

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHANNON C. BOESCH and CHARLES L. HALEY

Appeal No. 1999-2001
Application No. 08/664,089

ON BRIEF

Before JERRY SMITH, DIXON, and GROSS, Administrative Patent Judges.
GROSS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 23, which are all of the claims pending in this application.

Appellants' invention relates to a portable computer with a removable translation board coupled to a graphics controller for receiving video information of a first signal type and outputting to a display video information of a second signal type. Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A computer comprising:
a processor;

Appeal No. 1999-2001
Application No. 08/664,089

a graphics controller coupled to said processor for outputting video information defined using a first signal type;

a translation board removably coupled to said graphics controller for receiving said video information defined using said first signal type and outputting video information defined using a second signal type; and

a display coupled to said translation board for receiving said video information defined using said second signal type.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Shah	5,406,199	Apr. 11, 1995
Koenig	5,559,448	Sep. 24, 1996 (filed Apr. 07, 1995)
Sakoda et al. (Sakoda)	5,559,954	Sep. 24, 1996 (filed Mar. 29, 1995)
Reinhardt	5,598,565	Jan. 28, 1997 (filed Dec. 29, 1993)

Claims 1, 2, 4 through 10, and 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sakoda in view of Shah.

Claims 3, 11, and 14 through 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sakoda in view of Shah and Koenig.

Claims 12, 13, and 17 through 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sakoda in view of Shah, Koenig, and Reinhardt.

Reference is made to the Examiner's Answer (Paper No. 15, mailed December 17, 1998) for the examiner's complete reasoning in support of the rejections, and to appellants' Brief (Paper

Appeal No. 1999-2001
Application No. 08/664,089

No. 14, filed November 30, 1998) and Reply Brief (Paper No. 17, filed February 25, 1999) for appellants' arguments thereagainst.

OPINION

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by appellants and the examiner. As a consequence of our review, we will reverse the obviousness rejections of claims 1 through 23.

Independent claims 1, 9, and 23 each recite a translation board removably coupled to a graphics controller. The examiner asserts (Answer, page 4) that it would have been obvious to apply the removable translation board taught by Shah to the multi-format frame buffer of Sakoda's display "so that it can be setting the characteristic of a video signal supplied to a high resolution video display monitor which is responsive to a signal generate [sic] by the TTL logic that uniquely identifiers [sic] the video display monitor's capabilities." Appellants argue (Brief, page 10):

One skilled in the art would not look at Shah's paddle card (36') containing circuitry (52') for signal logic level translation which may be substituted for one of the paddle cards (36), when it is necessary to translate the logic level of certain signals (having nothing to do with a display or graphics controller) passing between the testing machine (13) and the circuit board (12), (bi-directional signal passing), and determine that a paddle card (36), having logic level translation (and which in Shah is installed between a channel card 44 and a translator member 16) could somehow be installed in Sakoda's apparatus

Appeal No. 1999-2001
Application No. 08/664,089

between display controller 37 and display monitor 30, with or without the improper hindsight provided by Applicants' disclosure. There is no motivation in the art for such a combination, and even if there were, the resulting combined device would not operate as suggested by the examiner.

We agree with appellants.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *Uniroyal, Inc. v. Rudkin-Wiley*, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1438 (Fed. Cir.1988), **cert. denied**, 488 U.S. 825 (1988). These showings by the examiner are an essential part of complying with the burden of presenting a **prima facie** case of obviousness. **Note In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In the absence of such showings, any combination of references cannot be considered as being based on anything other than impermissible hindsight.

The examiner has failed to provide any such teaching or suggestion from the prior art. We find no suggestion in Shah or Sakoda, which has nothing to do with a display, as to why Shah's removable translation board for translating signals between a

Appeal No. 1999-2001
Application No. 08/664,089

testing machine and a circuit board would have been useful or desirable for translating pixel formats for display in Sakoda's computer system. Furthermore, if the determination of pixel formats in Sakoda were removed, the display would not function. Therefore, we find that the examiner has failed to establish a *prima facie* case of obviousness. Consequently, we cannot sustain the rejection of independent claims 1, 9, and 23, and their dependents, claims 2, 4 through 8, and 10.

Independent claim 14, and dependent claims 3, 11, 15, and 16, each recite a translation board removably coupled to a graphics controller and also the particular type of signals (LVDS signals) output by the translation board. The examiner adds Koenig to the primary combination for a teaching of LVDS signals. However, Koenig fails to cure the deficiencies of Sakoda and Shah. Accordingly, we cannot sustain the rejection of claims 3, 11, and 14 through 16.

As to claims 12, 13, and 17 through 22, the examiner adds Reinhardt to Sakoda, Shah, and Koenig. However, Reinhardt adds nothing regarding the shortcomings of the primary combination. Consequently, we will not sustain the rejection of claims 12, 13, and 17 through 22.

Appeal No. 1999-2001
Application No. 08/664,089

CONCLUSION

The decision of the examiner rejecting claims 1 through 23 under 35 U.S.C. § 103 is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JOSEPH L. DIXON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
ANITA PELLMAN GROSS)	
Administrative Patent Judge)	

apg/vsh

Appeal No. 1999-2001
Application No. 08/664,089

TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS, TX 75265