BLAIR.001A PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Owner: Scott Blair
Examiner: Stephen J. Ralis
Filing Date: August 16, 2011
For: **SUBWAY TV MEDIA SYSTEM**

Control No.: 90/011,861
Gr. Art Unit: 3992

APPEAL BRIEF PURSUANT TO 37 CFR 41.37

Dear Sir or Madam:

In response to the Final Office Action in *Ex Parte* Reexamination dated April 25, 2012 ("Final *Ex Parte* Office Action") and the Advisory Action in *Ex Parte* Reexamination dated January 16, 2013 ("*Ex Parte* Advisory Action"), Patent Owner herein files an appeal brief for the above-identified application.

Real Party in Interest

Scott Blair (the Patent Owner for Reexamination Control No. 90/011,861) is the real party in interest.

Related Appeals and Interferences

Not Applicable.

Status of Claims

Claims 1 – 18 and 20 – 30 are now pending in the application.

Per the *Ex Parte* Advisory Action, Claim 1 stands rejected, Claims 2 – 7 are not subject to reexamination and Claims 8 – 18 and 20 – 30 are patentable and/or confirmed.

Patent Owner herein explicitly appeals the rejection of Claim 1.

Status of Amendments

Patent Owner has not submitted amendments to any of the claims subsequent to the *Ex Parte* Advisory Action (see also the response to the Final *Ex Parte* Office Action dated June 25, 2012).

Summary of Claimed Subject Matter

Claim 1 – Claim 1 discloses a subway car for mass transportation including longitudinal opposed sidewalls disclosed at, *inter alia*, FIGS. 1A and 1B, as well as at FIG. 2, along with its accompanying disclosure of Patent Owner's specification. The subway car includes a ceiling adjoining the sidewalls disclosed at, *inter alia*, FIG. 4a, along with its accompanying disclosure

at Col. 5, lines 35 – 49 of Patent Owner's specification. The subway car also includes a video display system comprising a plurality of video display monitors each having a video screen disclosed at, *inter alia*, Col. 5, lines 35 – 49 and Col. 5, lines 4 – 7 of Patent Owner's specification. The subway car further includes a video signal source unit operatively connected to the monitors disclosed at; *inter alia*, Col. 5, lines 4 – 7 of Patent Owner's specification. The monitors are spaced along the length of the car on opposed sides thereof disclosed at, *inter alia*, Col. 1, lines 45 – 50 as well as at Col. 4, lines 57 – 59 of Patent Owner's specification. Each of the monitors are mounted at the junction of the sidewall and ceiling disclosed at, *inter alia*, Col. 3, line 67 – Col. 4, line 6 and Col. 4, lines 64 – 67 of Patent Owner's specification. The screen of the monitor is substantially flushed with the adjacent wall surface structure of the car disclosed at; *inter alia*, Col. 5, lines 40 – 42 of Patent Owner's specification. The screen of the monitor is further directed obliquely downwardly toward the car seats, so that each video screen is readily visible to passengers in the subway car disclosed at, *inter alia*, Col. 4, line 67 – Col. 5, line 4 of Patent Owner's specification.

Grounds of Rejection to be Reviewed

1. Whether Claim 1 is unpatentable under 35 U.S.C. §102(b) as being anticipated by Minesaki (Japanese Publication No. JP 63-125984 of Japanese Application No. JP 61-272668, hereinafter "Minesaki").

2. Whether Claim 1 is unpatentable under 35 U.S.C. §102(b) as being anticipated by Amano et al. (Japanese Publication No. JP 02-23985A, hereinafter "Amano").

3. Whether Claim 1 is unpatentable under 35 U.S.C. §103(a) as being unpatentable over Maekawa et al. (Japanese Publication No. JP 04-160991A, hereinafter "Maekawa") in view of Amano.

4. Whether Claim 1 is unpatentable under 35 U.S.C. §103(a) as being unpatentable over Minesaki in view of Moore et al. (U.S. Patent No. 3,480,727, hereinafter "Moore").

5. Whether Claim 1 is unpatentable under 35 U.S.C. §103(a) as being unpatentable over Amano in view of Moore.

6. Whether Claim 1 is unpatentable under 35 U.S.C. §103(a) as being unpatentable over Maekawa and/or Shinagawa et al. (Japanese Publication No. JP 04-160991A, hereinafter "Shinagawa"), either in view of Amano and Moore.

Arguments

I. Rejection of Claim 1 Under 35 U.S.C. § 102 as Being Anticipated by Minesaki

Claim 1 – Patent Owner respectfully submits that it is well established that *"[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or*

inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See also MPEP §2131.

With regards to the Office's rejection of Claim 1 as being anticipated by Minesaki, Patent Owner respectfully traverses. Specifically, Minesaki fails to expressly or inherently describe: (1) *"each of said monitor being mounted at the junction of the sidewall and ceiling"*; (2) *"with the screen of the monitor substantially flushed with the adjacent wall surface structure of the car"*; and (3) *"directed obliquely downwardly toward the car seats"*.

With regards to the claimed feature *"each of said monitor being mounted at the junction of the sidewall and ceiling"*, Minesaki appears to only contemplate two configurations for mounting the information transmission display (part J). Specifically, one such configuration contemplated by Minesaki is an *"information display part J ... which is suspended and hangs down from the ceiling"*. {emphasis added} Such a configuration as described does not expressly or inherently describe mounting the monitor at the junction of the sidewall and ceiling.

Minesaki's second configuration contemplates that the *"information transmission display part J may also be formed on the sidewall 9 of the train car."* {emphasis added} Accordingly, Minesaki only appears to contemplate suspending the information transmission display part from the ceiling, or alternatively, forming the information transmission display part on the sidewall of the train car, and respectfully does *not* expressly contemplate mounting the monitor at the junction of the sidewall and ceiling. Furthermore, The Office alleges at page 100 of the Final *Ex Parte* Office Action that Fig. 2 of Minesaki illustrates the information transmission display part J at the junction of the sidewall and the ceiling.

Furthermore, Patent Owner respectfully submits that it is clear that the drawing of Fig. 2 is not intended to be to scale, and that the drafting quality of Fig. 2 is poor. Patent Owner notes that per MPEP §2125:

> *"When the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. See Hockerson-Halberstadt, Inc. v. Avia Group Int'l, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000)"*

For example, and as illustrated in Fig. 2, the information transmission display parts J are shown as being curved along the top portion of the display. However, Minesaki provides no mention or explanation for this curvature in its specification, and it would appear that such a curved feature is quite unusual in that it seemingly affects only the very top portion of the display shown in FIG. 2, which optically would seem to distort the light rays emanating from the display in an inconsistent manner (and hence distort at least a portion of any image displayed thereon, akin to a prism). Accordingly, it is believed that this drawing (Fig. 2) is at best unreliable (and at worst, inconsistent) in its teachings when considered without the context of the two configurations discussed *supra* provided by the written detailed description, and would not expressly or inherently describe a monitor being *"mounted at the junction of the sidewall and ceiling"* to one of ordinary skill in the art.

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Furthermore, with regards to the claimed feature *"with the screen of the monitor substantially flushed with the adjacent wall surface structure of the car"*, the Office alleges that the term *"substantially"* is often used in conjunction with another term to describe a particular characteristic of the claimed invention, and is further construed to be a broad term (citing MPEP §2173.05). While Patent Owner agrees that the term *"substantially"* is construed broadly, the use of the term *"substantially"* cannot be construed so broadly as to read the term *"flushed"* completely out of the claim. See e.g., *Exxon Chem. Patents v. Lubrizol Corp.*, 64 F.3d 1553, 1555 (Fed. Cir. 1995), *cert. denied*, 518 U.S. 1020 (1996), as it believes the Office's interpretation has done.

Furthermore, Patent Owner notes that terms in its claims must be interpreted in light of Patent Owner's specification as filed; see MPEP § 2111; *"During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." Phillips v. AWH Corp., 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005)"* {emphasis added}). Fig. 2 of Minesaki is reproduced below for the convenience of the Office.

Fig. 2

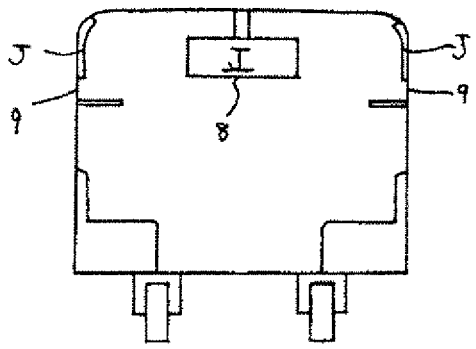

Figure 2 of Minesaki

As can be seen, there is not a single part of the information transmission display (part J) illustrated in Fig. 2 which can reasonably be considered to be flush with the adjacent wall surface (as Patent Owner has used that term in its specification and Claim 1); in fact, the entire information transmission display part J of Minesaki clearly protrudes away from the adjacent wall surface. Patent Owner refers the Office to FIG. 4a of its specification (reproduced below for convenience), which clearly shows an embodiment of Patent Owner's invention that has a *screen* that is substantially flushed with the adjacent wall surface (as explicitly recited in Claim 1), and with no protrusion of the display (as occurs in Minesaki). As indicated in Patent Owner's specification regarding FIG. 4a, (See, e.g. Col 5, lines 42 – 45 of Patent Owner's specification) this configuration gives a better aesthetic appearance to the inside of the subway car as a whole, as well as improving the display performance by minimizing the interference effects.

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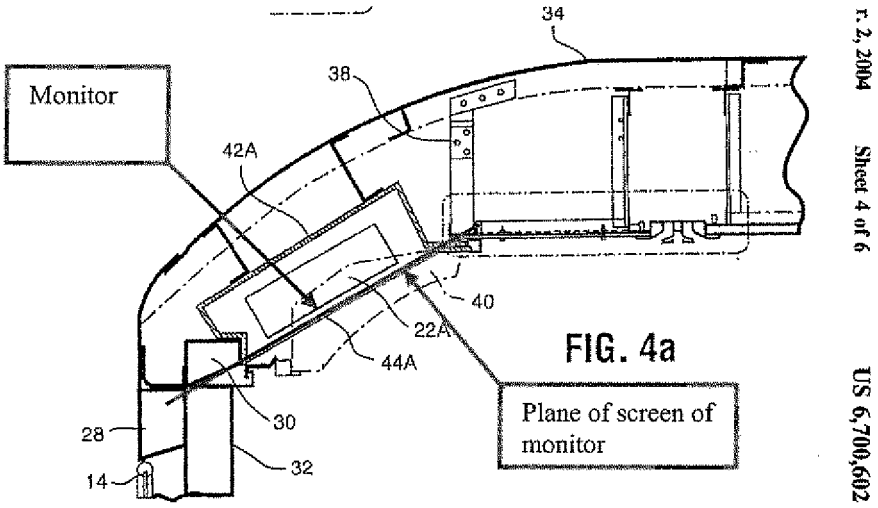

FIG. 4a

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Accordingly, Patent Owner respectfully submits that the Office's interpretation of the term *"substantially flushed"* is improper, as the Office's interpretation completely reads out the claimed *"flushed"* feature, and obscures what is meant by *"substantially flushed"* as clearly described throughout Patent Owner's specification and figures. Patent Owner's specification clearly describes a subway car with video monitors that appear integral with the design of the subway car (see, e.g., Col. 4, lines 8 – 13 of Patent Owner's specification). Furthermore, the Patent Owner's specification and figures are indicative of monitors that are built within the inner spaces and below the surface structure of the interior of the subway car so as to achieve the stated goal of making the video display monitors appear integral with the inside structure of the subway car (see e.g., Col. 3, line 55 to Col. 4, line 9). No attempt has been made by Minesaki to expressly place the information transmission display parts within the inner spaces of the adjacent interior surface structure of the car, nor is Minesaki concerned about having the information transmission display parts screen *"substantially flush"* with the adjacent surface structure. In response to Patent Owner's previous assertions, the Office states that the term flush is *"examined as 'forming a continuous plane or unbroken surface.'"* Furthermore, the Office alleges that the screen of the display monitor illustrated in FIG. 4a above can never form a continuous plane or unbroken surface with the adjacent wall surface structure. However, the Office alleges that this is the case because the screen is further behind the transport screen of the enclosure (see page 103 of the *Ex Parte* Office Action). Patent Owner submits that although the screen of the monitor is behind the transport screen in the illustrated embodiment, the use of the transport screen would give the appearance of a flush mounted monitor (e.g., *"substantially flush"*), even though the screen of the monitor would actually be slightly offset from the adjacent wall surface structure of the car. Again, contrast with Minesaki, which illustrates information transmission display parts which would clearly not give the appearance of a flush mounted monitor, instead showing its information transmission display parts sitting on top of the wall surface. In fact, if the drawings of Minesaki were taken literally, the information transmission display parts would protrude out from the wall approximately four (4) times the thickness of the wall, or alternatively, would protrude away from the wall at a distance approximately equal to the back portion of the seats illustrated in Minesaki. Clearly, such a configuration cannot be considered to be *"substantially flush"*.

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