

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SANFORD S. LUM, ADRIAN HARTOG, FRIDTJOF M.G. WEIGEL,
JOSH GROSSMAN and DAN O. GUDMUNDSON

Appeal No. 1999-0409
Application 08/425,741

ON BRIEF

Before JERRY SMITH, DIXON and BARRY, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-12, which constitute all the claims in the application.

The disclosed invention pertains to a method for providing text data for display in a processor controlled

apparatus.

Representative claim 1 is reproduced as follows:

1. A method of providing text data for display in a processor controlled apparatus comprising:

(a) storing data defining a text character in a memory, in packed monochrome bit map form,

(b) addressing the memory to read the text character data,

(c) providing the text character in packed form to a graphics processor circuit,

(d) performing a bitblt operation on each bit of the packed form of text character while providing a color attribute, and

(e) storing the packed text character having a color attribute for subsequent display.

The examiner relies on the following references:

Guttag et al. (Guttag)	5,522,082	May 28, 1996 (filed Oct. 23, 1992)
Morse et al. (Morse)	5,590,260	Dec. 31, 1996 (filed Dec. 30, 1993)

The admitted prior art.

Claims 1-12 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers the admitted prior art in view of Guttag and Morse.

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Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we reverse.

Before we discuss the substantive issues in this case, we note that appellants have asked us to rule on the propriety of the action of March 31, 1997 being made final by the

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examiner [reply brief]. The question of the propriety of making an Office action final, however, is not within our jurisdiction. We only decide if rejections have been properly made. The proper way for an applicant to contest a premature final rejection is to

petition the Commissioner under 37 CFR § 1.181. Thus, we do not rule on this question.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley

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Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.),
cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta
Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657,
664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS
Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221
USPQ 929, 933 (Fed. Cir. 1984). These showings by the
examiner are an essential part of complying with the burden of
presenting a prima facie case of obviousness. Note In re
Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir.
1992). If that burden is met, the burden then shifts to the
applicant to overcome the prima facie case with argument
and/or evidence. Obviousness is then determined on the basis
of the evidence as a whole and the relative persuasiveness of
the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039,
228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d
1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re
Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).
Only those arguments actually made by appellants have been
considered in this decision. Arguments which appellants could
have made but chose not to make in the brief have not been
considered [see 37 CFR

§ 1.192(a)].

We consider first the rejection of independent claims 1 and 2. The examiner finds that the admitted prior art teaches all the features of these claims except for a method for addressing a memory and for performing a bit block transfer on each bit of the packed form of text character while providing a color attribute. The examiner cites Guttag as teaching a method comprising registers for storing addressing information of memories, and the examiner finds that it would have been obvious to the artisan to have modified the admitted prior art with the teachings of Guttag so that data could be written into or read out from a predetermined position of memory. The examiner cites Morse as teaching a bit block transfer [bitblt] on each bit of the packed form of text data. The examiner finds that it would have been obvious to modify the admitted prior art with the teachings of Morse to increase the display efficiency of a data processing system [answer, pages 3-4].

Appellants argue that the admitted prior art teaches that a bit map is stored in off-screen memory 23 in sparse monochrome form and not in packed form as contended by the

examiner [brief, page 9]. Thus, appellants argue that the bitblt of the admitted prior art is performed on sparse bit-map data rather than on packed bit-map data as claimed [id., pages 9-11]. With respect to independent claim 2, appellants additionally argue that the bitblt operation set forth in clause (c) of claim 2 is not the same as the bitblt operation taught by Morse [id., pages 12-15].

The examiner responds that the term "packed text character" is very broad and is met by appellants' block of text character data or by Morse's rectangular region of text character data. The examiner finds that the text data is in packed form regardless of whether the text data is packed with spaces [answer, pages 5-6]. With respect to claim 2, the examiner simply disagrees with appellants.

We agree with appellants' position as argued in the briefs. The examiner cannot rely on the admitted prior art and then change what is taught by the admitted prior art. The admitted prior art indicates that in monochrome bitblt, "sparse monochrome (i.e. only one bit in each byte) sources have been used for the color expansion of one destination pixel" [specification, page 2]. The admitted prior art also

notes that "[c]haracter bitmaps provided by the Windows GUI are mostly packed, that is, all bits per source byte are used during the bitblt" [specification, pages 2-3]. Thus, the admitted prior art clearly defines the difference between sparse data and packed data.

There is no question that the admitted prior art teaches a bitblt operation being performed on a sparse monochrome bitmap [off-screen memory 23 of admitted prior art Figure 2]. The examiner's attempt to redefine this sparse monochrome bitmap memory as a packed form of text character memory has to fail as it contradicts what is clearly taught by the admitted prior art. Since the admitted prior art does not teach a bitblt operation on each bit of the packed form of text character as recited in independent claim 1, the examiner has failed to establish a prima facie case of obviousness. Therefore, we do not sustain the examiner's rejection of claim 1 or of claims 3-7 which depend therefrom.

With respect to independent claim 2, we agree with appellants that the bitblt steps set forth in claim 2 are not taught or suggested by Morse for the reasons noted by appellants in the briefs. Therefore, we do not sustain the

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examiner's rejection of independent claim 2 or of claims 8-12
which depend therefrom.

In summary, we have not sustained the examiner's
rejection of the claims on appeal. Therefore, the decision of
the examiner rejecting claims 1-12 is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
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JOSEPH L. DIXON)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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