

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KIPPEI KOJIMA, HIRONORI NAKATANI,
YASUYUKI WATANABE, and AKIRA SAKAMOTO

Appeal 2008-0337
Application 10/170,447
Technology Center 2600

Decided: March 20, 2008

Before JOSEPH F. RUGGIERO, ANITA PELLMAN GROSS, and
MAHSHID D. SAADAT, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of claims 1-19. We have jurisdiction under 35 U.S.C. § 6(b). An oral hearing on this appeal was conducted on March 12, 2008.

We reverse.

Appellants' invention relates to the display control of an image in which a display controller outputs an image signal in response to an address conversion parameter included in a control signal provided by an external device. A display address generator performs address conversion to generate a display address of the display panel with an image signal being output to the display panel in accordance with the generated display address. According to Appellants, the generation of display addresses by the display address generator eliminates the need for a large address bus between the external device and the display controller. (Specification 7-10).

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

1. A display controller which outputs an image signal to a display panel in response to image data and an address conversion parameter indicating how to generate an address of each pixel with respect to the image data which are supplied from an external device,

the display controller comprising:

display address generating means for generating a display address of the display panel in accordance with the address conversion parameter, wherein actual address information of any pixel with respect to the image data is not sent from the external device to the display controller but is instead generated within the display controller itself, wherein an address bus from the external device to the display controller is not necessary; and

image signal outputting means for outputting the image data as the image signal in accordance with the display address which is generated by the display address generating means.

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

Kagawa	US 5,063,526	Nov. 5, 1991
Ishizuka	US 6,479,940 B1	Nov. 12, 2002 (filed Sep. 14, 2000)
Boursier	US 6,795,062 B1	Sep. 21, 2004 (filed Jun. 21, 1999)

Claims 1-19 stand rejected under 35 U.S.C. § 112, first paragraph, as being based on an inadequate disclosure.

Claims 1-3, 5-8, and 14-18 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Boursier.

Claims 4 and 10-12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Boursier in view of Kagawa.

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Boursier in view of Ishizuka.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs and Answer for the respective details. 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 Briefs have not been considered and are deemed to be waived [see 37 C.F.R. § 41.37(c)(1)(vii)].

ISSUES

(i) Under 35 U.S.C § 112, first paragraph, with respect to appealed claims 1-19, would the skilled artisan have recognized in Appellants' disclosure a description of the claimed invention in accordance with the "written description" requirement of the statute.

(ii) Under 35 U.S.C § 102(e), does Boursier have a disclosure which anticipates the invention set forth in claims 1-3, 5-8, and 14-18?

(iii) Under 35 U.S.C § 103(a), with respect to appealed claims 4 and 10-12, would one of ordinary skill in the art at the time of the invention have found it obvious to modify Boursier by adding the teachings of Kagawa to render the claimed invention unpatentable?

(iv) Under 35 U.S.C § 103(a), with respect to appealed claim 9, would one of ordinary skill in the art at the time of the invention have found it obvious to modify Boursier by adding the teachings of Ishizuka to render the claimed invention unpatentable?

PRINCIPLES OF LAW

Written Description

The function of the written description requirement of the first paragraph of 35 U.S.C. § 112 is to ensure that the inventor has possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him. *In re Wertheim*, 541 F.2d 257, 262 (CCPA 1976), *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991). In establishing a basis for a rejection under the written description requirement of the statute, the Examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 263.

Anticipation

It is axiomatic that anticipation of a claim under § 102 can be found if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992). Anticipation of a patent claim requires a finding that the claim at issue “reads on” a prior art reference. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed. Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

Obviousness

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 (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 (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 (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 (2007)(quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

ANALYSIS

35 U.S.C. § 112, first paragraph, rejection

The Examiner has taken the position that Appellants’ disclosure lacks a written description of the claimed feature, present in each of the appealed independent claims 1, 14, and 15, of the generation of a display address of an image to be displayed in which the “actual address information of any pixel” is not sent from the external device to the display controller.

According to the Examiner (Ans. 3, 4, and 12), Appellants’ Specification, for example, at pages 13 and 14, describes the information in the control signal (CTL) sent from the external device central processor to the display controller as including start address information, which the Examiner interprets as the actual start address of at least one pixel.

We agree with Appellants (App. Br. 11-12), however, that a skilled artisan would have recognized Appellants’ description of the information sent from the external device to the display controller as not including actual address information of any pixel as claimed. In making this determination,

we agree with Appellants (Reply Br. 5-6) that the claim terminology “actual address information,” when read in light of the Specification, must be interpreted as referring to the address generated by the display controller, i.e., the converted address, after it operates on the source address information in accordance with the address conversion parameters. It is apparent that this interpretation is correct when the “wherein” clause containing the “actual address information” terminology in question in each of the independent claims 1, 14, and 15 is read in the context of the immediately preceding claim language and the address conversion language in the claim preamble.

With the above discussion in mind, it is our view that one of ordinary skill, when reading Appellants’ Specification, particularly the discussion at pages 22 and 23, would recognize that it is only source address information and address conversion parameters that are being sent from the external device to the display controller. The actual address information (the address after conversion) of any of the pixels is not sent to the display controller but is generated by the display controller in accordance with the transmitted address conversion parameters. We would also point out that, although Appellants’ Specification does not use the terminology “actual address information,” it is well settled that the subject matter of a claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.

In view of the above discussion, it is our opinion that, under the factual situation presented in the present case, the statutory written description requirement has been satisfied because Appellants were clearly in possession of the claimed invention at the time of filing of the application.

Therefore, we do not sustain the Examiner's rejection of claims 1-19 under the first paragraph of 35 U.S.C. § 112.

35 U.S.C. § 102(e) rejection

With respect to the 35 U.S.C. § 102(e) rejection of independent claims 1, 14, and 15 based on Boursier, the Examiner indicates (Ans. 5-7, 11, and 12) how the various limitations are read on the disclosure of Boursier. In particular, the Examiner directs attention to the portion of the disclosure of Boursier at column 3, lines 42-65, as well as the illustration at Figure 4 of Boursier.

Appellants' arguments in response assert that the Examiner has not shown how each of the claimed features is present in the disclosure of Boursier so as to establish a prima facie case of anticipation. Appellants' arguments (App. Br. 8-9; Reply Br. 3-4) focus on the contention that, in contrast to the claimed invention, Boursier discloses that actual address information of at least one pixel is sent from the external device 4 to the display controller 50.

After reviewing the disclosure of Boursier in light of the arguments of record, we are in general agreement with Appellants' position as stated in the Briefs. Our interpretation of the disclosure of Boursier coincides with that of Appellants, i.e., while Boursier discloses (col. 4, ll. 1-5) that the source and destination address generators 61 and 62 of the animation circuit 50 generate addresses of the image block to be displayed, this address generation is based upon the receipt of the actual source address and actual destination address of the first point, i.e., pixel, of the block. (Boursier, col. 3, ll. 56-59).

In other words, in Boursier, there is no conversion of the source and destination addresses of the first image pixel to an actual source and destination address since, contrary to the Examiner's contention (Ans. 5 and 11) that only address "parameters" are being sent, the actual source and destination addresses of the first image pixel are in fact transmitted to the animation circuit 50 from the external device. Accordingly, since Boursier does not provide a disclosure that the actual address information of *any* pixel is not sent from the external device to the display controller, the requirements of independent claims 1, 14, and 15 are not satisfied.

In view of the above discussion, since all of the claim limitations are not present in the disclosure of Boursier, we do not sustain the Examiner's 35 U.S.C. § 102(e) rejection of independent claims 1, 14, and 15, nor of claims 2, 3, 5-8, and 16-18 dependent thereon.

35 U.S.C. § 103(a) rejections

We also do not sustain the Examiner's obviousness rejections of dependent claims 4 and 10-12, in which Kagawa is added to Boursier, and dependent claim 9 in which Ishizuka is added to Boursier. The Examiner has added Kagawa and Ishizuka to Boursier to address, respectively, the claimed features of image rotation and electroluminescent display. We find nothing in the disclosures of Kagawa or Ishizuka, taken individually or collectively, which overcomes the innate deficiencies of Boursier discussed *supra*.

CONCLUSION

In summary, we have not sustained the Examiner's 35 U.S.C. § 112, first paragraph, rejection of claims 1-19, the 35 U.S.C. § 102(e) rejection of claims 1-3, 5-8, and 14-18, nor the 35 U.S.C. § 103(a) rejections of claims 4, 9, and 10-12. Therefore, the Examiner's decision rejecting claims 1-19 is reversed.

REVERSED

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