

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL V. STEIN

Appeal No. 1997-2895
Application 08/280,341

ON BRIEF

Before HAIRSTON, LALL and GROSS, Administrative Patent Judges.
LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection¹ of claims 1 to 14 and 16 to 30. Claim 15 has been withdrawn from consideration.

¹ An amendment after the final rejection was filed as paper no. 16 and was entered in the record for the purposes of this appeal [paper no. 18].

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The invention relates to an educational environment. By means of a network, a control workstation is connected to a multiplicity of other workstations. The former is for a teacher while the latter for the students. When the teacher desires to observe what is displaying on the displays of the students, the teacher sends a command to the student workstations. The student workstations reduce the images on their displays and transmit the data of the reduced images to the teacher's workstation. Thus, the teacher is able to simultaneously see on the display of the control workstation the reduced images from the displays of a plurality of student workstations.

Claim 1 is reproduced below as illustrative of the invention.

1. In a networked computer system having at least one control workstation and a multiplicity of other workstations, each having an associated display device for displaying information being processed at the respective workstations, a method for displaying information from the display devices of a plurality of said other workstations on the display device of said control workstation, comprising the steps of:

generating a command to said plurality of other workstations to provide the control workstation display information;

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processing the information being displayed on the display devices at each of said plurality of other workstations to produce data relating to a reduced-size reproduction of the information being displayed;

transmitting said reduced-size reproduction data to said control workstation;

storing the reduced-size reproduction data received from each of said plurality of other workstations at said control workstation; and

simultaneously displaying a reduced-size reproduction of the information displayed at each of said other workstations at respective locations on the display device for said control workstation.

The Examiner relies on the following references:

Stefik et al. (Stefik)	4,974,173	Nov. 27, 1990
Abrahamson et al. (Abrahamson)	5,002,491	Mar. 26, 1991
Piovosso et al. (Piovosso)	5,294,998	Mar. 15, 1994

Claims 1, 7, 16, 19, 20, 23, 24, 26 and 29 stand rejected under 35 U.S.C. § 102 over Stefik. Claims 6, 10 to 13, 27, 28 and 30 stand rejected under 35 U.S.C. § 103 over Stefik.

Claims 2 to 5, 14, 17, 18, 21, 22 and 25 stand rejected under 35 U.S.C. § 103 over Stefik in view of Piovosso. Claims 8 to 9 stand rejected under 35 U.S.C. § 103 over Stefik and Abrahamson.

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Rather than repeat the positions and the arguments of Appellant and the Examiner, we make reference to the briefs² and the answer for their respective positions.

OPINION

We have considered the rejections advanced by the Examiner. We have, likewise, reviewed Appellant's arguments against the rejections as set forth in the brief.

It is our view, after consideration of the record before us, that the rejections under 35 U.S.C. § 102 and under 35 U.S.C.

§ 103 are not proper. Accordingly, we reverse.

Analysis

There are various rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103. We treat them seriatim.

Rejections under 35 U.S.C. § 102

Claims 1, 7, 16, 19, 20, 23, 24, 26 and 29 are under

² A reply brief was filed as paper no. 20 and was entered in the record without any further response by the Examiner [paper no. 22].

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rejection as being anticipated by Stefik.

It is well established that a prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)).

We first take the independent claim 1. The Examiner asserts that Stefik discloses the claimed method [answer, page 3]. Appellant argues [brief, pages 6 to 9 and reply brief, pages 1 to 5] that Stefik does not anticipate claim 1. Moreover, Appellant advocates that Stefik is not even related to the same problem Appellant is trying to solve.

We agree with Appellant's position. In Stefik, all workstations have the same status, and any one workstation can initiate a change in the data being displayed on its screen. That workstation locally, or some central control, can put a notification on the network about the data change. The other

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workstations see the notification being displayed on their screens. The other workstations can then update the data on their display screens. See Stefik at Col. 4, Lines 13 to 15 and Lines 28 to 32, Col. 7, Lines 18 to 36. One may consider that the workstation generating the change in the data is the control workstation. However, this control workstation does not generate a "command" to the other workstations, and the other workstations do not reduce in size the displays on their screens and send the reduced size data to the control workstation which can simultaneously display on its screen the reduced displays from the other workstations. We are not persuaded by the Examiner's generalized statements like "[i]t may be unclear and not explicitly disclosed [in Stefik] in what manner the workstations are triggered to send the display information; ..." [answer, page 12], or, the "Examiner admits that the Office Action may not be clear on application of Stefik et al. to the claim limitations. However, ... any particular teachings not explicitly taught in Stefik et al. could be extrapolated from Stefik et al. using an inherency analysis for those claim limitations which Examiner does not consider to be critical to the invention, including the

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limitation in independent claim 1 of 'generating a command
...'" [id. at 13, 14]. The Examiner's argument is contrary to
the requirement of anticipation as enunciated above.
Furthermore, for an Examiner to rely on inherency, the
Examiner has to show that the alleged elements must, by their
very nature, perform precisely in the manner the Examiner
prescribes. The Examiner has not made, or even attempted to
make, such a showing here. Mere allegations are not
sufficient to assert inherency. Thus, we do not sustain the
anticipation rejection of claim 1 over Stefik. The other
independent claims, 19, 23 and 26 contain limitations
corresponding to those discussed above regarding claim 1.
Therefore, we do not sustain the anticipation rejection of
independent claims 19, 23 and 26, and the dependent claims 7,
16, 20, 24 and 29 over Stefik.

Rejections under 35 U.S.C. § 103

There are three different rejections under 35 U.S.C. §
103: 1.) Claims 6, 10 to 13, 27, 28 and 30 over Stefik alone,
2.) Claims 2 to 5, 14, 17, 18, 21, 22 and 25 over Stefik and
Piovoso, and 3.) Claims 8 to 9 over Stefik and Abrahamson.

With respect to a rejection under 35 U.S.C. § 103, an

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Examiner must set forth a prima facie case of obviousness. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the art, or by implications contained in such teachings or suggestions. In re Sernaker, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." Para-Ordnance Mfg. v. SGS Importer Int'l, Inc., 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), cert. denied, 117 S.Ct. 80 (1996) citing W. L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

With respect to each of the above obviousness rejections, the Examiner has relied on his position and discussion of Stefik above with respect to independent claim 1. The Examiner has presented no evidence, or a line of reasoning, to cure the deficiencies of Stefik to meet the claimed limitations discussed above. The additional references are

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presented for different and other teachings. Thus, for example, Piovoso stands for the concept of reducing size of a display by "decimating between original pixels in the neighborhood of the desired pixel position" [answer, page 7], and Abrahamson stands for "displaying the current status information of the other workstations ..." [id. at 10]. Since the deficiencies of Stefik are not cured, the Examiner has failed to set forth a prima facie case with respect to any of the three rejections under 35 U.S.C. § 103. Thus, we do not sustain the obviousness rejections of claims 6, 10 to 13, 27, 28 and 30 over Stefik alone, of claims 2 to 5, 14, 17, 18, 21, 22 and 25 over Stefik and Piovoso, and of claims 8 to 9 over Stefik and Abrahamson.

In conclusion, we reverse the Examiner's final rejection of claims 1, 7, 16, 19, 20, 23, 24, 26 and 29 35 U.S.C. § 102 over Stefik. Furthermore, we reverse the decision of the Examiner

rejecting under 35 U.S.C. § 103 claims 6, 10 to 13, 27, 28 and 30 over Stefik, claims 2 to 5, 14, 17, 18, 21, 22 and 25 over

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Stefik and Piovoso, and claims 8 and 9 over Stefik and
Abrahamson.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	
PARSHOTAM S. LALL)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
ANITA PELLMAN GROSS)	
Administrative Patent Judge)	

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