

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte KOSTA ILIC*

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Appeal 2007-1740  
Application 09/726,776  
Technology Center 2600

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Decided: July 24, 2007

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Before JOSEPH F. RUGGIERO, ROBERT E. NAPPI, and JEAN R. HOMERE, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from the Examiner's rejection of claims 1-31. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

Appellant's claimed invention relates to the magnification of a display of a signal waveform in which a virtual magnification symbol is positioned

by a user over a desired portion of the signal waveform. The magnified portion of the signal waveform is displayed at a location proximate to the position of the selected waveform portion before magnification, thereby enabling viewing of the magnified waveform portion within the context of the entire waveform. (Specification 5-6).

Claim 1 is illustrative of the invention and reads as follows:

1. An instrument for collecting data and which displays the data to a user, comprising:
  - a memory for storing data corresponding to a signal waveform; and
  - a display which displays the data as the signal waveform, wherein said display is also operable to display a virtual magnifying symbol;
  - wherein the virtual magnifying symbol is operable to be positioned over a portion of the signal waveform;
  - wherein the portion of the signal waveform is located at a first location in the signal waveform;
  - wherein the portion of the signal waveform is magnified on the display after positioning the virtual magnifying symbol over the portion of the signal waveform;
  - wherein the magnified portion of the signal waveform is displayed proximate to the first location in the signal waveform.

The Examiner relies on the following prior art references to show unpatentability:

Alexander	US 6,229,536 B1	May 8, 2001 (filed Mar. 5, 1998)
Engholm	US 6,642,936 B1	Nov. 4, 2003 (filed Aug. 8, 2000)
Rosen	US 6,938,218 B1	Aug. 30, 2005 (filed Apr. 28, 2000)

Claims 1-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Alexander in view of Engholm. Claim 31 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Alexander in view of Rosen.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Brief and Answer for the respective details. 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 C.F.R. § 41.37(c)(1)(vii)].

## ISSUES

- (1) Under 35 U.S.C § 103(a), with respect to appealed claims 1-30, would one of ordinary skill in the art at the time of the invention have been motivated and found it obvious to combine Alexander with Engholm to render the claimed invention unpatentable.
- (2) Under 35 U.S.C § 103(a), with respect to appealed claim 31, would the ordinarily skilled artisan have been motivated and found it obvious to combine Alexander with Rosen to render the claimed invention unpatentable.

## PRINCIPLES OF LAW

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 must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Furthermore, “‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)(quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).

## ANALYSIS

With respect to the 35 U.S.C. § 103(a) rejection of independent claim 1 based on the combination of Alexander and Engholm, Appellant’s arguments in response assert a failure by the Examiner to establish a *prima facie* case of obviousness since proper motivation for the Examiner’s proposed combination of references has not been established. After reviewing the disclosures of the prior art Alexander and Engholm references in light of the arguments of record, we are in general agreement with the Examiner’s position as stated in the Answer.

Appellant’s arguments (Br. 9-10) focus on the contention that motivation for the proposed combination of references is lacking because Alexander and Engholm have different objectives. Appellant contends (*id.*,

at 10) that the objective of Alexander “is to display a main waveform and a magnified waveform in two separate windows on the same display while Engholm’s objective is to fill the display with one waveform.”

We do not find Appellant’s argument to be persuasive since it is apparent to us from the Examiner’s stated position (Answer 3, 4, 11, and 12) that the Examiner is not suggesting the bodily incorporation of the single display screen feature of Engholm into the device of Alexander. Rather, it is Engholm’s teaching of the use of a virtual magnifying symbol (zoom rectangle 12) movable by a user over a portion of a waveform to be magnified that is relied on as a rationale for the proposed combination. “The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.... Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art.” *See In re Keller*, 642 F.2d 414, 425, 208 USPQ 871, 881 (CCPA 1981) and *In re Nievelt*, 482 F.2d 965, 968, 179 USPQ 224, 226 (CCPA 1973).

We also make the observation that, although the Examiner has relied upon Engholm to supply a teaching of the use of a movable virtual magnifying symbol, we find that Alexander in fact already uses such a symbol, which takes the form of movable rectangular window 340, as illustrated in Alexander’s Figure 9. This rectangular window is movable by a user (Alexander, Figures 3B and 3C) to be positioned over a portion of an original waveform to be magnified. Further, although Alexander displays the magnified portion of the signal waveform in a separate display window 336, the claimed requirement that the magnified waveform portion be

displayed “proximate to the first location in the signal waveform” does not distinguish over such an arrangement.

In view of the above discussion and analysis of the disclosure of the Alexander reference, we find that all of the claimed elements are in fact present in the disclosure of Alexander. Further, we find that Engholm supplements Alexander’s teachings to establish the Examiner’s *prima facie* case for the claims being obvious over the combination of those references. Therefore, it is our view that the Examiner did not err in concluding that the combination of Alexander and Engholm renders the cited claims unpatentable.

For the above reasons, since it is our opinion that the Examiner has established a *prima facie* case of obviousness which has not been overcome by any convincing arguments from Appellant, the Examiner’s 35 U.S.C. § 103(a) rejection of claim 1, as well as claims 2, 4-10, 12-19, and 21 not separately argued by Appellant, is sustained.

We also sustain the Examiner’s 35 U.S.C. § 103(a) rejection of separately argued dependent claims 11 and 20. We do agree with Appellant’s interpretation of the disclosure of Engholm which concludes that it is not the magnifying glass icons 18 or 20 which are positioned over a signal waveform portion to be magnified as required by appealed claim 11. We make reference to our earlier discussion, however, which concluded that the virtual magnifying symbol in Engholm is in fact the zooming rectangle 12 (as with the moving rectangle 340 in Alexander). In our view, the magnifying glass icon 18 in Engholm, positioned inside the zooming rectangle 12, identifies and characterizes the virtual magnifying zooming rectangle symbol as a “magnifying glass” symbol as claimed.

With respect to claim 20, we agree with the Examiner (Answer 13) that as the boundaries of the moving rectangle 340 in Alexander are adjusted, i.e., moved, to include a larger waveform portion, the additional waveform portions are magnified. To whatever extent Appellant may be correct in the assertion (Br. 13) that enlarging the area of magnification in Alexander requires redefining the magnifying window, i.e., the virtual magnifying symbol, there is no claim language which precludes redefining window boundaries to implement moving of the magnifying window.

We also sustain the Examiner's obviousness rejection of independent claim 31 based on the combination of Alexander and Rosen. We find no error in the Examiner's finding (Answer 15) that the ordinarily skilled artisan would have recognized that Rosen's teaching of a magnifying symbol placed over an area to be magnified and which has the magnified area displayed inside the symbol would serve as an obvious enhancement to the device of Alexander. We find Appellant's arguments (Br. 16) in response to be similar to those made with respect to the Examiner's rejection of claim 1 based on the combination of Alexander and Engholm, and we find them equally unpersuasive. We do not interpret the Examiner's position as suggesting the bodily incorporation of Rosen's web page magnifier into the device of Alexander. Rather, it is Rosen's teaching of a magnifying symbol in which an area of magnification is displayed inside the symbol that is relied upon as a basis for the proposed combination with Alexander.

Turning to a consideration of the Examiner's 35 U.S.C. § 103(a) rejection, based on the combination of Alexander and Engholm, of dependent claim 3 and independent claim 22 (and its dependent claims 23-

30, we note that, while we found Appellant's arguments to be unpersuasive with the respect to the Examiner's obviousness rejection of claims 1, 2, 4-21, and 31, we reach the opposite conclusion with respect to the rejection of claims 3 and 22-30. Rejected claims 3 and 22-30 require either that the magnified portion of the signal waveform be displayed "within the signal waveform" (claim 3) or that the signal waveform is "magnified within the original waveform" (independent claim 22).

We agree with Appellant that, even if Alexander and Engholm were combined as proposed by the Examiner, the ensuing combination would not satisfy the claimed requirements. As asserted by Appellant (Br. 11, 12, 14), Alexander discloses the display of a magnified portion of a signal waveform in a separate display window while Engholm discloses the display (Figure 2) of a magnified waveform portion in which the original displayed waveform is pushed off the screen. We recognize that, in support of the stated position of obviousness, the Examiner, in the "**Response to Argument**" portion of the Answer at pages 12 and 14, makes reference to the "zoom-out" embodiment disclosed by Engholm at column 2, lines 21-29. While the Examiner is correct that in Engholm's "zoom-out" embodiment, the entire original waveform is shrunk and displayed within the zoom rectangle, there would then be no portion of the original waveform which would be magnified so as to satisfy the requirements of the rejected claims.

Accordingly, since we are of the opinion that the proposed combination of Alexander and Engholm does not support the obviousness rejection, we do not sustain the rejection of dependent claim 3, nor of independent claim 22 and its dependent claims 23-30.

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## CONCLUSION

With respect to the Examiner's 35 U.S.C. § 103(a) rejection of appealed claims 1-31, we have sustained the rejection of claims 1, 2, 4-21, and 31, but have not sustained the rejection of claims 3 and 22-30. Accordingly, the Examiner's decision rejecting appealed claims 1-31 is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(effective September 13, 2004).

## AFFIRMED-IN-PART

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