

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte RAHUL G. PATEL and PAUL J. BROYLES

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Appeal No. 2003-0357  
Application 09/123,307

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ON BRIEF

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

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-27, which constitute all the claims in the application.

The disclosed invention pertains to a technique for selectively presenting a first and second video image to a video output device. The technique uses two video buffers, one holding a cover or clean screen, and the other holding a verbose screen. Upon execution of the startup instructions, the output of the first or second video buffer is provided to the display device depending on whether the video device is in the clean mode or the verbose mode.

Representative claim 1 is reproduced as follows:

1. In a computer system having a processor, a bus coupled to the processor, a memory coupled to the bus, and a video output device coupled to the bus, the memory containing a first video buffer and a second video buffer and further containing a set of startup instructions, the video output device having a clean mode and a verbose mode, a method of selectively presenting a first and second video image to the video output device, the method comprising the steps of:

executing the startup instructions, and upon execution of the startup instructions:

determining whether the mode of the video output device is the clean mode or the verbose mode;

when the video output device is in the clean mode, providing a first image to the video output device, the first image being defined by the contents of the first video buffer; and

when the video output device is in the verbose mode, providing a second image to the video output device, the second image being defined by the contents of the second video buffer.

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The examiner relies on the following references:

Engstrom et al. (Engstrom) 5,801,717 Sep. 1, 1998  
"Basic PC 97," file:C:\compaq\CH03.HTM, (9/15/98), Chapter 3,  
pages 1-29.

Claims 1-27 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Engstrom in view of Basic PC 97.

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

OPINION

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

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill

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in the art the obviousness of the invention as set forth in claims 1-27. Accordingly, we reverse.

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 Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness.

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Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived by appellants [see 37 CFR § 1.192(a)].

With respect to each of independent claims 1, 7, 16 and 25-27, the examiner essentially finds that Engstrom teaches the claimed invention except that "Engstrom et al do not teach expressly that the processor executing the startup instructions, and upon execution of the startup instructions: determining whether the mode of the video output device is the clean mode or the verbose mode, displaying a first image defined by the contents of the first video buffer, or a second image defined by the contents of the second video buffer, respectively, and

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corresponding to a first state or a second state selected by the video output controller" [Final Rejection, December 13, 2000, incorporated into answer at page 3]. The examiner cites Basic PC 97 as teaching a computer system which has a display device having a clean mode or a verbose mode during system startup. The examiner finds that it would have been obvious to the artisan to utilize the system startup instructions as taught by Basic PC 97 in Engstrom and making use of Engstrom's two buffers.

Appellants argue, inter alia, that Engstrom's system is directed to application programs and not to startup instructions or system startup code. Appellants also argue that the two buffer system of Engstrom does not meet the claimed invention because the front buffer in Engstrom is always used to display the current image. Appellants note that Engstrom specifically teaches away from the double buffering technique. Appellants argue that there is no need to determine whether the video output device is in the clean mode or the verbose mode in Basic PC 97 because Basic PC 97 only has one mode. Appellants assert that there is no motivation to combine the power-on self-test approach of Basic PC 97 with the software application approach of Engstrom because Engstrom teaches away from double buffering and Basic PC 97 has only one mode of display. Finally, appellants argue that

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the specific rationale set forth by the examiner for combining the teachings of Engstrom and Basic PC 97 is nothing more than an opinion by the examiner and is not supported by the applied prior art [brief, pages 7-22].

The examiner responds that Basic PC 97 does have a clean mode and a verbose mode. The examiner also responds that Engstrom teaches two video buffers in which one buffer would store the clean mode and the second buffer would store the verbose mode. The examiner repeats his position that it would have been obvious to the artisan to run the system startup of Basic PC 97 in Engstrom's computer system because such implementation would provide selectable display modes capable of conveniently and effectively presenting display images, which provide to the user the enhanced functionality of the computer system [answer, pages 3-8].

Appellants respond that the teachings of Basic PC 97 are too vague to suggest to one skilled in the art to use first and second video buffers in the manner recited in the independent claims. Appellants assert that there is no suggestion to use double buffers for low level startup programs as claimed. Appellants reiterate that Engstrom teaches away from using double buffering techniques as claimed. Finally, appellants reiterate

the argument that there is no verbose mode taught in Basic PC 97 [reply brief].

We will not sustain the examiner's rejection of independent claims 1, 7, 16 and 25-27. Basic PC 97 discloses that the system, by default, displays a clean BIOS startup screen. This default condition and the fact that the clean BIOS startup screen can be turned off and on might reasonably suggest to the artisan that Basic PC 97 has a non-clean startup or verbose startup screen as well. Therefore, we are not convinced that Basic PC 97 has only a clean mode as argued by appellants.

Nevertheless, we agree with appellants that the buffering technique taught by Engstrom does not meet the limitations of the appealed claims. As argued by appellants, the display device in Engstrom always outputs the contents of the front buffer. The contents of the buffers are flipped to ensure that the front buffer always points to the contents to be displayed. The examiner has failed to respond to this argument. Even if Basic PC 97 was determined to have two modes, and even if the two modes were stored in the two buffers of Engstrom, of which there is no suggestion, the display device in Engstrom would still only display the contents of the front buffer rather than the contents of two buffers in the manner claimed.

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We also agree with appellants that there is no suggestion within the applied prior art that the two buffer technique taught by Engstrom for use with complex applications would have any benefit when used at system startup with a display device having two modes of operation. The examiner's proposed motivation is based on an advantage obtained for complex applications and goes against the teachings of Engstrom for use of double buffering techniques. The examiner's proposed motivation for combining the teachings also assumes a benefit which is completely speculative on the part of the examiner and is not specifically suggested by either of the applied references.

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In summary, we have not sustained the examiner's rejection with respect to any of the independent claims on appeal. Therefore, we also do not sustain the rejection with respect to any of the dependent claims on appeal. Accordingly, the decision of the examiner rejecting claims 1-27 is reversed.

REVERSED

JERRY SMITH	)	
Administrative Patent Judge	)	
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	)	
	)	
LEE E. BARRETT	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
JOSEPH F. RUGGIERO	)	
Administrative Patent Judge	)	

JS/ki

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