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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MITSUO HAYASHI¹

Appeal 2018-002229
Application 14/260,036
Technology Center 2600

Before CAROLYN D. THOMAS, ADAM J. PYONIN, and
AMBER L. HAGY, *Administrative Patent Judges*.

PYONIN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner’s decision to reject claims 1, 3–9, and 11–14, which are all the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ “The real party in interest is JVC KENWOOD CORPORATION.” App. Br. 1.

STATEMENT OF THE CASE

Introduction

The Application is directed to “an information display device that includes . . . a display processing unit configured to display [] superimposed information in the display unit.” Abstract. Claims 1, 13, and 14 are independent. Claim 1 is reproduced below for reference:

1. An information display device comprising:
 - a transmittance setting unit configured
 - to set, to a first character transmittance, a character information transmittance that indicates a degree that character information included in first display information of display information to be displayed in a display unit transmits second display information that is the display information,
 - to set, to a first image transmittance that is a higher value than the first character transmittance, an image information transmittance that indicates a degree that image information included in the first display information transmits the second display information,
 - to set a transmittance of the character information included in the second display information to a second character transmittance, and
 - to set a transmittance of the image information included in the second display information to a second image transmittance that is a lower value than the second character transmittance;
 - a superimposed information generation unit configured
 - to generate superimposed information in which the first display information, which includes the character information and the image information to which the transmittances have been set by the transmittance setting unit, and the second display information, which includes the character information and the image information to which the transmittances have been set by the transmittance setting unit, are superimposed; and
 - a display processing unit configured

to display the superimposed information in the display unit,

wherein each of the transmittance setting unit, the superimposed information generation unit, and the display processing unit is hardware or a combination of hardware and software.

References and Rejections

Claims 1, 3–9, and 11–14 stand rejected under 35 U.S.C. § 101 for being directed to patent-ineligible subject matter. Final Act. 5–6.²

Claims 1, 3–9, and 11–14 stand rejected under 35 U.S.C. § 102(b) for being anticipated by over Nakanishi (US 2008/0068670 A1; Mar. 20, 2008). Final Act. 8.

ANALYSIS

We have reviewed the Examiner’s rejections in light of Appellant’s arguments. We have considered in this Decision only those arguments Appellant actually raised in the Briefs. Any other arguments Appellant could have made but chose not to make in the Briefs are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

I. 35 U.S.C. § 101

Appellant argues “the claims are not directed to an abstract idea, and the Office Action has failed to meet the *prima facie* legal requirements for a rejection under 35 U.S.C. § 101 based on a judicial exception.” App. Br. 11.

² In the heading of the rejection, the Examiner does not list claim 14. *See* Final Act. 5. We find this harmless error, as both Appellant and the Examiner acknowledge that, “[a]lthough of different scope, independent claims 13 and 14 have similar recitations” as claim 1. App. Br. 12; Ans. 3.

We are not persuaded the Examiner errs in determining the claims are not patent eligible. *See* Final Act. 2–3, 5–6; Ans. 3–8. We adopt the Examiner’s reasoning therein, to the extent consistent with our analysis.

A. Abstract Concept

Appellant argues independent claim 1 is not directed to an abstract concept pursuant to step one of the *Alice* patent eligibility framework, because the recited “features do not fall under any of the judicially identified exceptions to 35 U.S.C. § 101.” App. Br. 12; *see also Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014). Appellant further argues “the claims of the present application are directed to patent-eligible subject matter because their plain focus is on an improvement to the functionality of the technology itself.” Reply Br. 8; *see also* App. Br. 12–13.

We are not persuaded the Examiner errs in determining the “claims are found to be similar to the abstract idea of collecting, organizing and displaying information” (Ans. 4) as the claimed “steps of setting character transmittance and generating superimposed information describe[] the abstract idea of data storage and recognition since the character transmittances [are] stored and then used to generate superimposed information display” (Final Act. 2–3). Claim 1 recites computer “unit[s]” are configured to set various parameters of first and second “display information,” and then display the combined information as a superimposed image. *See* Figs. 2–4C. The claim is thus directed to an abstract concept, as our reviewing court has held that claims comparably directed to calculating information for display are abstract. *See RecogniCorp, LLC v. Nintendo Co., Ltd.*, 855 F.3d 1322, 1326 (Fed. Cir. 2017) (“the abstract idea of

encoding and decoding image data”); *see also Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344, 1351 (Fed. Cir. 2014) (“an ineligible abstract process of gathering and combining data”); *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1241 (Fed. Cir. 2016) (“[T]hese patents are directed to an abstract idea . . . [as] the claims are directed to certain functionality—here, the ability to generate menus with certain features.”); *Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1340 (Fed. Cir. 2017) (“the patent claims are, at their core, directed to the abstract idea of collecting, displaying, and manipulating data”).

Further, we agree with the Examiner that Appellant’s “argued improvement is not tied to [] specific computer implementations,” as the “[c]laimed steps of setting transmittance, generating superimposed information display and displaying superimposed information display does not recite limitations that [are] beyond basic computer functionality.” Ans. 6; *see also* Fig. 13. Claim 1 recites a system that combines and displays information, and each of the recited system units “is hardware or a combination of hardware and software.” The claimed system does not patentably “improve[] the functioning of a computer,” as a claim that “started with data, added an algorithm, and ended with a new form of data was directed to an abstract idea.” *RecogniCorp*, 855 F.3d at 1327 (citing *Digitech*, 758 at 1351).

Accordingly, we agree with the Examiner that claim 1 is directed to an abstract concept. *See* Ans. 4–5, 7–8.

B. Significantly More

Appellant argues “[a]s to the second step of the *Alice* test, the invention here is ‘significantly more’ than an abstract idea itself.” App. Br. 14. Particularly, Appellant contends “the invention here is similar to the inventions considered by the Federal Circuit in *Bascom* . . . and *Amdocs*.” App. Br. 14–15; *Bascom Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016); *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288 (Fed. Cir. 2016).

We are not persuaded the system of claim 1 is similar to claims found patent-eligible under step two of the *Alice* framework. In *Bascom*, “the claimed invention represents a ‘software-based invention[] that improve[s] the performance of the computer system itself.’” *Bascom*, 827 F.3d at 1351. In *Amdocs*, “claim 1 solves a technological problem (massive data flows requiring huge databases)” and “is a technical improvement over prior art technologies and served to improve the performance of the system itself.” *Amdocs*, 841 F.3d at 1302. Unlike the claims in these cases—and discussed above with respect to step one of the *Alice* framework—Appellant’s claim 1 does not provide improvements to the computer system itself. Rather, the claim, as described by Appellant, uses an algorithm to combine display information. See Reply Br. 13. Thus, we are not persuaded the Examiner errs in finding the “claim limitations describe a generic recitation of [a] computer performing basic computer functions and would not add significantly more than the abstract idea.” Ans. 5–6; see also *RecogniCorp*, 855 F.3d at 1328 (“[C]laim 1 is directed to the abstract idea of encoding and decoding. The addition of a mathematical equation that simply changes the data into other forms of data cannot save it.” Moreover, “tak[ing] an

abstract idea and appl[ying] it with a computer” does not transform a claim into a patent-eligible application.).

C. Prima Facie Case

Appellant argues the following:

The Office Action fails to meet the *prima facie* legal requirements for a rejection under 35 U.S.C. based on a judicial exception because the Office Action (A) has inappropriately abstracted the claims away from their recited function, (B) has failed to recite any case law supporting the assertion that the claims fall under a judicial exception, and (C) has failed to provide any evidence or articulated reasoning supporting the Office Action assertion.

App. Br. 15–16.

We are not persuaded of reversible error in the Examiner’s rejection. Based on the record before us, the Examiner has properly performed the § 101 analysis. *See, e.g.*, Ans. 4–8. That is, as discussed above, we find the Examiner correctly determined claim 1 is directed to an abstract concept and that the elements of the claim, considered both individually and as an ordered combination, do not transform the nature of the claim into a patent-eligible application. *See* Final Act. 2–3, 5–6; Ans. 4–8. Thus, we find Appellant has been notified of the reasons for the rejection with such information “as may be useful in judging of the propriety of continuing the prosecution of [the] application,” as required. *In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (alteration in original) (quoting 35 U.S.C. § 132).

Accordingly, we sustain the Examiner’s rejection of independent claim 1 under 35 U.S.C. § 101. For the same reasons, we sustain the Examiner’s rejection of independent claims 13 and 14, and the dependent claims, under 35 U.S.C. § 101. *See* App. Br. 12, 13.

II. 35 U.S.C. § 102(b)

Appellant argues the Examiner’s anticipation rejection is in error, because “Nakanishi does not disclose all of the features of claim 1.” App. Br. 22. Particularly, Appellant contends “[c]laim 1 recites two values associated with the first display information and two values associated with the second display information, and further describes a relationship between the two values for each display information,” whereas “Nakanishi is completely silent as to such a relationship.” App. Br. 21–22.

We are persuaded by Appellant’s argument. “[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed.” *Net MoneyIn, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008).

Independent claim 1 recites “the first display information, which includes the character information and the image information to which the transmittances have been set,” and “second display information, which includes the character information and the image information to which the transmittances have been set.” The Examiner finds Nakanishi teaches³ first and second character information and first and second image information. *See* Ans. 11 (“there may be two character image elements and two graphics image elements -teaching claimed first and second character information and first and second image information.”). The Examiner also finds Nakanishi discloses display information “containing multiple image elements,” such as alpha blending values. Ans. 12. Claim 1, however, requires that the recited

³ We note the rejection before us is one of anticipation, not obviousness.

image and character information are both included in each of the first and second “display information.” The Examiner’s analysis is silent with respect to the display information having *both* character and image information. *See* Ans. 11–13. Accordingly, the Examiner has not established that Nakanishi discloses all of the limitations arranged in the same way as recited by the claim.

We find the Examiner errs in determining Nakanishi anticipates the limitations of independent claim 1, and independent claims 13 and 14 which recite similar limitations. *See* App. Br. 22. We do not sustain the Examiner’s 35 U.S.C. § 102(b) rejection of these claims, or the claims dependent thereon.

DECISION

The Examiner’s decision rejecting claims 1, 3–9, and 11–14 under 35 U.S.C. § 101 is affirmed.

The Examiner’s decision rejecting claims 1, 3–9, and 11–14 under 35 U.S.C. § 102(b) 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).

AFFIRMED