UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Ex parte TAKAHIRO TAKIGUCHI, HIROYUKI KONO, MASAYOSHI KOBAYASHI, and TAKASHI HOSOI

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Appeal 2019-003495
Application 14/830,993
Technology Center 2100

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Before ROBERT E. NAPPI, JOYCE CRAIG, and STACY B. MARGOLIES *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant[1] appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1, 2, 4 through 10, 12 through 14, 16, and 17. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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[1] We use the word Appellant to refer to "applicant" as defined in 37 C.F.R. § 1.42(a) (2019). According to Appellant, Nintendo Co., Ltd. is the real party in interest. Appeal Br. 3.

INVENTION

The invention is directed to a device with a display screen that presents a selection image and a background image. Abstract. The selection image is constructed from one or a plurality of images, and is used for receiving a selection. *Id*. The background image serves as a background and is provided to the device by a background image transmission device. *Id*. Claim 1 is illustrative of the invention and is reproduced below.

1. An information processing system comprising:

a first information processing device including a hardware processor configured to control displaying on a display of a basic screen comprising a selection image and a first background image, the selection image comprising one or a plurality of selectable images, the first background image serving as a background of the selection image; and

a second information processing device configured to transmit the first background image of the basic screen, wherein

the hardware processor of the first information processing device is configured to control the first information processing device to automatically receive the first background image transmitted by the second information processing device and to control display of the received first background image in the background of the selection image,

the hardware processor of the first information processing device is further configured to control the first information processing device to automatically transmit, to the second information processing device, a background image request for requesting the first background image, and the second information processing device is configured to transmit the first background image to the first information processing device in response to the background image request.

EXAMINER'S REJECTIONS[2]

The Examiner has rejected claims 1, 2, 4, 7 through 10, 12 through 14, 16, and 17 under 35 U.S.C. § 102(a)(2) as anticipated by Jung (US 2011/0138334 A1, pub. June 9, 2001). Final Act. 4–12.

The Examiner has rejected claims 5 and 6 under 35 U.S.C. § 103 as unpatentable over Jung and Gatti (US 2009/0163182 A1, pub. June 25, 2009). Final Act. 12–16.

ANALYSIS

We have reviewed Appellant's arguments in the Briefs, the Examiner's rejections, and the Examiner's response to Appellant's arguments. Appellant's arguments have persuaded us of error in the Examiner's rejection of independent claims 1, 9, 10, 16 and 17.

Appellant argues the anticipation rejection is in error. Appeal Br. 9–12. Appellant argues that Jung does not teach the claim 1 limitation of "the hardware processor of the first information processing device is further configured to control the first information processing device to automatically transmit, to the second information processing device, a background image request for requesting the first background image." *Id.* at 9–10. Appellant argues the teachings of Jung cited by the Examiner "describe[] acquiring condition information and changing the background image based on the acquired condition information." *Id.* at 10. According to Appellant, "Jung lacks disclosure of the television requesting a background image." *Id.*

Further, Appellant states that while Jung discloses changing a background, Jung lacks any disclosure of a device automatically requesting a background image from another device. *Id*. at 10–11. Appellant asserts that independent claims 9, 10, 16 and 17 are in error for the same reasons. *Id*. at 12–13.

> The Examiner, in response to Appellant's arguments, states:

> [T]he Examiner interprets the receipt of the condition information as the background image, and once that condition information is received, it is searched, which Examiner interprets as a request for the condition information, i.e., the background image that was just received.

Ans. 16. The Examiner also cites to Figure 31 and paragraphs 174 and 175 of Jung and states the following as to how Jung discloses "a background image request":

> **[T]wo things are being mapped here to complete the teaching of this limitation: i.) a network TV receives condition information** teaches *a first background image*, and **ii.) a background image corresponding to the <u>condition information is searched</u>** teaches *requesting the first background image)*, and automatically transmit . . . a background image request for requesting the first background image **(a network TV receives condition information . . . from network operator 10 . . . a background image corresponding to the condition information is searched)**.

Id. at 17.

Appellant's arguments have persuaded us of error in the Examiner's rejection of the independent claims. Independent claim 1 recites "a first information processing device including a hardware processor configured to control displaying on a display . . . a selection image and a first background image" and further recites that the hardware processor is further configured to control the first information processing device to automatically transmit a

background image request to a second information processing device. Independent claims 9, 10, 16 and 17 recite similar limitations. Thus, the scope of the independent claims is that the background image is an image displayed on a screen and that a request for a background image is automatically transmitted to a second device. In the Final rejection the Examiner refers to Figures 8 and 24 to show that Jung teaches a background, a portion of the display which contains images in the shape of a structure, sign board or road of a city. Final Act. 5 (citing ¶¶ 94-96, 170). We concur that Jung's display teaches a background image and we concur with the Examiner's finding that Jung teaches this background is adjusted based upon a user's condition. *See* for example Figures 25 and 26, discussed in paragraphs 169–170, 174, which depict different background images based upon the user being in New York (background with statue of liberty) or Paris (background of Eifel tower) or Figures 27 and 28, discussed in paragraph 171, which depict day or night (background image showing sun or stars) discussed in paragraph 171. As discussed above, in applying the limitation related to automatically transmitting the request for the background image, the Examiner cites to paragraph 174 and the flow chart of Figure 31, and finds that the condition information meets the claimed background image. We disagree. Jung teaches that the condition information is information associated with user's surroundings such as location, season, or time of day. Jung ¶¶ 169, 173. Thus, a predicate for the Examiner's analysis of the automatically transmit limitation is incorrect because the condition information is not a background image that is displayed as claimed. Further, we disagree with the Examiner's finding that searching for the background image based upon condition information, as discussed in Jung's paragraphs

173 and 174, involves a request for the image from another device as claimed (i.e., from the first information processing device to the second information processing device). These paragraphs of Jung do not identify the location of the collection of background images on which the search is performed and thus do not disclose a request for the background image from one device to another device as claimed. We note that Jung teaches that the background image may be in the first device's firmware, suggesting that the search for a background image is a search of the first device's firmware and not requested from a second device. Jung ¶ 149. Thus, we do not find that the Examiner has demonstrated that Jung discloses the limitations of the independent claims 1, 9, 10, 16, and 17. As such we do not sustain the Examiner's anticipation rejection of 1, 2, 4, 7 through 10, 12 through 14, 16, and 17.

The Examiner's obviousness rejection of dependent claims 5 and 6 similarly relies upon Jung to teach the limitations of independent claim 1, and the Examiner has not shown that the additional teachings of Gatti make up for the deficiency's noted above in the anticipation rejection of claim 1. Final Act 13–16. We note that the Examiner has found that Gatti teaches the user may request theme information from a second device that stores background images. *Id.* at 14. While the theme information can include wallpaper (*see, e.g.*, Gatti ¶¶ 81, 108), which is a background image, the Examiner has not shown that Gatti teaches the request for theme information is automatically transmitted by the processor of the first information

processing device (Gatti's user device) as recited in independent claim 1.[3]

Accordingly, we do not sustain the Examiner's obviousness rejection of claims 5 and 6.

CONCLUSION

We reverse the Examiner's rejections of claims 1, 2, 4 through 10, 12 through 14, 16, and 17.

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 2, 4, 7–10, 12–14, 16, 17	102(a)(2)	Jung		1, 2, 4, 7–10, 12–14, 16, 17
5, 6	103	Jung, Gatti		5, 6
Overall Outcome				1, 2, 4–10, 12–14, 16, 17

REVERSED

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[3] Should there be further prosecution of this application, the Examiner is encouraged to consider whether another reference in combination with Jung (such as Gatti) would render obvious the disputed limitation of automatically transmitting a request for a background image (e.g., determine whether Gatti teaches automatically transmitting a request for the theme information from a first device to a second device).