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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RONG LIU, YU P. SUN,
JUN QI, and VICTOR H. YIN

Appeal 2018-009205
Application 14/943,202
Technology Center 2800

Before KAREN M. HASTINGS, LILAN REN, and
MICHAEL G. MCMANUS, *Administrative Patent Judges*.

REN, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The record on appeal includes the Specification filed November 17, 2015 (“Spec.”), the Examiner’s Final Action mailed January 12, 2018 (“Final Act.”), the Examiner’s Final Office Action mailed September 15, 2017 (“Final Act.”), Appellants’ Appeal Brief filed June 1, 2018 (“App. Br.”), the Examiner’s Answer mailed September 5, 2018 (“Ans.”), and Appellants’ Reply Brief filed September 26, 2018 (“Reply Br.”).

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 11, 13, and 16–18.^{2, 3} We have jurisdiction under 35 U.S.C. § 6(b).

We procedurally reverse and enter a new ground of rejection pursuant to 37 CFR § 41.50(b).

CLAIMED SUBJECT MATTER

The claims are directed to a display backlight with an optical film. Claim 11, reproduced below, is illustrative of the claimed subject matter (emphasis added to highlight a key limitation):

11. A display comprising:
 - a plurality of light-emitting diodes;
 - an upper polarizer;
 - a lower polarizer;
 - first and second transparent substrates interposed between the upper and lower polarizers;
 - a liquid crystal layer between the first and second transparent substrates;
 - a turning film that comprises a plurality of protrusions, wherein each protrusion of the plurality of protrusions comprises a concave surface and a surface that is positioned at an angle with respect to the concave surface; and

² Appellants identify “Apple Inc.” as the real party in interest. Br. 2.

³ Appellants state that the “claims currently on appeal are claims 11, 13, and 16–18” (Reply Br. 2) which is consistent with the Examiner’s statement that the rejection of claims 11, 13, and 16–18 is on appeal. Ans. 7. Although the Claims Appendix of the Appeal Brief includes claims other than 11, 13, and 16–18, our opinion only addresses the rejections of 11, 13, and 16–18 and the references from which the appeal arises. *Compare* Final Act. 2 (stating that claims 12 and 21 are withdrawn, claims 19 and 20 have been allowed, claim 23 is objected to as being dependent from a rejected claim, and claim 21 has been withdrawn), *with* App. Br. 2 (stating that claims “11–13, 16–21, and 23 are pending.”).

a light guide layer configured to pass backlight from the plurality of light-emitting diodes through the turning film, the lower and upper polarizers, the first and second substrates, and the liquid crystal layer, wherein the turning film has a top surface, wherein the turning film is interposed between the liquid crystal layer and the light guide layer, wherein each protrusion of the plurality of the protrusions extends away from the top surface of the turning film towards the light guide layer, and *wherein the surface of each protrusion is interposed between the plurality of light-emitting diodes and the respective concave surface of that protrusion.*

App. Br. 12–13 (Claims Appendix).

REFERENCES

The prior art references relied upon by the Examiner in rejecting the claims on appeal are:

Akins et al. (hereinafter “Akins”)	US 6,166,787	Dec. 26, 2000
Ouderkirk et al. (hereinafter “Ouderkirk”)	US 2011/0149554 A1	Jun. 23, 2011

REJECTIONS

Claims 11 and 16 are rejected under 35 U.S.C. 103 as unpatentable over Ouderkirk and Akins. Final Act. 5–7.

Dependent claims 13, 17, and 18 are rejected under 35 U.S.C. 103 as unpatentable over Ouderkirk, Akins, and additional respective references.

Final Act. 7–9.

OPINION

Appellants argue that the Examiner erred in finding that the prior art teaches or suggests each and every limitation of claim 11 including the limitation “wherein the surface of each protrusion is interposed between the plurality of light-emitting diodes and the respective concave surface of that protrusion.” Br. 10.

“[I]f a claim is amenable to two or more plausible claim constructions, the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim unpatentable under 35 U.S.C. § 112, second paragraph, as indefinite.” *Ex parte Miyazaki*, 89 USPQ 2d 1207, *5 (BPAI 2008) (precedential).

In this case, this claim language “wherein the surface of each protrusion is interposed between the plurality of light-emitting diodes and the respective concave surface of that protrusion” is unclear as to whether “the surface of each protrusion is interposed between” “the respective concave surface of that protrusion” and (1) a respective one of “the plurality of light-emitting diodes” or (2) all of “the plurality of light-emitting diodes.” The specification including the hand-drawn illustrations does not appear to clearly support either interpretation. *See* Br. 4 (citing FIGS. 6–8 and paragraphs 47 and 49 as support for this claim element); *see also Carnegie Mellon Univ. v. Hoffmann-La Roche Inc.*, 541 F.3d 1115, 1122 (Fed. Cir. 2008) (holding that the specification is required under 35 U.S.C. § 112 to

“convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention”).⁴

Review of the rejection under 35 U.S.C. § 103 would therefore require considerable speculation as to the scope of claim 11. Such speculation would not be appropriate. *In re Steele*, 305 F.2d 859, 862 (CCPA 1962) (“[W]e do not think a rejection under 35 U.S.C. § 103 should be based on such speculations and assumptions.”). We, therefore, procedurally reverse the 35 U.S.C. § 103 rejection of claim 11 as well as the 35 U.S.C. § 103 rejection of claims 16, 13, 17, and 18. We emphasize that this is a technical reversal of the rejections under 35 U.S.C. § 103, and not a reversal based upon the merits of the rejections.

We accordingly enter a new ground of rejection that claim 11 is indefinite under 35 U.S.C. § 112 (b). As a result, dependent claims 13, and 16–18 are also rejected for indefiniteness.

CONCLUSION

The Examiner’s decision is reversed.

Claims Rejected	Basis	Affirmed	Reversed	New Ground
11, 13, and 16–18	35 U.S.C. § 103		11, 13, and 16–18	
11, 13, and 16–18	35 U.S.C. § 112 (b)			11, 13, and 16–18
Overall Outcome	35 U.S.C. § 112 (b)			11, 13, and 16–18

⁴ Should prosecution continue after the appeal, Appellants and the Examiner should consider whether this claim limitation complies with the written description requirement under 35 U.S.C. § 112(a).

A new ground of rejection of claim 11, 13, and 16–18 for indefiniteness under 35 U.S.C. § 112 (b) has been entered.

TIME PERIOD FOR RESPONSE

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides:

When the Board enters such a non-final decision, the appellants, 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 the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellants may again appeal to the Board pursuant to this subpart.

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new

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ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

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).

REVERSED; NEW GROUND OF REJECTION