

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANAND KRISHNAMURTHY, MUTHU VENKATESH
MUTHURAJ, BENJAMIN D. NOVATZKY, and
STEVEN LAWRENCE FORS

Appeal 2007-1414
Application 10/453,559
Technology Center 2600

Decided: July 26, 2007

Before KENNETH W. HAIRSTON, JOSEPH L. DIXON, and
HOWARD B. BLANKENSHIP, *Administrative Patent Judges*.
DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's Final Rejection of claims 1-3, 5-8, 16-18, 20-23, and 53-86. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

BACKGROUND

Appellants' invention relates to a key image note (KIN) display and annotation system and method. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method for displaying an image, comprising:
 - receiving a digital image;
 - receiving one or more annotations associated with the digital image;
 - categorizing the one or more annotations based on an annotation characteristic of each annotation; and
 - displaying the digital image on an operator interface, wherein the categorization of the one or more annotations associated with the digital image at least partially determines a display characteristic of the one or more annotations associated with the digital image.

PRIOR ART

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

| | | |
|------------|--------------------|---------------|
| Rothschild | US 2002/0016718 A1 | Feb. 07, 2002 |
| Turek | US 6,429,878 B1 | Aug. 06, 2002 |

Meron US 2002/0171669 Nov. 21, 2002

REJECTIONS

Claims 1-3, 5-8, 16-18, 20-23, and 58-69 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claims 1, 2, 5-8, 16, 17, 20-23, 53-69, 71-80, and 82-86 are rejected under 35 U.S.C. § 102(e) as being anticipated by Meron. Claims 3, 18, 70, and 81 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Meron in view of Turek and in view of Rothschild.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellants regarding the above-noted rejection, we make reference to the Examiner's Answer (mailed Nov. 29, 2006) for the reasoning in support of the rejections, and to Appellants' Brief (filed Sep. 5, 2006) and Reply Brief (filed Feb. 1, 2007) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to Appellants' Specification and claims, to the applied prior art references, and to the respective positions articulated by Appellants and the Examiner. As a consequence of our review, we make the determinations that follow.

35 U.S.C. § 112, First Paragraph

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. *See Vas-Cath,*

Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). Compliance with the written description requirement is essentially a fact-based inquiry that will “necessarily vary depending on the nature of the invention claimed. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991) (quoting *In re DiLeone*, 436 F.2d 1404, 1405, 168 USPQ 592, 593 (CCPA 1971)), quoted with approval in *Enzo*, 323 F.3d at 963, 63 USPQ2d at 1612.

Here, the Examiner maintains that:

The specification fails to teach determining a display characteristic of the one or more annotations associated with the digital image. At the most an annotation's priority will determine the display order or location of the annotations. The term "display characteristic" covers much more than that which is disclosed on page 9. Color, intensity, rotation, movement, etc are examples of display characteristics. Since the claim specifically recites "display characteristic" then the claim is clearly covering display characteristics that are not disclosed by the specification and claims away from that which is discussed on page 9 line 20 to page 10 line 9 of applicants specification. Therefore, the application fails to convey that applicant had possession of the currently claimed invention. (Answer 3-4).

Appellants dispute the Examiner’s requirement for the need to explicitly disclose all examples of an invention. Appellants rely upon the following legal premise in the Reply Brief at pages 2-3.

A claim will not be invalidated on section 112 grounds simply because the embodiments of the specification do not contain examples explicitly covering the full scope of the claim language. *See Union Oil Co. v. Atl. Richfield Co.*, 208 F.3d 989, 997 [54 USPQ2d 1227] (Fed. Cir. 2000). That is because the patent specification is written for a person of skill in the art, and such a person comes to the patent with

the knowledge of what has come before. *In re GPAC Inc.*, 57 F.3d 1573, 1579 [35 USPQ2d 1116] (Fed. Cir. 1995). Placed in that context, it is unnecessary to spell out every detail of the invention in the specification; only enough must be included to convince a person of skill in the art that the inventor possessed the invention and to enable such a person to make and use the invention without undue experimentation. (Emphasis removed).

LizardTech, Inc. v. Earth Resource Mapping, Inc., 424 F.3d 1336, 1345, 76 USPQ2d 1724, 1732 (Fed. Cir. 2005).

We agree with Appellants and conclude that the level of specificity in the instant Specification is sufficient to support the claimed “display characteristic.” We find the instant Specification clearly identifies that Appellants were in possession of the claimed “display characteristic.”

Appellants’ original Specification at page 10, lines 1-8 supports the instant claim language specifically by the recitation of “some other KIN characteristic” and “the viewer may configure the display location of the KIN 54 based upon other characteristics.” While the specific examples are limited in the Appellants’ Specification, it is clear from Appellants’ Specification that Appellants did not limit the possession of the invention by listing the enumerated examples. Therefore, we will not sustain the rejection of all the claims under 35 U.S.C. § 112 for a lack of written description.

ANTICIPATION

“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). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a

determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

"It is well settled that a prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless inherent in it. Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates." *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002) (citations and internal quotation marks omitted). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999) (citations and internal quotation marks omitted).

"[A] prima facie case of anticipation [may be] based on inherency." *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138-39 (Fed. Cir. 1986). Once a prima facie case of anticipation has been established, the burden shifts to the Appellant to prove that the prior art product does not necessarily or inherently possess the characteristics of the claimed product. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977) ("Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes,

the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product."). *See also In re Spada*, 911 F.2d 705, 708-09, 15 USPQ2d 1655, 1657-58 (Fed. Cir. 1990).

From our review of the instant claims and the prior art rejection, applied by the Examiner, we will sustain the rejection of independent claim 1 and independent claim 16 grouped therewith by Appellants. First, we note that the language of independent claim 1 recites "receiving one or more annotations" and "categorizing the one or more annotations." Interpreting independent claim 1 to include a single annotation, and placing that single annotation on the digital image and on a timeline, we find the teaching of Meron to meet the express limitations of independent claim 1. We find that the use of a single category of annotation gives an *a priori* categorizing of the annotation which would meet the language of independent claim 1. Furthermore, the Examiner has identified that Appellants include time as one of the explicit categories in Appellants' Specification at page 9, line 29 which we find to be similar to the teachings of Meron (Answer 7-8).

Additionally, we find that each individual unit of time may be deemed to be a separate category and the proper placement on the image and the appropriate time and relative location on the image and timeline is a categorizing step. Finally, we note that Meron also teaches that other information may be displayed and information may be displayed in other sets or windows or not displayed in windows in paragraph [0031]. Meron additionally states in paragraph [0034] that an annotation may automatically be created when such conditions (low motility or for blood in the GI tract)

are seen and the user may access a set of bookmarks which refer the user to the portions of the moving image where such conditions exist. We find this teaching to teach the use of categorization of annotations/bookmarks into sets and display thereof to the user. We find that this automatic generation teaches the receiving annotations/bookmarks from the system and associating them with the digital image as claimed. Therefore, we find that Meron teaches the invention as recited in independent claim 1 for the above varied reasons.

As advanced by Appellants in the discussion with respect to the written description, we find the language of display characteristic to be broad, and not limited by the Specification. Therefore, we find the above discussion of interpretation to be reasonable and the application of Meron to be reasonable as discussed above.

Appellants' main contention in the Brief and Reply Brief is that Meron does not teach categorizing the annotations since there is only one category of time taught by Meron (Br. 9-10 and Reply Br. 4-6). We disagree as discussed above due to the instance where there is one annotation which is categorized by time or may be categorized due to a specific GI tract condition(s). Appellants argue that the Examiner's claim interpretation extends beyond the broadest reasonable interpretation in light of the disclosed invention. (Reply Br. 5). We disagree with Appellants and find the express language of the claim to be broader than Appellants may have desired. Here, we find Appellants reliance upon the dictionary definitions at page 5 of the Reply Brief to be unpersuasive since we find the categorizing or classifying of annotations with respect to time to meet the express

limitations of independent claim 1 and taught by Meron. Therefore, we find that Appellants have not shown error in the Examiner's initial showing and we will sustain the rejection of independent claims 1 and 16 and their respective dependent claims 2, 5-8, 17, 20-23, 58-63, and 64-69.

With respect to independent claims 53 and 76, Appellants contend that Meron does not teach receiving a prioritization preference and filtering a set of annotations (Reply Br. 6). We disagree with Appellants and find that Meron teaches in paragraph [0034] that an annotation may automatically be created when such conditions (low motility or for blood in the GI tract) are seen and the user may access a set of bookmarks which refer the user to the portions of the moving image where such conditions exist. We find this teaching to teach the use of categorization of annotations/bookmarks into sets with display thereof to the user. We find that this automatic generation teaches the receiving annotations/bookmarks from the system and associating them with the digital image as claimed. Additionally, we find that the user's request for this data would have been a prioritization preference and the data would have been filtered to present the appropriate set of data to the user.

Appellants argue that the Examiners' reliance upon time as a preference is in error since that is a single mandatory manner of listing the data (Reply Br. 6-7). We agree with Appellants, but we find that the Examiner does identify paragraph [0034] in the discussion of independent claim 1 which identifies that time is not the only manner for user preference to be used in the display. Therefore, we find our reliance upon those teachings in our discussion above to be reasonable since the Examiner has

identified them in the statement of the rejection. Therefore, we find that Meron teaches the invention recited in independent claim 53 and independent claim 76 which Appellants elected to group therewith and their respective dependent claims 54-57, 71-79, and 81-86.

Obviousness

Appellants elected to rely upon the asserted deficiencies under 35 U.S.C. § 102 and that Turek and Rothchild do not remedy the deficiency in Meron. Since we found no deficiency in Meron and Appellants have not presented separate arguments for patentability under 35 U.S.C. § 103(a), we sustain the rejections of claims 3, 18, 70, and 81 under 35 U.S.C. § 103(a).

CONCLUSION

To summarize, we have reversed the rejection of claims 1-3, 5-8, 16-18, 20-23, and 58-69 under 35 U.S.C. § 112, first paragraph; we have sustained the rejection of claims 1, 2, 5-8, 16, 17, 20-23, 53-69, 71-80, and 82-86 under 35 U.S.C. § 102; and we have sustained the rejection of claims 3, 18, 70, and 81 under 35 U.S.C. § 103(a).

Appeal 2007-1414
Application 10/453,559

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

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