

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JI-YOUNG LEE

Appeal No. 2002-1996
Application No. 09/086,312

HEARD: Apr. 2, 2003

Before RUGGIERO, BARRY, and LEVY, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

A patent examiner rejected claims 1, 2, 5-8, 11, and 12. The appellant appeals therefrom under 35 U.S.C. § 134(a). We reverse.

BACKGROUND

The invention at issue on appeal controls an image on a multi-synchronization mode display. With such a display, the horizontal and vertical position values and the horizontal and vertical size values of an image displayed thereon vary with the mode of synchronization. (Paper No. 8 at 2.) The display sets a reference value according to a specific mode to correspond to each synchronization mode and stores it as shown in

Table 1 of the appellant's specification. (*Id.*) More specifically, the Table shows that the horizontal and vertical positions and horizontal and vertical sizes are set to perform image control suitable for each mode when the display is fabricated. (Spec. at 2.) The appellant asserts that, in such a display, errors in the fabrication of its cathode ray tube impede correct execution of image control. (*Id.*)

To solve this problem, the appellant explains, his multi-synchronization mode display allows a reference value to vary in a narrow, predetermined range. (*Id.*) When the display is fabricated, data for controlling the size of an image are stored in a memory, and the image is controlled automatically using the stored data. (*Id.* at 15.)

A further understanding of the invention can be achieved by reading the following claims.

1. A method of controlling an image parameter of an image displayed on a multi-synchronization display, said image parameter being one of increase vertical size of image, decrease vertical size of image, increase horizontal size of image, decrease horizontal size of image, move image up, move image down, move image to right, and move image to left, said method comprising the steps of:

(a) determining whether there is an image parameter input from a user for controlling an image parameter of the image;

(b) setting a variable range of a reference value determined when the display was fabricated, upon it being determined that there is no image parameter input from the user;

(c) upon the variable range being set, determining whether the user has operated a control key for changing an image parameter of the displayed image; and

(d) upon it being determined that the user has operated the control key, increasing or decreasing image parameter data according to the image parameter input by the user;

wherein all of said determining steps are carried out entirely by software means in a programmed microcomputer; and

wherein the step (d) of increasing or decreasing image parameter data comprises the steps of:

(d1) upon it being determined that the user has operated the control key for increasing the image parameter data, determining whether the increased image parameter data is greater than or equal to a predetermined maximum value of the variable range;

(d2) if the increased image parameter data is not greater than or equal to the predetermined maximum value of the variable range, increasing the image parameter data according to the image parameter input from the user;

(d3) upon it being determined that the user has operated the control key for decreasing the image parameter data, determining whether the decreased image parameter data is less than or equal to a predetermined minimum value of the variable range; and

(d4) if the decreased image parameter data is not less than or equal to the predetermined minimum value of the variable range, decreasing the image parameter data according to the image parameter input from the user.

5. A method of controlling an image parameter of an image displayed on a multi-synchronization display, said image parameter being one of increase vertical size of image, decrease vertical size of image, increase horizontal size of image, decrease horizontal size of image,

move image up, move image down, move image to right, and move image to left, said method comprising the steps of:

(a) determining whether there is an image parameter input from a user for controlling an image parameter of the image;

(b) setting a variable range of a reference value determined when the display was fabricated, upon it being determined that there is no image parameter input from the user;

(c) upon the variable range being set, determining whether the user has operated a control key for changing an image parameter of the displayed image; and

(d) upon it being determined that the user has operated the control key, increasing or decreasing image parameter data according to the image parameter input by the user;

wherein all of said determining steps are carried out entirely by software means in a programmed microcomputer; and

wherein the step (a) of determining whether there is an image parameter input from the user comprises the steps of:

(a1) reading the reference value;

(a2) determining whether the user has operated the control key; and

(a3) upon it being determined that the user has operated the control key, comparing the image parameter input from the user with predetermined minimum and maximum values for the image parameter, and selectively increasing or decreasing the image parameter input according to the comparison result.

Claims 1, 2, 5-8, 11, and 12 stand rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,579,029 ("Arai") or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Arai.

OPINION

Rather than reiterate the positions of the examiner or the appellant *in toto*, we address the main point of contention therebetween. The examiner asserts, "[i]n column 3, lines 14-28, Arai et al. discloses setting of display parameters at the factory before shipping." (Examiner's Answer at 6.) The appellant argues, "*Arai et al.* '029 does not disclose or suggest such a method or apparatus wherein a variable range of a reference value is determined when the display is fabricated in the factory, and wherein that variable range is then set in the second step or function performed by the method and apparatus, respectively." (Appeal Br. at 8.)

We begin with the anticipation rejection. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (citing *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 715, 223 USPQ 1264, 1270 (Fed. Cir. 1984); *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983);

Kalman v. Kimberly-Clark Corp., 713 F.2d760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983)). "[T]here is no anticipation 'unless all of the same elements are found in exactly the same situation and united in the same way . . . in a single prior art reference.'"

Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984) (citing *Kalman*, 713 F.2d at 771, 218 USPQ at 789).

Here, although the examiner purports to apply only one reference, he relies on teachings of multiple inventions mentioned in Arai. Often the examiner relies on descriptions of the invention shown in Figure 6 of Arai. (Final Rejection¹ at 2; Examiner's Answer at 4-5.) Specifically, the reference calls this invention "the third embodiment of the invention." Col. 5, ll. 17-18.

To support his aforementioned assertion, however, the examiner relies on a passage of Arai describing "the above conventional technique. . . ." Col. 3, l. 14. This conventional technique is not described as part of Arai's invention. To the contrary, it "is a technique disclosed in JP-U-64-4491." Col. 1, ll. 32-33. The examiner's reliance

¹We advise the examiner to copy his rejections into his examiner's answers rather than merely referring to a "rejection . . . set forth in prior Office Action. . . ." (Examiner's Answer at 3.)

on the teachings of both Arai's third embodiment and those of JP-U-64-4491² evidence that neither of these inventions, by itself, discloses all the claimed elements in exactly the same situation and united in the same way. Such a failure "negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986). Therefore, we reverse the anticipation rejection.

We turn to the obviousness rejection. "[T]o establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicants." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citing *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). "[T]he factual inquiry whether to combine references must be thorough and searching." *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001).

Here, the examiner fails to allege, let alone show evidence of, the desirability of combining elements of Arai's third embodiment and elements of JP-U-64-4491. We will

²The examiner also cites Figure 9 of Arai, (Final Rejection at 2), which "show[s] the fifth embodiment of the invention." Col. 5, ll. 23-24.

not "resort to speculation," *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), about such desirability. Therefore, we reverse the obviousness rejection.

CONCLUSION

In summary, the rejections of claims 1, 2, 5-8, 11, and 12 under § 102(b) and under § 103(a) are reversed.

REVERSED

JOSEPH F. RUGGIERO
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

STUART S. LEVY
Administrative Patent Judge

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