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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

CHIMEI INNOLUX CORP.,
Requester and Appellant

v.

Patent of MONDIS TECHNOLOGY, LTD.,
Patent Owner and Respondent

Appeal 2011-002708
Reexamination Control 95/000,460
U.S. Patent 6,304,236 B1
Technology Center 3900

Before RICHARD TORCZON, ALLEN R. MacDONALD and
SCOTT R. BOALICK, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The one-month time period for filing a request for rehearing, as recited in 37 C.F.R. § 41.79, and the two-month time period for filing an appeal, as recited in 37 C.F.R. § 1.304 (see 37 C.F.R. § 1.983(b)(1)), both begin to run from the “MAIL DATE” shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE²

Introduction

Appellant appeals under 35 U.S.C. § 134 from a final decision of the primary examiner favorable to the patentability of claims 1 and 2. We have jurisdiction under 35 U.S.C. § 315(b). We reverse.

Exemplary Claim in the Present Appeal

Exemplary independent claim 1 under appeal reads as follows:

1. A display apparatus which receives a video signal and a synchronization signal from an external computer, and which displays an image in accordance with the video signal and synchronization signal on a screen, the display apparatus comprising:

an interface circuit which receives a control signal which is generated by a program that is previously programmed in software used for operating the external computer; and

a memory which stores control data concerning display control, the stored control data is read out by the control signal from the interface circuit;

wherein the displayed image is adjusted in accordance with the control data which is read out from the memory; and

wherein said interface circuit transmits a reception confirmation signal to the external computer, the reception confirmation signal indicates receiving the control signal from the external computer..

Appellant's Contentions

Appellant contends that the Examiner erred in making a final decision favorable to the patentability of claims 1 and 2 because:

(1) The preambles of claims 1 and 2 do not affirmatively limit the claims. (App. Br. 4).

² Hearing held on February 16, 2011.

(2) The phrase “software used for operating [an] external computer” does not distinguish operation during manufacture from other operating environments. (App. Br. 10).³

(3) Claims 1 and 2 are obvious over Takahashi. (App. Br. 13).

(4) Claims 1 and 2 are obvious over the combination of Webb and the RS-232 specification. (App. Br. 18).

Issues on Appeal

Did the Examiner err in making a final decision favorable to the patentability of claims 1 and 2?

ANALYSIS

We have reviewed the Examiner’s rejections in light of Appellant’s above-stated contentions 1-4 that the Examiner has erred. We agree with Appellant’s conclusions. We disagree with the Examiner’s favorable final decision as to the patentability of claims 1 and 2.

Preambles of Claims 1 and 2

Appellant contends that the preambles of claims 1 and 2 do not affirmatively limit the claims. (App. Br. 4). Respondent counters that the preambles inform the patentability of the claims. (Resp. Br. 4).

³ Respondent (Patent Owner) agrees with Appellant that the Examiner erred on this point because the phrase “software used for operating [an] external computer” does not limit the claims. (Resp. Br. 5). Because the parties agree on this point we do not address it further.

The preamble of claim 1 reads:⁴

A display apparatus which receives a video signal and a synchronization signal *from an external computer*, and which displays an image in accordance with the video signal and synchronization signal on a screen, the display apparatus comprising:

(emphasis added). We construe the claim preamble to limit the display to using a particular signal format (video and synchronization signals) for displaying images. We construe the phrase “from an external computer” to merely recite the source of the signals (*see* ‘236 patent figure 7) or the source of the image data that will be used to generate the signals (*see* ‘236 patent figure 8). Appellant is correct in arguing that the Examiner erred in finding that the preamble language “from an external computer” affirmatively limited the claims.

Unlike the particular signal format used by the display, the source is not structurally part of the claimed display apparatus and should not be given weight in determining patentability. Stated differently, the preamble requires the claimed apparatus to be configured for and capable of receiving such signals. (Resp. Br. 4). However, the preamble does not require the structure of the claimed apparatus to include the external computer.⁵

⁴ Other than a minor typographical difference (“which display an image”), the preamble of claim 2 is identical.

⁵ We also note that even if we were to construe the preamble of the claims to require the structure of the external computer, by Patent Owner’s own admission, the preamble would not serve to distinguish over the prior art. The 6,304,236 patent, at column 1, lines 20-47, shows that the entire subject matter found in this preamble is known in the prior art.

*New Ground of Rejection - Takahashi*⁶

We reject claims 1 and 2 under 35 U.S.C. § 103(a) as being unpatentable over Takahashi for the reasons set forth at pages 19-25 of the Requester's Corrected Request For *Inter Partes* Reexamination filed May 4, 2009.

Further, contrary to the Examiner's finding in the Action Closing Prosecution at page 5, the first full paragraph, Takahashi at figure 3 clearly teaches a PC 74 (an external computer) that supplies inspection standards data (image data) via I/O interface 22 to the CPU 20. The CPU 20 in turn outputs adjustment signals to the respective adjustment circuits (imaging system circuit 14 and deflecting system circuit 18) "so as to obtain the provided inspection standards data" on the display 12. Takahashi describes an imaging system circuit 14 and a deflecting system circuit 18. (Takahashi 766 at lower left and 767 at lower right). We conclude that Takahashi's imaging system circuit 14 and deflecting system circuit 18 correspond to video circuit 20 and deflection circuit 21 respectively in figure 1 of the '236 patent. For this reason, Takahashi's imaging system circuit 14 and deflecting system circuit 18 are deemed to operate based on conventional video and synchronization signals respectively.

⁶ The footnote, at page 5 of the Action Closing Prosecution, mistakenly states that the English translation of Takahashi appears to be missing text on page 767. We disagree. The translation is not structured as two columns per page as presumed by the Examiner. Rather, the structure is four columns per page. Each column is in one of the four quadrants of the page. The order to read the columns is upper left, upper right, lower left, and lower right.

At the hearing, the Patent Owner questioned whether Takahashi's "inspection standards data" is "image data" (such as the image data disclosed as being sent between the computer (1e) and the display unit (1f) in figure 8 of the patent under reexamination). (Hr'g Tr. 22:12-17). We find that Takahashi's "inspection standards data" teaches or suggests "image data" because Takahashi states that the PC 74 compares image data sensed by image sensor 70 to the inspection standards data and outputs an adjustment request signal (a control signal) so as to eliminate any deviation there-between. Comparison of the inspection standards data to the sensed image data suggests that either the inspection standards data is itself image data or that the inspection standards data is some known substitute for image data which can be compared to the sensed image data. Given Takahashi's supplying of inspection standards data via I/O interface 22 to the CPU 20, it is either explicitly taught or would be obvious to supply image data via I/O interface 22 to the CPU 20.

New Ground of Rejection - Webb and the RS-232 Specification

We reject claims 1 and 2 under 35 U.S.C. § 103(a) as being unpatentable over Webb and the RS-232 specification for the reasons set forth at pages 35-38 of the Requester's Corrected Request For *Inter Partes* Reexamination filed May 4, 2009.

*New Ground of Rejection*⁷

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.77(b). 37 C.F.R. § 41.77(b) provides “a new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.77(b) also provides that Appellant, WITHIN ONE MONTH FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. The owner of the patent may file a response requesting reopening of prosecution before the examiner. . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.79 by the Board upon the same record. . . .

CONCLUSIONS

The Examiner erred in making a final decision favorable to the patentability of claims 1 and 2.

DECISION

The Examiner’s final decision favorable to the patentability of claims 1 and 2 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

⁷ The DATE OF THE DECISION is the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

Appeal 2011-002708
Reexamination Control 95/000,460
U.S. Patent 6,304,236 B1

REVERSED
37 C.F.R. § 41.77(b)

bim

FOR PATENT OWNER:

DECHERT, LLP
P.O. BOX 390460
MOUNTAIN VIEW, CA 94039-0460

FOR THIRD-PARTY REQUESTER:

COOLEY GODWARD KRONISH, LLP
ATTN: PATENT GROUP
777 6TH STREET, NW
SUITE 1100
WASHINGTON, DC 20001