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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHANG-YEOP KIM, WON-KYU KWAK, JEONG-YEOL LEE,
and GYOO-CHUL JO, JUNG-HO CHOI

Appeal 2019-000722
Reexamination Control 96/000,213
Patent No. US 8,730,191 B2
Technology Center 3900

Before JOHN A. JEFFERY, MARC S. HOFF, and ERIC B. CHEN,
Administrative Patent Judges.

HOFF, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from the rejection of claims 1–7 and 15–20.¹ We have jurisdiction under 35 U.S.C. §§ 134(b) and 306.

We reverse and enter a new ground of rejection.

The '191 patent issued to Kim on May 20, 2014. The '191 patent is a touch screen panel protected against failure due to static electricity. Kim includes a plurality of static electricity induction patterns extending between

¹ Claims 8–14 have been cancelled.

first and second sensing cells such that an end portion overlaps the neighboring sensing cell. Abstract.

Claim 1 is exemplary of the claims on appeal:

1. A touch screen panel, comprising:
 - a transparent substrate;
 - a plurality of first sensing cells connected along a first direction on the transparent substrate, and a plurality of second sensing cells disposed between the respective first sensing cells and connected along a second direction;
 - a plurality of first connection patterns which connect the first sensing cells along the first direction;
 - a plurality of second connection patterns which connect the second sensing cells along the second direction;
 - a plurality of static electricity induction patterns, each static electricity induction pattern being connected to one of the first sensing cells or one of the second sensing cells, and extending in a direction toward a sensing cell immediately adjacent to a sensing cell to which said each static electricity induction pattern is connected so that an end portion of the static electricity induction pattern overlaps the adjacent sensing cell;
 - and
 - a first insulating layer interposed between the first and second connection patterns and between said each static electricity induction pattern and the adjacent sensing cell, wherein the static electricity conduction pattern extends from an end of one of the connection patterns to one of the sensing cells that is not connected to the one of the connection patterns.

App. Br. 8 (Claims Appendix).

The Examiner relies upon the following prior art in rejecting the claims on appeal:

Lin et al.	CN101655755	Feb. 24, 2010
Guo et al.	CN101840285	Sept. 22, 2010

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Throughout this decision, we make reference to Appellants' Brief ("App. Br.," filed July 20, 2018), the Reply Brief ("Reply Br.," filed Oct. 22, 2018) and the Examiner's Answer ("Ans.," filed Aug. 22, 2018) for their respective details.

REJECTIONS

Claims 1–5 and 15–20 stand rejected under pre-AIA 35 U.S.C. § 102(b) as being anticipated by Lin.

Claims 6 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lin and Guo.

ISSUE

Appellants' arguments present us with the following issue:

Does Lin disclose all of the limitations of independent claim 1 with a single embodiment?

ANALYSIS

CLAIMS 1–5 AND 15–20

Claim 1 recites, *inter alia*,

“a plurality of first sensing cells connected along a first direction on the transparent substrate, and a plurality of second sensing cells disposed between the respective first sensing cells and connected along a second direction;”

“a plurality of first connection patterns which connect the first sensing cells along the first direction;”

“a plurality of second connection patterns which connect the second sensing cells along the second direction;”

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“a plurality of static electricity induction patterns, each . . . being connected to one of the first sensing cells or one of the second sensing cells, and extending in a direction toward a sensing cell immediately adjacent to a sensing cell to which said each static electricity induction pattern is connected so that an end portion of the static electricity induction pattern overlaps the adjacent sensing cell;”

“wherein the static electricity induction pattern extends from an end of one of the connection patterns to one of the sensing cells that is *not* connected to the one of the connection patterns” (emphasis added).

As noted *supra*, the Examiner rejected independent claim 1, and dependent claims 2–5 and 15–20, under 35 U.S.C. § 102(b) as being *anticipated* by Lin. Final Act. 8.

Figure 2A of Lin is reproduced below:

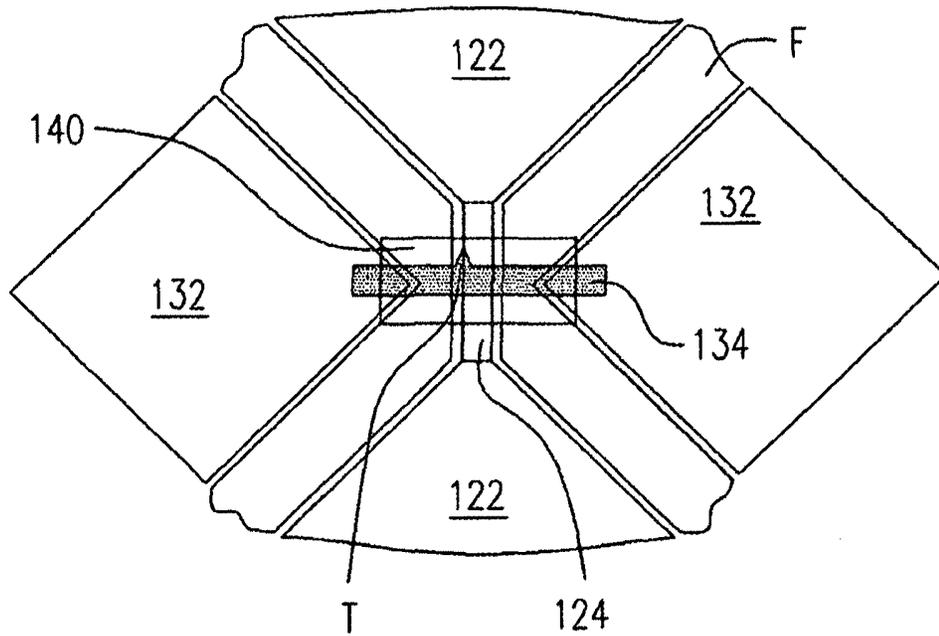


图2A

Figure 2A represents an enlarged schematic view of the first embodiment of the touch panel of Lin. Lin p. 5. Figure 2A includes disclosure of a first bridge portion 124 that connects sensing pads 122, and a second bridge portion 134 that connects sensing pads 132. Lin p. 11.

Figure 5D of Lin is reproduced below:

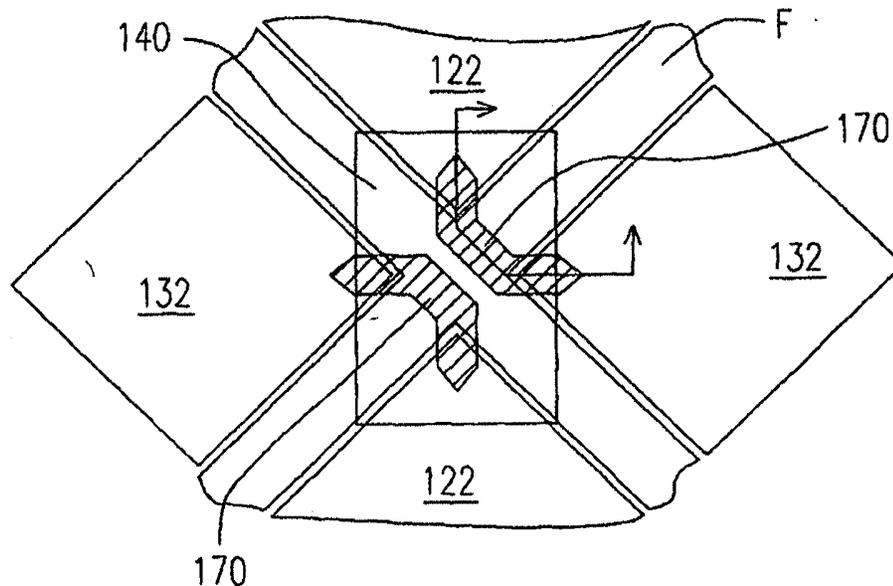


图 5D

Figure 5D illustrates “other possible embodiments” including

a third electrostatic discharge electrical design tip 170, wherein the third electrostatic discharge tip 170 from which a first sensing tandem 120 First sensing pads to the edge 122 of the adjacent second sensing tandem 130 wherein a second sensing pads 132 The edge extension, and a third electrostatic discharge tip 170 and wherein a first sensing pad 122, or A second sensing pads 132 are electrically connected.

Lin p. 15.

The Examiner finds that Figure 2A teaches the claimed first connection patterns (first bridge portions 124) which connect the first

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sensing cells (122) along the first direction, and second connection patterns (second bridge portions 134) which connect the second sensing cells (132) along the second direction. Ans. 4–5; Lin p. 11. The Examiner further finds that Figure 5D teaches the claimed static electricity induction patterns, each pattern being connected to a sensing cell, and extending in a direction toward a sensing cell immediately adjacent, [such] that an end portion of the static electricity induction pattern overlaps the adjacent sensing cell (electrostatic discharge tip 170). Ans. 6–7; Lin p. 15.

Appellants argue, and we agree, that Figures 2A and 5D of Lin represent distinct separate embodiments of Lin's invention. Reply Br. 8. Figure 5D does not include disclosure of the claimed first and second connection patterns. Figure 2A does not include disclosure of the claimed static electricity induction patterns that extend toward and overlap an adjacent sensing cell. *Id.* The Examiner has written an anticipation rejection, rather than an obviousness rejection. To anticipate under section 102, the prior art reference must not only disclose all elements within the four corners of the document, but must also disclose those elements *arranged as in the claim*. *Net MoneyIn, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008). We have reviewed Lin and we find that Lin does not disclose all the elements of the claim, in a single embodiment, arranged as claimed.

We find that the Examiner erred in rejecting the claims as being anticipated by Lin. We do not sustain the § 102 rejection of claims 1–5 and 15–20.

REJECTION OF CLAIMS 6 AND 7 OVER LIN AND GUO

Claims 6 and 7 ultimately depend from independent claim 1. We find, *supra*, that the Examiner erred in rejecting claim 1. The Examiner does not find that Guo remedies the deficiencies that we have identified in Lin. Therefore, we do not sustain the Examiner's § 103(a) rejection of claims 6 and 7 as being unpatentable over Lin and Guo, for the same reasons expressed with respect to the Examiner's rejection of claim 1, *supra*.

NEW GROUND OF REJECTION

Claims 1–5 and 15–20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lin Figure 2A in view of Lin Figure 5D.

As discussed *supra*, we agree with the Examiner that Figure 2A of Lin discloses the claimed “plurality of first connection patterns which connect the first sensing cells along the first direction” and “plurality of second connection patterns which connect the second sensing sells along the second direction.” Ans. 4. We further agree that Figure 5D of Lin discloses the claimed “plurality of static electricity induction patterns,” each “being connected to one of the first sensing cells or one of the second sensing cells, and extending in a direction toward a sensing cell immediately adjacent to a sensing cell to which said each static electricity induction pattern is connected.” *See* Ans. 5.

We determine that it would have been obvious to the person having ordinary skill in the art to combine the embodiments of Figures 2A and 5D of Lin. The skilled artisan would have been motivated to make the combination in order to obtain a touchscreen control panel having static

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discharge protection. *See* Lin, Abstract. “Combining two embodiments disclosed adjacent to each other in a prior art patent does not require a leap of inventiveness.” *Boston Scientific Scimed v. Cordis*, 554 F.3d 982, 990 (Fed. Cir. 2009).

Claims 6 and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lin in view of Guo.

In addition to the proposed combination of Figures 2A and 5D of Lin, explained *supra*, we rely on the Examiner’s rationale stated at pages 12–13 of the Examiner’s Answer regarding the combination of Lin with Guo.

CONCLUSION

Lin does not disclose all of the limitations of independent claim 1 with a single embodiment. We enter a new ground of rejection, concluding that the claimed invention would have been obvious over Lin.

ORDER

The Examiner’s decision to reject claims 1–7 and 15–20 is reversed.

This decision contains new grounds of rejection as permitted under 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 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 the appeal as to the rejected claims:

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(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, appellant 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 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). See 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED; 37 C.F.R. § 41.50(b)