

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(2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN SONG,
CURTIS D. MOYER,
and KAREN E. JACHIMOWICZ

Appeal No. 1997-0413
Application 08/231,570

ON BRIEF

Before HAIRSTON, KRASS, and FLEMING, Administrative Patent
Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of
claims 16 through 33, all of the claims pending in the
application.

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The invention is directed to a receiver (e.g., a pager, cellular phone, two-way radio, etc.) having a miniature virtual image display and a direct visual display.

Representative independent claim 16 is reproduced as follows:

16. A portable communications receiver with multiple visual displays comprising a portable communications receiver with a miniature virtual image display having a viewing aperture, the miniature virtual image display being operably attached to the receiver and including image generation apparatus for providing a real image and a fixed optical system for producing, from the real image, a virtual image viewable through the viewing aperture and a direct visual display operably attached to the receiver.

The examiner relies on the following references:

Brennan et al. (Brennan)	4,076,978	Feb. 28, 1978
Lowell	4,115,870	Sep. 19, 1978
Villa-Real	4,481,382	Nov. 6, 1984
Wells et al. (Wells)	5,023,905	Jun. 11, 1991
Tanielian et al. (Tanielian)	5,051,738	Sep. 24, 1991
Igaki	5,124,548	Jun. 23, 1992 (filed Sep. 27, 1991)

Claims 31 and 32 stand rejected under 35 U.S.C. § 112, first paragraph, as relying on a nonenabling disclosure.

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Claims 16 through 33 stand provisionally rejected under obviousness-type double patenting as being unpatentable over claims 1 through 12, 14, 16, 18 and 22 through 24 of copending Application Serial No. 07/767,178 in view of Lowell.

Claims 16 through 33 stand further rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner cites Wells and Lowell with regard to claims 16 through 19, 21, 27, 28, 30 and 33, adding Villa-Real with regard to claim 20, Brennan with regard to claims 22 through 24, Tanielian with regard to claims 25, 26, 31 and 32, and Igaki with regard to claim 29.

Reference is made to the briefs and answers for the respective positions of appellants and the examiner.

OPINION

At the outset, we reverse the rejection of claims 16 through 33 under obviousness-type double patenting as being moot since the copending Application Serial No. 07/767,178 has since been abandoned.

Turning now to the rejection of claims 31 and 32 under 35 U.S.C. § 112, first paragraph, as relying on a nonenabling disclosure, we will also reverse this rejection for the

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reasons set forth in our earlier decision of August 23, 1996 in the parent application, Serial No. 07/767,178.

The examiner contends that the claimed recitation of "the real image being of a size to require magnification to be perceivable with the human eye" is not disclosed by applicants because the recitation of "miniature virtual image display...which incorporates an extremely small LED array," at page 10, lines 10-11 of the specification, "does not mean the image can not be perceived by human eye" [supplemental answer-page 3] because appellants did not specify the size of the image on the chip. However, if a device array is placed on a single chip, an operation clearly within the skill of an artisan, it would appear to us that the real image would be too small to be perceived by the human eye, as claimed.

As we said in our earlier decision, if the examiner had trouble understanding the claim language in view of the language employed in the specification, perhaps the rejection should have been under the second paragraph of 35 U.S.C. § 112. In any event, it is clear to us, from a review of the instant disclosure as a whole, that what appellants intend is

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the provision of a real image of such size so as to require magnification in order to be clearly seen by a normal human eye. This would appear to have been provided by forming the array of pixels on a single semiconductor chip and we find no contention by the examiner that the skilled artisan would not have been able to have constructed such a device. We find no problem with enablement of the invention set forth in instant claims 31 and 32.

Finally, we turn to the rejections based on prior art. Since the propriety of all of the rejections depends on whether it was proper to combine the two primary references to Wells and Lowell, we focus on these references.

Wells clearly is directed to similar subject matter as the instant claimed invention in the disclosure, within a portable communication receiver, of a miniature virtual image display [see Figure 4 of Wells] having a viewing aperture, being operably attached to the receiver and including image generating apparatus [real image of LED display 46 is provided and lenses 54 and 56, along with housing 52, provide a virtual image] for providing a real image and a fixed optical system

[e.g., lens 54] for producing the virtual image viewable through a viewing aperture.

As the examiner recognizes, Wells lacks the claimed "direct visual display operably attached to the receiver." This claim language is interpreted to mean a typical display device, such as shown at 16 in Figure 1A of the instant application, as opposed to the miniature virtual display shown, for example, at 12 in Figure 1A and as 12' in Figure 2A. Thus, Wells does not disclose the plurality of displays [a miniature virtual display and a direct visual display] required by the instant claims.¹

The examiner then turns to Lowell to supply the teaching missing in Wells. Lowell discloses a plurality of displays, as shown in Figure 1 of that patent. However, we can discern no reason why the skilled artisan having Wells and Lowell before him/her would have combined the teachings of these disparate references in such a manner as to arrive at the instant claimed subject matter. It is true that Lowell

¹In fact, it is this combination of displays which distinguishes the claimed subject matter of the instant application from that of the parent application Serial No. 07/767,178.

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discloses a portable device which has a plurality of displays and it is true that Wells discloses a portable device having a miniature virtual display. But we find no suggestion to the artisan to modify Wells in any way so as to provide for the *combination* set forth in the instant claims where a portable communications receiver has both a miniature virtual display and a direct visual display. Wells would have no reason to include a direct visual display, as claimed, because Wells is interested in only viewing the virtual image through a display window [e.g., window 58A in Figure 5]. Wells' device would have no need for a direct visual display as claimed.

As appellants state, at page 11 of the reply brief, the examiner's finding of obviousness "at the exact point of novelty," i.e., in providing for the plurality of displays, is nothing more than judicial notice which requires a supporting citation by the examiner if challenged, as the examiner has been, by appellants. The examiner has provided no evidence of any reason for providing a direct visual display in Wells. The examiner's reason for the combination of Wells and Lowell, i.e., "to simultaneously present a different kind of

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information on a respective display and a user can be more easy to focus on the information [sic]" [supplemental answer-page 11] is not persuasive. Wells doesn't suggest a need for any other type of display or information and the examiner's reasoning appears to be based more on hindsight than on anything either Wells or Lowell suggests.

Accordingly, we will not sustain the rejection of any claim under 35 U.S.C. § 103 since all rejections depend on the combination of Wells and Lowell and the secondary references to Villa-Real, Brennan, Tanielian and Igaki, relied on by the examiner for various other reasons, do not overcome the deficiencies of the Wells-Lowell combination.

We have not sustained the rejection of claims 16 through 33 under 35 U.S.C. § 103, nor have we sustained the rejection of claims 31 and 32 under 35 U.S.C. § 112, first paragraph, or the provisional rejection of claims 16 through 33 under obviousness-type double patenting.

Accordingly, the examiner's decision is reversed.

REVERSED

Kenneth W. Hairston)

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	Administrative Patent Judge)	
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	Administrative Patent Judge)	APPEALS AND
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