

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN DOUGLAS REED,
JACK ANTHONY SMITH,
and DANNY PINCKLEY

Appeal 2008-3194
Application 09/855,388
Technology Center 2600

Decided: September 29, 2008

Before MAHSHID D. SAADAT, ROBERT E. NAPPI,
and CARLA M. KRIVAK, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 1-7, 9-13, and 15-19, which are all of the claims pending in this application as claims 8, 14, and 20 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

Appellants' invention relates to a method of displaying data including an image on a display with two separate display portions separated by a visible seam, such as a folding display (Spec. 1).

Claim 1 is representative of the claims on appeal and reads as follows:

1. A method for processing data including an image for presentation on a display having a first display portion and a second display portion, the first and second display portions separated by a visible seam having a location and a width, the method comprising the steps of:

locating a position on at least one of the first and second display portions for displaying the image; and

displaying the image in said position such that, when said position extends beyond one of the display portions and onto a next one of the display portions, a portion of the image corresponding to the location of the visible seam is omitted,

wherein the data includes attributes for controlling at least one of scaling and placement of the image on the display and identifying important areas of the image, and

wherein the locating step comprises the step of scaling and locating the image and protecting the important areas in accordance with the attributes.

The prior art applied in rejecting the claims on appeal is:

Hecht	US 4,751,659	Jun. 14, 1988
Caine	US 5,361,078	Nov. 1, 1994
McNelley	US 5,438,357	Aug. 1, 1995
Forcier	US 5,590,257	Dec. 31, 1996
Bricklin	US 5,680,152	Oct. 21, 1997
Banitt	US 5,963,247	Oct. 5, 1999
Sakaihara	JP 2-79090	Mar. 19, 1990

The rejections as presented by the Examiner are as follows:

Claims 1, 9, and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sakaihara and McNelley.¹

Claims 2, 3, 10, and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sakaihara, McNelley, and Hecht.

Claims 4, 11, and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sakaihara, McNelley, and Banitt.

Claims 5, 12, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sakaihara, McNelley, and Bricklin.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Sakaihara, McNelley, and Caine.

Claims 7, 13, and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sakaihara, McNelley, and Forcier.

Rather than repeat the arguments here, we refer 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 did not make in the Briefs have not been considered and are deemed waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103. Appellants do not dispute the Examiner's reading of the claimed features on the prior art teachings, they merely focus on whether the combination of Sakaihara and McNelley would

¹ Throughout this opinion, our references to Sakaihara are to its English translation provided by the USPTO Translation Branch on Aug. 5, 2003.

have been obvious to one of ordinary skill in the art (App. Br. 8-11). Therefore, the issue turns on whether there is a legally sufficient justification for combining the disclosures of Sakaihara and McNelley and if so, whether the combination of the applied references teaches the claimed subject matter.

PRINCIPLES OF LAW

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. *See In re Kahn*, 441 F.3d 977, 987-988 (Fed. Cir. 2006), *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991) and *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007).

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR*, 127 S. Ct. at 1739-40). “One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims.” *KSR*, 127 S. Ct. at 1742.

The *KSR* Court further recognized that “[w]hen there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason

to pursue the known options within his or her technical grasp.” *KSR*, 127 S. Ct. at 1732. In such circumstances, “the fact that a combination was obvious to try might show that it was obvious under §103.” *KSR*, 127 S. Ct. at 1742.

“[A] reasonable expectation of success, not absolute predictability” supports a conclusion of obviousness. *In re Longi*, 759 F.2d 887, 897 (Fed. Cir. 1985). *See also In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (“Obviousness does not require absolute predictability.”).

ANALYSIS

Appellants specifically contend that Sakaihora does not describe any use of its electronic stained glass in the teleconferencing system of McNelley (App. Br. 9). Additionally, Appellants argue that the patterns and pictures displayed by Sakaihora are neither dynamic to involve tracking a moving object (App. Br. 10), nor include important parts that need to be displayed (App. Br. 11; Reply Br. 5). Appellants assert that the alleged goal to ensure that an important part of an image is displayed is not a proper motivation for combining the references (*id.*).

The Examiner responds that Sakaihora recognizes the problem of cutting a part of the display image due to the separation between different portions of the display, while McNelley addresses the problem of displaying a moving object by using “quick track” to ensure that the important part of the image remains within the display portion (Ans. 19). The Examiner further concludes that one of ordinary skill in the art would have been motivated by the teachings of McNelley to place the important part of the image within the display areas of Sakaihora to ensure that the important

parts of the image would not be omitted if positioned in the area between the display portions (*id.*).

Upon review of Sakaiharu and McNelley, we find ourselves in agreement with the Examiner's stated rationale for combining the references. In that regard, Sakaiharu clearly teaches that the part of the image corresponding to the area between adjacent display areas is eliminated in order to display a continuous image across the displays (Sakaiharu 3). McNelley, on the other hand, recognizes that if a conferee moves during a teleconferencing session having a stationary image pickup device, the important part of the image, i.e., the face of the conferee, may not be in the image area that is displayed (col. 4, ll. 38-59). McNelley, therefore, provides an image manipulation technique (col. 5, ll. 5-14) for tracking the conferee such that the important part of the image remains in the displayed frame (col. 6, ll. 34-38). This technique includes scaling or positioning the image with respect to the viewing window (col. 6, ll. 34-65). We find that, as argued by the Examiner (Ans. 19), the technique disclosed by McNelley suggests more efficient display of a moving object, which is equally applicable to a display comprising one single display device or multiple display devices similar to those disclosed in Sakaiharu. Therefore, we remain unconvinced by Appellants' arguments against the combinability of the references since using *KSR* and *Leapfrog* standards, the evidence provided by the Examiner supports a finding that combining the familiar displaying techniques of Sakaiharu and McNelley would have been obvious to one of ordinary skill in the art because the combination is based on an obvious solution to displaying a moving image which produces predictable results.

In addressing whether a motivation to combine is disclosed to one of ordinary skill in the art by either Sakaihara or McNelley (App. Br. 11), we note that the combination is not about putting components from each reference together, but takes into account the concepts of displaying an image on multiple display devices to create a continuous image on a multi-pane display and capturing the important part of an image in a display. Here, according to *KSR*, McNelley provides an obvious solution to a known problem. A person of ordinary skill has a reasonable expectation of success to pursue the known options related to scaling and framing the important part of an image of McNelley that are available and obvious to try. Therefore, in view of our analysis above, we find that the teachings of Sakaihara and McNelley, when considered as a whole, support the Examiner's § 103 ground of rejection.

CONCLUSION OF LAW

Because Appellants have failed to point to any error in the Examiner's position, we sustain the various 35 U.S.C. § 103(a) rejections of claims 1-7, 9-13, and 15-19, which are argued as being in error for the same reasons as the rejection of claim 1 (App. Br. 11).

DECISION

The decision of the Examiner rejecting claims 1-7, 9-13, and 15-19 is affirmed.

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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).

AFFIRMED

KIS

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