not publicly distributed." The examiner contends (Answer, page 4) that appellant has admitted (Specification, page 12) public use of the claimed invention because the invention was "screened" at the trade show "Digital World" in June 1992, and it

won "Best Narrative category" and "Best Overall Movie" at the QuickTimeFilm Festival in San Francisco in May 1992. Boisseau indicates (page 4B, column 1) that the inventor gave several demonstrations of his work at "computer and interactive film shows." Exhibition at a trade show has been deemed to be for exploitative purposes that are commercial by nature. In re Tone Brothers, 28 F.3d 1192, 1199, 31 USPQ2d 1321, 1325 (Fed. Cir. 1994). Testing the market is indicative of commercial exploitation. In re TP Laboratories, Inc. v. Professional Positioners, Inc., 724 F.2d 965, 972, 220 USPQ 577, 583 (Fed. Cir. 1984). Evidence of experimentation is part of the totality of the circumstances considered in a public use

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inquiry. Tone Bros., 28 F.3d at 1198, 31 USPQ2d at 1324. Appellant has not, however, alleged experimentation, and the examiner has correctly concluded (Answer, page 14) that the evidence before us does not suggest such.

When a prima facie case of public use is made by the examiner, the burden shifts to appellant to come forward with evidence establishing the opposite. Inasmuch as appellant has admitted (Specification, page 12, lines 4-6 and 27-28) that his

invention was exhibited in a trade show, appellant has the burden of establishing by evidence that this was not a public use of the claimed invention. Appellant argues (Brief, page 9) that only the results of the invention, rather than the invention itself, were viewed and that the viewing was not enabling. For "public use" under 35 U.S.C. § 102(b), no such enablement requirement is necessary¹. As indicated supra, the totality of the circum-stances test is used to determine

¹ In re Epstein, 32 F.3d 1559, 1568, 31 USPQ2d 1817, 1823 (Fed. Cir. 1994) (quoting J.A. LaPorte, 787 F.2d at 1583, 229 USPQ at 439).

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"public use" under U.S.C.

§ 102(b). Appellant's argument concerning "results of the invention" are, therefore, irrelevant since appellant has not demonstrated that each of the questioned public uses of the claimed invention was not a "consistent, reproducible use of" the claimed invention. W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983). More importantly, there is no requirement that the observer of the public use of the claimed invention must understand how it works.

In reviewing the totality of the circumstances, within the underlying policies of the public use bar, we find that appellant's public use of the claimed invention for the business purpose of gaining publicity for the inventor and his company is a commercial use of the claimed invention. By appellant's own admission (Specification, page 12, lines 4-6 and 27-28), the publications describe the disclosed and claimed invention. Thus, the publications provide enabled disclosures that describe the claimed invention. Even if the publications are not fully enabled, the skilled artisan would

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have known from the teachings and suggestions of the publications how to arrive at the claimed method and device structure. Appellant has not provided any evidence that proves otherwise.

Appellant argues (Brief, page 9) that what was publicly used equates to a black box and that the public was only able to perceive what was coming out the black box not what was inside the box. In view of the absence of a specific description of the disclosed invention in both the specification and the publications, we assume that anyone desiring to carry out the method and device of the disclosed and claimed invention would know of the techniques and equipment to be used. In re Fox, 471 F.2d 1405, 1406, 176 USPQ 340, 341 (CCPA 1973). A prior use is

public even if the invention is completely hidden from view, and even if viewers of the machine incorporating the invention do not comprehend the invention. Stated differently, "we are not aware of any requirement that the person to which an invention is publicly disclosed has to understand the

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significance and the technical complexities of the invention.”
Ex parte Kuklo, 25 USPQ2d 1387, 1390 (Bd. Pat. App. & Int.
1992).

Based upon the foregoing, the burden shifted to appellant to show by evidence that the invention was not reproducible based on public use and the publications describing the invention. Tone Bros., 28 F.3d at 1201, 31 USPQ2d at 1325. Attorney argument in the brief can not take the place of such evidence. In the absence of such evidence, we find that appellant had made “public use” of the claimed invention within the meaning of 35 U.S.C.

§ 102(b) prior to the critical date. In summary, the 35 U.S.C.

§ 102(b) “public use” rejection of claims 1, 2, 4 -13, and 20 is sustained.

Turning to the 35 U.S.C. § 102(b) rejection of claims 1, 2, 4-11, and 20 as being anticipated by Hyperbole, the examiner states (Answer, page 6) that any missing elements in Hyperbole

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are inherently disclosed in the cited reference. The examiner also argues (Answer, pages 9 and 10) that based on applicant's admission it would have been obvious at the time the invention was made to correlate screen positions with known methods. To establish inherency, any extrinsic evidence relied on by the examiner "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991); In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981). According to appellant (Brief, page 11), "'It is elementary that an anticipation rejection requires a showing that each limitation of a claim must be found in a single reference, practice or device.' *In re Donohue*, 226 USPQ 619, 621 (cites omitted) (CAFC, 1985)." In essence, appellant is of the opinion (Brief, page 11) that Hyperbole "is inadequate to form the basis for an anticipation rejection." In light of appellant's admission (Specification, page 12), the publicly displayed works would not have worked without the missing

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elements being manifestly inherent in the

displaying device. As indicated supra, appellant has not produced any evidence that states otherwise. Appellant further argues (Brief, page 12) that Hyperbole describes what the invention is, but not what it does. Again, we find that appellant's admission concerning the contents of the Hyperbole publication places all of the elements of appellant's claimed invention in the publication. As a result thereof, the 35 U.S.C. § 102(b) rejection of claims 1, 2, 4-11, and 20 based upon the teachings of the Hyperbole publication is sustained.

In keeping with the foregoing, the 35 U.S.C. § 102(b)/35 U.S.C. § 103 rejection of claims 12 and 13 based upon the teachings of Hyperbole is sustained.

Turning lastly to the 35 U.S.C. § 103 rejection of claims 14-18, appellant argues (Brief, page 14) that claim 14 "distinguishes the disclosure of Freeman by the requirement that the switching device be connected to the television network via a digital database storage device for temporarily storing the database portions transmitted by the television

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network." We agree with appellant's argument because the examiner has not successfully demonstrated the need for a temporary buffer in the

real-time cable television system disclosed by Freeman. It is impermissible to engage in hindsight reconstruction of the claimed invention, using applicant's structure as a template to fill in the gaps. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). Upon evaluation of all the evidence before us, it is our position that the evidence adduced by the examiner is not sufficient to establish a prima facie case of obviousness with respect to claim 14.

Accordingly, we will not sustain the obviousness rejection of claim 14 and dependent claims 15 and 16. The obviousness rejection of claims 17 and 18 is reversed because the publication to Boisseau does not cure the noted shortcoming in the teachings of Freeman.

In summary, the rejections of claims 1, 2, 4-13, and 20 are sustained, and the rejections of claims 14-18 are reversed.

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DECISION

The decision of the examiner rejecting claims 1, 2, 4-13, and 20 under 35 U.S.C. § 102(b) is sustained. The decision of the examiner rejecting claims 1, 2, 4-11, and 20 under 35 U.S.C. § 102(b) is sustained. The decision of the examiner rejecting claims 12 and 13 under 35 U.S.C. § 102(b) or, in the alternative,

under 35 U.S.C. § 103 is sustained. The decision of the examiner rejecting claims 14-18 under 35 U.S.C. § 103 is reversed. Accordingly, the decision of the examiner is affirmed-in-part.

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

AFFIRMED-IN-PART

KENNETH W. HAIRSTON)
Administrative Patent Judge)

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