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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* PAUL DRZAIC and RUSSELL J. WILCOX

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Appeal 2010-009851  
Application 10/827,745  
Technology Center 2600

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Before THU A. DANG, JAMES R. HUGHES, and  
GREGORY J. GONSALVES, *Administrative Patent Judges*.

GONSALVES, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the final rejection of claims 38, 41-45, 48, and 50 (App. Br. 5). We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

*The Invention*

Exemplary Claim 38 follows:

38. An encapsulated electrophoretic display comprising:

a full-color pixel comprising a first addressable sub-pixel and a second sub-pixel independently addressable from the first sub-pixel, wherein the first sub-pixel comprises a first electrophoretic medium comprising first particles in a suspending fluid and the second sub-pixel comprises a second electrophoretic medium comprising second particles in a suspending fluid, at least some of the second particles having a color different from the color of the first particles, each of the first and second sub-pixels being capable of displaying three colors selected from the group consisting of white, black, red, green, blue, cyan, magenta and yellow when addressed, the first sub-pixel being capable of displaying at least one color different from the colors capable of being displayed by the second sub-pixel.

Claims 38, 41-45, 48 and 50 stand rejected under 35 USC 112, first paragraph as failing to comply with the written description requirement (Ans. 3-7).

Claims 38, 41-45, 48 and 50 stand rejected under 35 U.S.C. § 112 as failing to comply with the enablement requirement (Ans. 7-8).

Claims 38, 41-45, 48, and 50 stand rejected under 35 USC 102(b) as anticipated by Ota (U. S. Patent No. 3,870,517) (Ans. 9-11).

## ISSUES

Appellants' responses to the Examiner's positions present the following issues:

1. Did the Examiner err in concluding that claims 38, 41-45, 48 and 50 fail to comply with a) the written description requirement and b) the enablement requirement?
2. Did the Examiner err in finding that finding that Ota discloses "a first addressable sub-pixel and a second sub-pixel independently addressable from the first sub-pixel," as recited in independent claim 38?

## ANALYSIS

### *35 U.S.C. § 112 First Paragraph Rejection of Claims 38, 41-45, 48 and 50*

The Examiner found that claims 38 and 45 fail to comply with the written description requirement of 35 U.S.C. § 112, first paragraph, because the Specification "does not teach a sub-pixel comprising an electrophoretic medium" (Ans. 3 and 5 (emphasis omitted)). With respect to claim 38, the Examiner also found that the Specification does not teach "the claimed limitation, 'each of the first sub-pixel and the second sub-pixel being capable of displaying three colors selected from the group consisting of white, black, red, green, blue, cyan, magenta and yellow when addressed'" (Ans. 7 (emphasis omitted)). With respect to claim 45, the Examiner found that the Specification does not teach "the claimed limitation 'the third sub-pixel being capable of displaying three colors selected from the group consisting of white, black, red, green, blue, cyan, magenta and yellow when addressed'" (*id.* at 5-6).

In response, Appellants argue that the claims do meet the written description requirement because “Figure 31 [of the Specification] shows three different capsules 22, 22' and 22'', each of which comprises two differently colored types of particles in a suspending fluid. By virtue of the different colors which these three capsules can display, they constitute three different sub-pixels” (App. Br. 12). Appellants also argue that the Specification discloses “the basic idea of forming a color pixel using three sub-pixels each of which is capable of displaying three colors. Furthermore, these three paragraphs explicitly disclose that the relevant colors can include white, black, red, green, blue, cyan, magenta and yellow” (*id.* at 14).

We agree with Appellants. The Specification describes “full color electrophoretic displays and methods of creating full-color microencapsulated electrophoretic displays” (p. 1, ll. 1-5) and discloses that “FIG. 1A depicts a single capsule 20 of an encapsulated display media” (p. 20, l. 9). The Specification also discloses that subpixels “may each be contained in a single large capsule” (p. 23, ll. 13-15). That is, the Specification teaches that a sub-pixel is a capsule comprising electrophoretic media, as recited in claims 38 and 45. Moreover, the Specification discloses various embodiments wherein each pixel comprises three sub-pixels and each sub-pixel displays three of the following colors: white, black, red, green, blue, cyan, magenta and yellow (*see* p. 29, l. 21 – p. 30, l. 27). Accordingly, we find error in the Examiner’s written description rejection of claims 38 and 45 as well as the remaining claims on appeal (i.e., claims 41-44, 48 and 50) because the Examiner did not set forth an independent basis for his finding that those claims did not meet the written description requirement (*see* Ans. 5).

The Examiner also rejected claims 38, 41-45, 48 and 50 for failing to comply with the enablement requirement and set forth the same grounds in support of this rejection as provided for the written description rejection (Ans. 7-8). Accordingly, for the reasons expressed *supra* with respect to these grounds, we also find error in the Examiner's enablement rejection of claims 38, 41-45, 48 and 50.

*35 U.S.C. § 102(b) Rejection of Claims 38, 41-45, 48 and 50*

Appellants contend that the Examiner erred in rejecting independent claim 38 as anticipated by Ota “because it does not disclose “[a]n encapsulated electrophoretic display comprising a full-color pixel comprising a first addressable sub-pixel and a second sub-pixel independently addressable from the first sub-pixel, wherein the first sub-pixel comprises a first electrophoretic medium comprising first particles in a suspending fluid and the second sub-pixel comprises a second electrophoretic medium comprising second particles in a suspending fluid” (App. Br. 17). In support of their contention, Appellants argue that “there are in Ota no true sub-pixels” (*id.*). The Examiner found, however, that Ota discloses this claim limitation because it “further teaches each suspension unit (shown in Fig. 5) corresponding to each of the first, second and third sub-pixels and comprising an electrophoretic medium, which is separated from the other electrophoretic medium by an insulating sheet (41) (see Fig. 5; col. 11, lines 36-55).” (Ans. 13).

Claim 38, however, requires more than a separation of electrophoretic medium, it requires a second sub-pixel that is independently addressable from the first subpixel. Here we find the Examiner did not show that Ota

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discloses independently addressable subpixels. Accordingly, we will not sustain the Examiner's anticipation rejection of independent claim 38 as well as claims 41-45, 48 and 50 dependent therefrom.

#### DECISION

We reverse the Examiner's decision rejecting claims 38, 41-45, 48, and 50 as failing to meet the written description and enablement requirements and as being anticipated by Ota.

REVERSED

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