

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT S. HAMILTON

Appeal No. 2006-0785
Application No. 09/683,531

ON BRIEF

Before HAIRSTON, JERRY SMITH, 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 1-18, which constitute all the claims pending in this application.

The disclosed invention pertains to an addressable bistable display device which is usable as a label for recording media.

Representative claim 1 is reproduced as follows:

1. An addressable display useable as a label for recording media, comprising:

a bistable display device usable as the label, the label including:

an energy source that generates an operating signal;
an embedded optical data link for bi-directional communication with a recording/play device; and

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a microcontroller that receives the operating signal generated by the energy source and a signal from the optical data link and provides a control signal to the bistable display device so that an image is generated on the label of the recording media, wherein the label is automatically updated by the recording/play device.

The examiner relies on the following references:

Bloch et al. (Bloch)	5,745,102	Apr. 28, 1998
Albert et al. (Albert)	6,118,426	Sep. 12, 2000

Claims 1-18 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Bloch in view of Albert.

Rather than repeat the arguments of appellant 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 appellant's 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.

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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 have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we affirm.

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

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(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. 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 appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

With respect to independent claims 1, 9, 10 and 18, the examiner essentially finds that Bloch teaches the claimed invention except for teaching that the display device is a bistable display device. The examiner cites Albert as teaching a

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bistable display device. The examiner finds that it would have been obvious to the artisan to modify Bloch's display label to be a bistable display as taught by Albert [answer, pages 3-8].

Appellant argues that the claimed invention is directed to a label having certain claimed features whereas Bloch teaches these features incorporated directly on or in a housing of a floppy disk. Appellant asserts that Bloch does not disclose, suggest or contemplate a label of any type having the claimed features. Appellant also argues that Albert fails to disclose or suggest an addressable display usable as a label for recordable media and having the claimed features [brief, pages 9-12].

The examiner responds that Bloch and Albert both teach a display that is usable as a label. The examiner reiterates that Bloch teaches all the features related to the claimed label and that Albert teaches the advantages of a bistable display device [answer, pages 8-13].

Appellant responds that Bloch teaches a specially-designed floppy disk housing rather than the display label as claimed. With respect to independent claims 9 and 18, appellant additionally argues for the first time that Bloch fails to disclose the claimed user configurable pattern electrodes.

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Appellant also argues that there is no motivation to combine the teachings of Bloch and Albert because Albert does not teach an addressable display having the claimed features and because Albert relates to a different problem from the claimed invention [reply brief, pages 2-6].

With respect to independent claims 1 and 10, we will sustain the examiner's rejection. We are not persuaded by appellant's argument that Bloch fails to teach or suggest a display device used as a label. Even though neither the examiner nor appellant has specifically defined what is meant by the term "label," it is clear that they disagree on whether the display taught by Bloch can be considered to be a label within the meaning of the claims. Bloch indicates that his invention is intended to overcome the shortcomings of conventional adhesive labels [column 1, lines 57-58]. Thus, the display disclosed by Bloch replaces the conventional adhesive label. We agree with the examiner that the display of Bloch can be called a label within the broadest reasonable interpretation of that term because the display indicates the contents of the disk to which it is attached. We also note that Bloch teaches that the disclosed display mechanism "could be mounted ... on an adhesive-backed device, ... and

affixed to a conventional data storage device" [column 11, lines 46-50]. Thus, Bloch specifically suggests that the disclosed display mechanism could be adhesively attached to a floppy disk in the same manner as conventional adhesive labels. Therefore, in our view, Bloch specifically teaches an addressable display used as a label as asserted by the examiner.

With respect to appellant's argument that Albert fails to teach an addressable display usable as a label having the features recited in claims 1 and 10, this argument is unpersuasive because Bloch teaches the features of the display recited in claims 1 and 10. Albert is cited only to show the advantages of a bistable display and provide the motivation for modifying the display of Bloch to be a bistable display. Albert teaches that a bistable display consumes no power [column 2, line 22] and can be used in applications where paper is currently the display medium of choice [column 7, lines 14-16]. Since Bloch's display is intended to replace a conventional paper label, and since Albert teaches that replacing paper labels with a bistable display conserves power, we agree with the examiner that the artisan would have been motivated to modify the Bloch display to use bistable elements so that power would be conserved as taught

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by Albert. Appellant's arguments notwithstanding, we agree with the examiner that the teachings of Albert are combinable with the teachings of Bloch for the limited purpose of making the display label in Bloch a bistable display.

With respect to independent claims 9 and 18, we will sustain the examiner's rejection. These claims differ from claims 1 and 10 in the recitation of "user configurable pattern electrodes" and "configuring a set of electrodes." Appellant asserts that configuration of the electrodes in Bloch is transparent to the user so that they are not user configurable. The examiner asserts that electrodes 316 in Bloch are shaped to display all numbers and letters. As with the term "label" discussed above, it is not clear that the examiner and appellant have interpreted "user configurable pattern electrodes" in the same manner. We note that Bloch teaches that the display can use seven segment devices, 12 segment devices or 5x7 dot matrix elements [column 4, lines 40-48]. Each of these display configurations would have a different pattern of electrodes. Thus, we are of the view that the user selection of the type of display in Bloch, each of which has a different pattern of electrodes, represents user configurable pattern electrodes within the broadest reasonable

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interpretation of the claimed invention. Although the examiner appears to be relying on the fact that the display elements in Bloch can display different characters, we do not think it is necessary to determine whether the different characters in Bloch meet the recitation of user configurable pattern electrodes since Bloch specifically teaches that different patterns for displaying characters can be used.

With respect to the dependent claims, we sustain the examiner's rejection of each of the dependent claims because appellant has offered no arguments with respect to any of these claims. Therefore, we have sustained the examiner's rejection with respect to each of the claims on appeal. Accordingly, the decision of the examiner rejecting claims 1-18 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JERRY SMITH)	APPEALS
Administrative Patent Judge)	AND INTERFERENCES
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