

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MARY A. METELKO

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Appeal 2008-1238  
Application 10/301,417  
Technology Center 2600

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Decided: September 3, 2008

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Before KENNETH W. HAIRSTON, JOSEPH F. RUGGIERO,  
and MARC S. HOFF, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from the Final Rejection of claims 1-18. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Appellant's invention relates to the optimizing of the bandwidth of a wireless link between a display device and an image data player. The display device, which is configured with various bandwidth reduction parameters that affect its bandwidth capacity, wirelessly communicates the bandwidth reduction parameters to the image data player. Upon receipt of the bandwidth reduction parameters, the image data player is able to transform image data in accordance with the parameters and deliver device-specific image data to the display device. (Spec. 4).

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

1. A method of communicating image data from an image data player to a display device, the image data player programmed to transform the image data in accordance with display device parameters, comprising the steps of:
  - transmitting bandwidth reduction parameters from the display device to the player, the bandwidth reduction parameters comprising at least parameters representing flow control, storage capacity, and rendering capability of the display device; and
  - receiving transformed image data from the player in the display device;wherein the transmitting and receiving steps are performed via a wireless link.

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

Estevez

US 2003/0017846 A1

Jan. 23, 2002

(eff. filed Jun. 12, 2001)

Claims 1-8 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Estevez.

Claims 9-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Estevez.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Briefs 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 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 § 102(e), does Estevez have a disclosure which anticipates the invention set forth in claims 1-8?
- (ii) Under 35 U.S.C § 103(a), with respect to appealed claims 9-18, would one of ordinary skill in the art at the time of the invention have found it obvious to modify Estevez to render the claimed invention unpatentable?

## PRINCIPLES OF LAW

### 1. 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 Pharmaceutical Corp.*, 432 F.3d 1368, 1375 (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).

## 2. 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. § 102(e) REJECTION

With respect to the 35 U.S.C. § 102(e) rejection of independent claim 1 based on the teachings of Estevez, the Examiner indicates (Ans. 3-4) how the various limitations are read on the disclosure of Estevez. In particular, the Examiner directs attention to the illustrations in Figures 3, 5, 8, and 9 of Estevez as well as the portions of the disclosure at ¶’s 0020, 0024, 0026, 0028, 0031, and 0033 of Estevez.

Appellant’s arguments in response assert that the Examiner has not shown how each of the claimed features is present in the disclosure of Estevez so as to establish a prima facie case of anticipation. According to Appellant (App. Br. 5-7), in contrast to the claimed invention, the Estevez reference provides no disclosure of the transmission of bandwidth reduction parameters from a display device to an image data player. After reviewing the Estevez reference in light of the arguments of record, we are in general agreement with Appellant’s position as stated in the Briefs.

Our interpretation of the disclosure of Estevez coincides with that of Appellant, i.e., while several drawing illustrations in Estevez (e.g., Figures 8 and 9) suggest two-way communication between an image player and a display device, there is no indication as to what, if anything, is being transmitted from the display device to the image player. In particular, there

is no indication that bandwidth reduction parameters are being transmitted from the display device to the image player as specifically set forth in independent claim 1.

We recognize that the Examiner has asserted (Ans. 8) that the ordinarily skilled artisan would have recognized that the 802.11 protocol frame structure used by the system of Estevez would have included data representative of flow control, storage capacity, and rendering capability, all parameters which could be considered bandwidth reduction parameters. We simply find, however, no evidence on the record before us to support such a conclusion. Further, even assuming, *arguendo*, the correctness of the Examiner's position, there remains no indication that such bandwidth reduction parameters are actually being transmitted from the display device to the image player in Estevez.

In view of the above discussion, in order for us to sustain the Examiner's rejection, we would need to resort to impermissible speculation or unfounded assumptions or rationales to supply deficiencies in the factual basis of the rejection before us. *In re Warner*, 379 F.2d 1011, 1017, 154 (CCPA 1967). Accordingly, since all of the claim limitations are not present in the disclosure of Estevez, we do not sustain the Examiner's 35 U.S.C. § 102(e) rejection of appealed independent claim 1, nor of claims 2-8 dependent thereon.

35 U.S.C. § 103(a) REJECTION

*Dependent claim 9*

The Examiner's obviousness rejection, based on Estevez, of claim 9, which is dependent upon previously discussed independent claim 1, is not sustained. In addressing the language of dependent claim 9, the Examiner (Ans. 5-6) asserts the obviousness to the skilled artisan of using an optical link as the form of the claimed wireless communication. Regardless of the merits of the Examiner's position, however, the Estevez reference remains deficient, for all of the previously discussed reasons, in disclosing the transmission of bandwidth reduction parameters from the display device to the image data player as required by independent claim 1.

*Claims 10-18*

We also do not sustain the Examiner's 35 U.S.C. § 103(a) rejection, based on Estevez, of independent claim 10, and its dependent claims 11-18. We refer to our earlier discussion with respect to independent claim 9 and note that we simply find no disclosure in Estevez of any transmitter in the display device which functions to transmit bandwidth reduction parameters to the image data player as specifically set forth in appealed independent claim 10.

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## CONCLUSION

In summary, we have not sustained either of the Examiner's rejections of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-18 is reversed.

REVERSED

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