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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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SEIJI MATSUMOTO

Appeal No. 97-1656
Application No. 08/314,256¹

ON BRIEF

Before URYNOWICZ, HAIRSTON and BARRY, Administrative Patent Judges.

BARRY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the final rejection of claims 1 through 6. We affirm-in-part.

¹ The application was filed September 30, 1994 and entitled "Single Chip Microcomputer having a Built-in On Screen Display Device."

BACKGROUND

The invention relates to an on-screen display ("OSD") for a television ("TV"). (Appeal Br. at 2.) The OSD simultaneously displays channel or volume data along with teletext data on a cathode ray tube. (Spec. at 2.) In one embodiment of the invention, a single chip microprocessor incorporates plural OSD devices, which are independently controlled. In an alternate embodiment, a single chip microprocessor employs a single OSD and controls priorities, interrupts, and masks for the display. (Spec. at 24.)

Claim 1, which is representative for our purposes, follows:

1. A single chip microcomputer having at least one built-in on screen display device for simultaneously displaying on a display a plurality of display tasks which are processed asynchronously, comprising:

a plurality of on screen display devices each capable of displaying in plural blocks of display data, information from independent sources;

controlling means for independently controlling said on screen display devices; and

mixing means for mixing output signals from said on screen display devices, with each other.

The reference relied on by the patent examiner in rejecting the appealed claims follows

Takahashi 5,420,610 May 30, 1995 (filed Mar. 7, 1994).

Claims 1 and 2 stand rejected under 35 U.S.C. § 112 as indefinite and under 35 U.S.C. § 102(e) as anticipated by Takahashi. Claims 3 through 6 stand rejected under § 102(e) as anticipated by or under 35 U.S.C. § 103 as obvious over Takahashi. Rather than repeat the arguments of the appellant or examiner in toto, we refer to the appeal and reply briefs and the examiner's answer for the respective details thereof.

OPINION

In reaching our decision in this appeal, we considered the subject matter on appeal and the rejections and evidence advanced by the examiner. We also considered the appellant's and examiner's arguments. After considering the record before us, it is our view that claims 1 and 2 particularly point out and distinctly claim the subject matter the appellant regards as his invention. It is also our view that Takahashi

anticipates the invention of claims 1-2 but not the invention of claims 3-6. Further, it is our view that the evidence relied on and the level of skill in the art would not have suggested to one of ordinary skill in the art the invention of claims 3-6. Accordingly, we affirm-in-part. Our opinion discusses the grouping of all the claims, the definiteness of claims 1 and 2, the anticipation of claims 1 and 2, and the novelty and nonobviousness of claims 3 through 6 seriatim.

Grouping of All Claims

37 C.F.R. § 1.192(c)(7), as amended at 60 Fed. Reg. 14518 (Mar. 17, 1995), was controlling when the appeal brief was filed. Section 1.192(c)(7) stated as follows.

For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

The appellant states that the claims are "separately patentable." (Appeal Br. at 5.) He also explains why the claims are separately patentable. (Id. at 6-13.) Therefore, we find claims 1-6 to stand or fall separately; we will consider the claims separately.

Definiteness of Claims 1 and 2

We begin our consideration of the definiteness of claims 1 and 2 by noting that the test for the definiteness of a claim is whether one skilled in the art would understand the bounds of the claim when read in light of the specification. If the claim read in light of the specification would reasonably apprise one so skilled of the scope of the invention, 35 U.S.C. § 112 demands no more. Miles Labs., Inc. v. Shandon Inc., 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993). Furthermore, a claim should not be denied solely because of the type of language used to define the subject matter for which patent protection is sought. In re Swinehart, 439 F.2d. 210, 212 n.4, 169 USPQ 226, 228 n.4 (CCPA 1971). With this in mind, we analyze the examiner's rejection.

The examiner asserts that the phrase "capable of displaying in plural blocks of display data," recited in claims 1 and 2, is indefinite for two reasons. First, he opines that the phrase capable of displaying "implies the meaning of 'capable of but not displaying', therefore it is not clear whether each OSD actually display data on plurality of blocks." (Examiner's Answer at 3.) The examiner explains, "'capable' mean[] having the ability or capacity. Having the capacity does not mean[] that the capacity is being used." (Id. at 6.) He concludes, "[t]hus 'capable of displaying in plural blocks of display data' does not necessary [sic, necessarily] mean[] that the OSDs do actually display in plural blocks of data and a circuit for that function is provided." (Id. at 6.) In response the appellant merely alleges, "[w]hen the claim language is read in light of the specification, an artisan would readily understand what the metes and bounds of the invention are." (Appeal Br. at 8.) The appellant does not explain his allegation.

Despite the appellant's laconic response, claims 1 and 2 should not be denied solely because the claims use the

language "capable of" to define the subject matter. When read in light of the specification, we find that one skilled in the art would understand that "capable of displaying" means that data "can be displayed ... on a display ... under a desired screen configuration" (Spec. at 24.) Because data are not always displayed, e.g., when the microcomputer is off, the language "capable of" is clear.

Second, the examiner opines, "it is not clear as to whether the [appellant] meant to recite that each OSD is capable of displaying in each and every block of display data or each is capable of displaying data in a single block within the plurality of blocks" (Examiner's Answer at 3.) He explains that the appellant did not specify "whether each OSD is capable of displaying in **each and every block** of display data, or each is capable of displaying data in a single block within the plurality of blocks" (Id. at 6-7.) In response the appellant states, "[c]laim 1 intends that each of the on screen display devices independently displays data in a single block of the plural blocks." (Reply Br. at 1.) He emphasizes, "[c]laim 1 does not intend that each of the on

screen display devices independently displays in each and every block of plural blocks of display data." (Id. at 2.)

The examiner remarks that the response clarifies the claim language such that it "should be interpreted as each of the on screen display devices independently displays data in a single block of the plural blocks." (Paper No. 12.) We find the remark to be an admission that one skilled in the art would understand the bounds of the claim when read in light of the specification. We demand no more. Therefore, we reverse the rejection of claims 1 and 2 under 35 U.S.C. § 112.

Novelty of Claims 1 and 2

We begin our consideration of the novelty of claims 1 and 2 by recalling that during patent examination, pending claims must be given their broadest reasonable interpretation. Limitations from the specification are not to be read into the claims. In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993); In re Prater, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969). With this in mind, we address the appellant's arguments.

Regarding claims 1 and 2, the appellant alleges that Takahashi does not teach on screen display devices. (Appeal Br. at 9-10.) He adds, "the structure of Takahashi is different from that of the present invention." (Reply Br. at 2.) In response the examiner notes, "Takahashi teaches a plurality of on screen display circuits." (Examiner's Answer at 7-8.) The examiner then reads the claimed limitation on the reference. (Id. at 8.)

Giving claims 1 and 2 their broadest reasonable interpretation, we find that the limitation of "a plurality of on screen display devices each capable of displaying in plural blocks of display data, information from independent sources," (Appeal Br. at 15), is broad enough to read on Takahashi's plurality of screen display circuits. The reference generally teaches a screen display apparatus fabricated on a single chip to show a variety of displays, col. 2, ll. 1-3, on a TV screen. Col. 1, ll. 1-8. The variety includes channel number, sound volume, and menu. Id. at ll. 54-55. Takahashi's apparatus includes a plurality of screen display circuits for generating display pattern data. Col. 2, ll. 4-6. Each display circuit comprises a character RAM and a

character ROM. Id. at 15-28. A position control circuit controls the screen display circuits' output of the display data. A composing circuit forms a logical sum of the display data. A plurality of display patterns generated by the screen display circuits is thus composed to shift or overwrite characters. Id. at 11. 6-14.

Comparison of the claim language to the reference's teaching evidences that Takahashi's screen display circuits anticipate the claimed on screen display devices. The claimed "displaying in plural blocks of display data, information" reads on the reference's displaying character data including first and second characters depicted in Figures 3, 5, and 6. The claimed "independent sources" read on Takahashi's first character RAM or ROM vis-à-vis his second character RAM or ROM depicted in Figures 2 and 4.

Regarding claim 2, the appellant opines, "it is unclear whether teletext is included" in Takahashi's display patterns. (Appeal Br. at 10.) More specifically, he argues that although the reference teaches displaying a menu, it does so

in the background section. (Id.) In response, the examiner points to the characters "ACBD" and "DCBA" displayed in Figures 3 and 5. (Examiner's Answer at 8-9.)

The rule that anticipation requires that every element of a claim appear in a single reference, moreover, accommodates situations where the common knowledge of "technologists" is not recorded in the reference, i.e., where technical facts are known to those in the field of the invention. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1269, 20 USPQ2d 1746, 1749-50 (Fed. Cir. 1991). Those in the field of screen displaying would know that a menu was commonly displayed on a TV screen at the time of the invention. Takahashi, col. 1, ll. 34-35. They would expect the screen of Takahashi to display such a menu.

Furthermore, the appellant did not define teletext. Giving claim 2 its broadest reasonable interpretation, we find that the claimed limitation of a "teletext display task," (Appeal Br. at 15), is broad enough to read on Takahashi's display patterns. The characters ACBD and DCBA are displayed

on a television screen. The characters are text. Thus, ACBD and DCBA are teletext.

We end our consideration of the novelty of claims 1 and 2 by concluding that we are not required to raise or consider any issues not argued. Our reviewing court stated, "[i]t is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art." In re Baxter Travenol Labs., 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991).

37 C.F.R. § 1.192(a), as amended at 60 Fed. Reg. 14518 (Mar. 17, 1995), was controlling when the appeal brief was filed. Section 1.192(a) stated as follows.

The brief ... must set forth the authorities and arguments on which appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief may be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.

Also at the time of the brief, 37 C.F.R. § 1.192(c)(8)(iii) stated as follows.

For each rejection under 35 U.S.C. 102, the argument shall specify the errors in the rejection and why the rejected claims are patentable under 35 U.S.C. 102, including any specific limitations in the rejected claims which are not described in the prior art relied upon in the rejection.

At the same time, 37 C.F.R. § 1.192(c)(8)(iv) stated as follows.

For each rejection under 35 U.S.C. 103, the argument shall specify the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and shall explain how such limitations render the claimed subject matter unobvious over the prior art. If the rejection is based upon a combination of references, the argument shall explain why the references, taken as a whole, do not suggest the claimed subject matter, and shall include, as may be appropriate, an explanation of why features disclosed in one reference may not properly be combined with features disclosed in another reference. A general argument that all the limitations are not described in a single reference does not satisfy the requirements of this paragraph.

In summary, section 1.192 provides that just as the court is not under any burden to raise or consider issues not argued by the appellant, this board is also not under any such burden. Therefore, we affirm the rejection of claims 1 and 2 under 35 U.S.C. § 102(e).

Novelty and Nonobviousness of Claims 3 through 6

We begin our consideration of the novelty and nonobviousness of claims 3 thorough 6 by recalling that a prior art reference anticipates a claim only if the reference discloses expressly or inherently every limitation of the claim. Absence from the reference of any claimed element negates anticipation. Rowe v. Dror, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997).

In rejecting claims under 35 U.S.C. § 103, furthermore, the patent examiner bears the initial burden of establishing a prima facie case of obviousness. A prima facie case is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. If the examiner fails to establish a prima facie case, an obviousness rejection is improper and will be overturned. In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). With this in mind, we address the appellant's arguments.

Regarding claims 3 through 6, the appellant opines, "Takahashi always has a mask set in the event of a conflict.

Takahashi does not control 'the existence of a mask'"
(Appeal Br. at 11-12.) In response the examiner explains,
"the existence of a mask is determined based on the priority
of the display patterns." (Examiner's Answer at 9.)

Giving claims 3 through 6 their broadest reasonable
interpretation, we find that the claim limitation of a "third
controlling means for controlling the existence of a mask in
display in accordance with the priorities of said display
tasks," (Appeal Br. at 16-17), is broad enough to read on
Takahashi's priority control circuit. The reference teaches a
priority control circuit that masks font data on an overlapped
portion of a display pattern output from a screen display
circuit. Masking is performed based on priorities of display
patterns entered from a central processing unit, i.e., CPU.
Col. 3, ll. 21-25; col. 6, ll. 35-38.

By arguing that Takahashi sets a mask in the event of a
conflict, the appellant admits that the reference teaches a
means for setting a mask, i.e., a means for controlling the
existence of a mask. The mask is set in the event of a

conflict. Comparison of the claim language to the reference's teaching, furthermore, evidences that Takahashi's priority control circuit anticipates the claimed third controlling means. The claimed "controlling the existence of a mask in display in accordance with the priorities of said display tasks" reads on Takahashi's controlling the existence of a mask based on priorities of display patterns.

Further regarding claims 3 through 6 the appellant argues, "Takahashi has nothing which controls the occurrence of 'interrupts' (plural) in accordance with priorities of the display tasks." (Appeal Br. at 13.) In response the examiner speculates it "would be necessary to have an interrupt controller to control the interruptions of the display tasks."

(Examiner's Answer at 10.)

The examiner does not address the claim limitation that requires controlling in accordance with the priorities of the display tasks. We find that Takahashi fails to teach this

limitation. The absence of the limitation from the reference negates anticipation.

Furthermore, we find that the teachings from the prior art itself would not appear to have suggested the limitation to a person of ordinary skill in the art. As admitted by the examiner, Takahashi fails to expressly teach interrupts. (Examiner's Answer at 5.) Because the reference omits a description of any interrupts, it would not have suggested interrupts that are controlled based on priorities of display tasks. We also note that Takahashi was aware of prioritization. As aforementioned, the reference teaches the use of priorities to control masking. In view of this teaching, if Takahashi intended to use priorities to control interrupts, he would have mentioned the use.

For the foregoing reasons, the examiner failed to show a teaching or suggestion of controlling interrupts in accordance with the priorities of the display tasks. Therefore, we find the examiner's rejection does not amount to a prima facie case of obviousness. Because the examiner has not established a

prima facie case, the rejection of claims 3 through 6 is improper. Therefore, we reverse the rejection of claims 3 through 6 under 35 U.S.C. § 102(e) and under 35 U.S.C. § 103.

CONCLUSION

To summarize, the examiner's rejection of claims 1 and 2 under 35 U.S.C. § 112 as indefinite is reversed. His rejection of claims 1 and 2 under 35 U.S.C. § 102(e) as anticipated by Takahashi is affirmed. The examiner's rejection of claims 3 through 6 under 35 U.S.C. § 102(e) as anticipated by or under 35 U.S.C. § 103 as obvious over Takahashi is reversed. Accordingly, we affirm-in-part.

No time period for taking subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

STANLEY M. URYNOWICZ, JR.)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
KENNETH W. HAIRSTON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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APPEAL NO. 97-1656 - JUDGE BARRY
APPLICATION NO. 08/314,26

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APJ HAIRTSOON

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DECISION: **AFFIRMED-IN-PART**

Prepared by: Gloria Henderson

DRAFT TYPED: 08 Jun 00

FINAL TYPED:

Gloria, note the following instructions:

Do NOT change style of citations.

Do insert claim and reference(s).

Do proofread.