

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte SHUNPEI YAMAZAKI,  
MASAAKI HIROKI and  
YASUHIKO TAKEMURA

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Appeal No. 96-2591  
Application 07/957,106<sup>1</sup>

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HEARD: June 10, 1999

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Before URYNOWICZ, FLEMING and RUGGIERO, Administrative Patent Judges.

URYNOWICZ, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1-17, all the claims pending in the application.

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<sup>1</sup> Application for patent filed October 7, 1992.

The invention pertains to a method of driving an active matrix display. Claim 1 is illustrative and reads as follows:

1. A method of driving an electro-optical device of an active matrix structure comprising the steps of:

converting an input analog signal into a numerical value of N-radix notation where N $\geq$ 3 or a signal corresponding thereto; and

applying a plurality of voltage pulses having pulse heights and pulse widths based on said numerical value or said signal corresponding thereto to a pixel of said electro-optical device,

wherein an average effective voltage of said voltage pulses is close to an arbitrary voltage; and

wherein both the said pulse widths and said pulse heights are varied so that the minimum width of said pulses can be increased.

The references relied upon by the examiner as evidence of obviousness are:

Aoki et al. (Aoki)	4,775,891	Oct. 04, 1988
Morris et al. (Morris)	5,010,328	Apr. 23, 1991

Appellants' admitted prior art at pages 1-4.

Claims 1-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending application Serial No. 07/957,107.

Claims 1-17 stand rejected under 35 U.S.C. § 103 as being unpatentable over the admitted prior art (Figure 1A) in view of Aoki and Morris.

The respective positions of the examiner and the appellants with regard to the propriety of these rejections are set forth in the final rejection, the examiner's answer, answer to the reply brief and supplemental examiner's answer (Paper Nos. 9, 22, 25 and 27, respectively) and the appellants' brief, reply brief and supplemental reply brief (Paper Nos. 21, 24 and 26, respectively).

### Opinion

We will not sustain the rejection of claims 1-17 over the prior art.

Our analysis of the claims and prosecution history of appellants' application indicate that considerable speculation as to the meaning of certain terms employed and assumptions as to the scope of such claims was made by the examiner and appellants. With respect to independent claim 1, the examiner contends that the language "converting an input analog signal into a numerical value of N-radix notation where N $\geq$ 3 or a signal corresponding thereto" is broad and is met by prior art disclosing converting an input analog signal into a signal corresponding thereto. In contrast, appellants argue that the above language requires converting an input analog signal into a numerical value of N-radix notation where N $\geq$ 3 or converting an input analog signal to a numerical value corresponding to a N-radix notation where N $\geq$ 3. A like disagreement exists with respect to similar language of the only other independent claim, claim 13, at lines 5-7.

Because no reasonably definite meaning can be ascribed to the above language of claims 1 and 13 and, consequently, the dependent claims 2-12 and 14-17, the subject matter cannot be considered

Appeal No. 96-2591  
Application 07/957,106

obvious but, rather, is indefinite. In re Wilson, 424 F.2d 1382, 185 USPQ 494 (CCPA 1970). It is improper to rely on speculative assumptions as to the meaning of a claim and reject the claim as obvious under 35 U.S.C. § 103. In re Steele, 305 F.2d 858, 134 USPQ 292 (CCPA 1962).

In view of the indefiniteness of the claims, we will not sustain the rejection of claims 1-15 on the basis of obviousness-type double patenting.

Our reversal of the rejections under 35 U.S.C. § 103 and under the judicially created doctrine of obviousness-type double patenting is not a reversal on the merits of the rejection, but rather a procedural reversal predicated on the indefiniteness of the claimed subject matter.

The following new rejection is entered pursuant to 37 C.F.R. § 1.196(b).

Claims 1-17 are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellants regard as the invention. This rejection is based on the preceding analysis of the claims.

At the oral hearing before the Board on June 10, 1999, counsel for appellants represented that appellants were agreeable to this course of action by the Board, thus enabling further prosecution before the examiner so as to amend the claims to overcome their indefiniteness as to the term “a numerical value of N-radix notation...” and to have the rejections under 35 U.S.C. § 103 and double patenting reconsidered in view of the amendments.

Summary

(a) the rejection of claims 1-17 under 35 U.S.C. § 103 is not sustained;

(b) the rejection of claims 1-15 under the judicially created doctrine of obviousness-type double patenting is not sustained;

(c) a new rejection of appealed claims 1-17 is entered pursuant to 37 C.F.R. § 196(b).

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 C.F.R.

§ 1.196(b) provides that, “A new ground of rejection shall not be considered final for purposes of judicial review.”

37 C.F.R. § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Appeal No. 96-2591  
Application 07/957,106

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

REVERSED  
37C.F.R. § 1.196(b)

STANLEY M. URYNOWICZ, JR. )  
Administrative Patent Judge )  
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)  
) BOARD OF PATENT  
MICHAEL R. FLEMING )  
Administrative Patent Judge ) APPEALS AND  
)  
) INTERFERENCES  
)  
JOSEPH F. RUGGIERO )  
Administrative Patent Judge )

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Appeal No. 96-2591  
Application 07/957,106

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