

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 41

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOSHIYA MINAMI, HIROSHI SATOH and TAKANOBU SATOH

Appeal No. 96-3564
Application 08/274,133¹

ON BRIEF

Before THOMAS, FLEMING and DIXON, **Administrative Patent Judges.**

DIXON, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1-9, which are all of the claims pending in this application.

¹Application for patent filed July 12, 1994. According to appellants, this application is a continuation of application 07/879,075, filed May 1, 1992, which is a continuation of application 07/565,598, filed August 10, 1990, both abandoned.

BACKGROUND

The present invention relates to a method and apparatus for displaying text on a computer screen in a "dark on white" fashion, and particularly displaying text with a normal mode and a highlighted mode on the screen at the same time. The method and apparatus employ a highlight mode (second mode) where the text is black-on-white, and a normal mode (first mode) where the text is gray-on-white. The background stays the same in both modes which are concurrently displayed on the screen. The background has the highest luminance and the foreground changes from gray to black. This change increases the contrast/difference between the background and foreground, but decreases the overall luminance on the screen. The luminance of the black-on-white is less than that of the gray-on-white.

Appellants have indicated that claims 10-33 stand or fall together. (Brief at page 3.)

Independent claim 26 is representative of the invention and reproduced as follows:

26. A method of generating pixel luminance signals corresponding to text to be displayed comprising the steps of:

a) selectively generating an intensity signal specifying a first mode or a second mode;

b) receiving an intensity signal specifying a first mode for selected first text or a second mode for highlighting selected second text concurrently displayed with first text; and

c) generating background pixel luminance signals of a first luminance level

d) decreasing contrast while increasing overall luminance, relative to a second mode, of said first text by generating, in response to foreground pixel signals in the first mode, foreground pixel luminance signals of a second luminance level with less luminance than the first luminance level; and

e) increasing contrast while decreasing overall luminance of said second text to be highlighted by generating, in response to foreground pixel signals in the second mode, foreground pixel luminance signals of a third luminance level with less luminance than the second luminance level, whereby said first text in the first mode and said second text in the second mode are displayed concurrently.

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

Pleva et al. (Pleva) 4,997,398 Dec. 11, 1990

Admitted prior art Figures 1-3 disclosed in the specification

Claims 10-33 stand rejected under 35 U.S.C. § 103 as being unpatentable over Pleva in view of the admitted prior art.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the

appellants, we make reference to the brief² and answer³ for the details thereto.

OPINION

After a careful review of the evidence before us we disagree with the Examiner that claims 10-33 are properly rejected under 35 U.S.C. § 103 and we will not sustain the rejection of claims 10-33.

As a consequence of our review, we make the determinations which follow.

Turning to the rejection of claims 10-33, appellants argue that the claimed invention distinguishes over Pleva. (See brief at page 6.) Appellants state:

[T]he backgrounds for the (sic) both the first mode and the second mode are the same, i.e., 'first luminance level' - in contrast, Pleva discloses making the background still lighter.

That the highlighted text (second mode) is achieved by 'increasing contrast while decreasing overall luminance' - whereas Pleva does not disclose this, but instead says that 'the background still lighter' which would increase luminance."

The Examiner argues that "the claims do not require the first luminance in the first mode is the same as the first luminance in the second mode or the claims are

broad enough to read on the first luminance of Pleva which includes light (or white) and

² Appellants filed a second appeal brief in compliance with 37 CFR 1.192, February 26, 1996, (Paper No. 38). We will refer to this appeal brief as simply the brief.

³ The Examiner responded to the brief with an examiner's answer mailed May 14, 1996, (Paper No. 39). We will refer to this examiner's answer as simply the answer.

lighter (or whiter)." (See answer at page 6, paragraph 2.) With respect to the concurrent display of both modes on the display, the Examiner states that the admitted prior art supplies this teaching and the combination would provide the claimed functionality. (See answer at page 7, paragraphs 3-4.) The Examiner again states that the language of the claims does not require the background to be the same for both the first and second modes. We disagree with the Examiner's interpretation of the claim language.

As pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). As pointed out by our reviewing court, claim language should be read with the "broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification." *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). From a review of the specification and appellants' arguments, the meaning of the limitation in claim 26

of "generating background pixel luminance signals of a first luminance level" is understood to set the background at a set level higher than the second and third levels which will be

displayed concurrently on the display. With the concurrent display of the first and second text in the two modes, the background would be the same on the same display since the second and third levels are limited and described with reference to the first level. If the first luminance level varied then the relationship between the levels may not hold true. Therefore, the Examiner's interpretation of the reference with respect to the claimed invention is in error.

The Examiner's interpretation of the Pleva reference to arguably meet the decreasing contrast then alters the Examiner's interpretation for the second mode. In the second mode, the contrast is increased while the luminance is decreased. The Examiner has argued that generating a lighter background would meet the increasing contrast, but appellants argue that this would increase rather than decrease the overall luminance as required in the claim language. (See brief at page 6.) Pleva does teach making the foreground darker if the background is lighter which would meet the claim limitation of "increasing contrast while decreasing overall luminance . . .", but then the limitation requiring the "decreasing contrast while increasing overall luminance . . ." would not be met by the Pleva reference.

The difference between the admitted prior art and the claimed invention is in the manipulation of decrease in luminance of the foreground from a higher luminance to a

lower luminance when going from the normal to the highlight mode. (See brief at page 8.) Appellants again argue the differences between the admitted prior art and the claimed invention concerning same background and increasing contrast while decreasing luminance. (See brief at page 9.)

We find that the examiner has not met the burden of setting forth a **prima facie** case of obviousness in rejecting claims 10, 17, 26, 30 and 33. Each of independent claim contains similar limitations with respect to luminance and contrast. Our reviewing court has stated that obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." **In re Keller**, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

In regard to the 35 U.S.C. § 103 rejection, the Examiner has failed to set forth a **prima facie** case. 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 prior 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." **Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.**, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), **cert. denied**, 117 S.Ct. 80 (1996)

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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).

The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." ***In re Fritch***, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), **citing *In re Gordon***, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). We note that none of the references address the problem that is being solved by the Appellants' invention, which is the reduction of operator eye fatigue from concurrently displayed material which includes highlighted text. The Examiner has shown portions of the claimed invention in the teachings of the Pleva reference and the admitted prior art, but has not provided a motivation why it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings to achieve the invention as set forth in the language of independent claim 26 and claims 10, 17, 30 and 33.

Instead, it appears to us that the Examiner relied on hindsight in reaching the obviousness determination. However, our reviewing court has said, "[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious

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effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." ***W. L. Gore & Assoc. v. Garlock, Inc.***, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983).

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the Examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is not sufficient to establish a ***prima facie*** case of obviousness with respect to claim 26. Each of claims 10, 17, 26, 30 and 33 contain the same basic limitation concerning the relationship of the three luminance levels with the highest level as the background, the concurrent display and the increase and decreasing contrast. Accordingly, we will not sustain the Examiner's rejection of claims 10, 17, 26, 30 and 33 under 35 U.S.C. § 103.

Since all the limitations of independent claims 10, 17, 26, 30 and 33 are not suggested by the applied prior art, we cannot sustain the examiner's rejection of appealed claims 11-16, 18-26, 27-29 and 31-32 which depends therefrom, under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the examiner rejecting claims 10-33 under 35 U.S.C. § 103 is reversed. The decision of the examiner is reversed.

REVERSED

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JAMES D. THOMAS
Administrative Patent Judge

MICHAEL R. FLEMING
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

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