

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ATSUSHI MARUYAMA

Appeal No. 1999-0478
Application No. 08/534,106

HEARD: Oct. 10, 2001

Before FLEMING, LALL, and BARRY, Administrative Patent Judges.
BARRY, Administrative Patent Judge.

DECISION ON APPEAL

The examiner rejected the appellant's claims 1, 3-5, and 7-12. He appeals therefrom under 35 U.S.C. § 134(a). We reverse.

BACKGROUND

The invention at issue in this appeal provides entertainment to passengers in an aircraft. Heretofore, a flight attendant sold "admission" to a film shown on an aircraft by renting headphones for connection to audio ports

or adapters for connection between headphones and audio ports to passengers.

Without the headphones or adapters, passengers could not hear the soundtrack of the film. To prevent passengers from using their own headphones to listen to the soundtrack, the aircraft's headphones, adapters, and ports were customized. Unfortunately, the rented headphones or adapters were sometimes lost.

In contrast, the appellant's invention includes a hand-held remote controller for use by a flight attendant. He uses the remote controller to indicate which passengers have paid for a movie. When the flight attendant so signals a receiver, an associated controller enables reception of the soundtrack to be broadcast to those passengers' seats.

Claim 1, which is representative for present purposes, follows:

1. A signal supplying/receiving system comprising:

an operating unit for a passenger provided in association with each of a plurality of seats within a vehicle, and

a supplying device for supplying data signals over a plurality of channels to said operating units,

said plurality of seats being divided into groups, each group comprising at least two seats,

wherein each said operating unit comprises selecting means for selecting one of said plurality of channels supplied from said supplying device,

said selecting means associated with the seats in one of said groups of seats being controlled by controlling means,

said controlling means selectively inhibiting selection of one or more of said channels by said selecting means, said controlling means selectively inhibiting selection of one or more of said channels by said selecting means,

said controlling means being connected to a remote control signal receiving unit responsive to

a

remote control signal,

wherein said remote control signal, received by said receiving unit, identifies one of said seats in the group of seats, and, in response to said remote control signal, said controlling means cease to inhibit selection of said one or more inhibited channels by the selecting means associated with the seat which is identified by said remote control signal.

The prior art applied by the examiner in rejecting the claims follows:

Kuo 1984	4,428,078	Jan. 24,
Hildebrandt et al. ("Hildebrandt") 1988	4,774,514	Sep. 27,
Kondo et al. ("Kondo") 1989	4,835,604	May 30,
Edwards et al. ("Edwards") 1994.	5,311,325	May 10,

Claims 1, 3, 4 and 7-12 stand rejected under 35 U.S.C. § 103 as being obvious over Kondo in view of Edwards and Hildebrandt.

Claim 5 stands rejected under § 103 as being obvious over Kondo in view of Edwards and Hildebrandt, further in view of Kuo. Rather than reiterate the arguments of the appellant or examiner in toto, we refer the reader to the briefs and answer for the respective details thereof.

OPINION

After considering the record, we are persuaded that the examiner erred in rejecting claims 1, 3-5, and 7-12.

Accordingly, we reverse.

We begin by summarizing the examiner's rejection. Admitting that Kondo "does not expressly discuss inhibiting the selection of one or more channels, and then granting permission to those channels via a remote signal," (Examiner's Answer at 4), the examiner asserts, "it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the channel granting scheme of Edwards in the distribution system of Kondo to increase flexibility in the fee based service provided in airplanes." (Id.)

The appellant makes two arguments. First, he argues, "a skilled artisan addressing the problems of providing in-flight movies, simply would not logically turn to a cable television network spread across a city to assist a flight attendant handing out headphones." (Reply Br. at 6.)

Edwards, however, is analogous art. "Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved." In re Clay, 966 F.2d 656, 658-59, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992)(citing In re Deminski, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986) and In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979)). Determining whether a reference is from the same field of endeavor "depends upon the necessary essential function or utility of the subject matter covered by the claims, and not upon what it is called. For example, a tea mixer and a concrete mixer are for the same art, namely the mixing art, this being the necessary function of each." M.P.E.P. § 904.01(c)(6th ed., rev. 3, July 1997). Also, "a reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's

attention in considering his problem.... If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection." Clay, 966 F.2d at 659, 23 USPQ2d at 1061.

Regarding the first criterion, the appellant's invention is in the field of providing entertainment. Specifically, his "invention is designed primarily for use when showing movies" (Appeal Br. at 3.) Edwards also provides entertainment. Specifically, the reference's invention "provid[es] periodic subscription television services." Col. 4, ll. 1-2. Because both the appellant's and Edwards' inventions are from the field of providing entertainment, the reference is within the field of the inventors' endeavor.

Regarding the second criterion, the appellant is involved with supplying selected programming only to paying customers. Specifically, "[t]his audio signal supplying device has a fee channel and an ordinary non-fee channel. The fee channel furnishes a special program to the passenger subject to

payment of a prescribed fee." (Spec. at 4.) Similarly, a problem that Edwards solves also relates to supplying selected programming only to paying customers. Specifically, "pay-per-view service communications are utilized at service denial apparatus for periodically permitting and denying service to subscribers in a subscription television system." Col. 4, ll. 59-63. Because both the appellant's and Edwards' inventions solve the problem of supplying selected programming only to paying customers, the reference is reasonably pertinent to the particular problem with which the inventor is involved. Under either criterion, Edwards is analogous art.

Second, the appellant argues, "even if Kondo and Edwards were in analogous arts, there is no motivation to combine their teachings as the Examiner has proposed found outside the Applicant's disclosure." (Appeal Br. at 9.)

The examiner fails to identify a persuasive suggestion to combine the teachings of the references. "[I]dentification in the prior art of each individual part claimed is insufficient

to defeat patentability of the whole claimed invention. In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citing In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998)). "Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant." Id., 55 USPQ2d at 1316 (citing In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) and In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). "[E]vidence of a suggestion, teaching, or motivation to combine 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" In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)(citing Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996) and Para-Ordinance Mfg. v. SGS Imports Intern., Inc. , 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995)). "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, 157 F.3d at 1352, 48 USPQ2d at 1232. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" Id., 50 USPQ2d at 1617 (citing McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) and In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977)).

Here, although Edwards discloses periodic subscription television services, the examiner fails to show clear and particular evidence of the desirability of using such services in Kondo's "audio/video system for entertaining passengers" Kondo, col. 1, ll. 12-14. Specifically, there is no evidence to support his stated reason for combining the references, viz., to increase flexibility in a fee based service. More specifically, Kondo does not charge a fee for its entertainment. To the contrary, "passengers can freely utilize VTRs **111-115**, CD

players **121-129** and game programs in cartridges **141-147** in the system's normal operating mode." Col. 6, ll. 45-48. Because Kondo provides free entertainment, there is no fee-based service to be made more flexible by the addition of Edwards.

Relying on Hildebrandt to show an "addressing scheme," (Examiner's Answer at 4), and Kuo to show a "shared receiver method," (id. at 5), the examiner fails to allege, let alone show, that the additional references cure the aforementioned deficiency. Because there is no fee-based service in Kondo to be made more flexible by the addition of Edwards, we are not persuaded that teachings from the prior art would have suggested combining the two references. Therefore, we reverse the rejection of claims 1, 3-5, and 7-12.

