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DAVIS & BUJOLD, P.L.L.C.  
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CONCORD, NH 03301

EXAMINER
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WOOD, WILLIAM H

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PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ADC TECHNOLOGY, INC.

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Appeal 2012-000193  
Reexamination Control 90/009,523 & 90/010,663<sup>1</sup>  
Patent 5,775,995<sup>2</sup>  
Technology Center 3900

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Before JAMESON LEE, ROBERT CLARKE, and JOSIAH C. COCKS,  
*Administrative Patent Judges.*

COCKS, *Administrative Patent Judge.*

DECISION ON APPEAL

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<sup>1</sup> The reexamination proceedings were merged in a “Decision *Sua Sponte* Merging Reexamination Proceedings” mailed March 12, 2010.

<sup>2</sup> The patent under reexamination (hereinafter the “995 Patent”) issued to Okamoto on July 7, 1998 from Application 642,560 filed on May 3, 1996.

A. STATEMENT OF THE CASE

This reexamination proceeding arose from a request for ex parte reexamination filed August 17, 2009 by ADC Technology, Inc. (“ADC”), the owner of the ‘995 Patent under reexamination<sup>3</sup>, and a third party request for ex parte reexamination filed on September 2, 2009 by Microsoft Corporation. ADC informs us that the ‘995 Patent is involved in litigation which is currently stayed. (App. Br. 3.)

ADC appeals under 35 U.S.C. §§ 134(b) and 306 from a final rejection of claims 1-2 and 4-14. We have jurisdiction under those statutes.

*We reverse.*

References Relied on by the Examiner

Chernow et al. (“Chernow”)	US Patent 4,999,806	Mar. 12, 1991
Tsumura	US Patent 5,547,202	Aug. 20, 1996

Japanese Patent 4-10191 published January 14, 1992 (“**JP ‘191**”)<sup>4</sup>

Japanese Patent 4-32898 published February 4, 1992 (“**JP ‘898**”)<sup>5</sup>

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<sup>3</sup> See Patent Assignment Abstract of Title, Reel 011741 Frame 0816 which was entered into the record of this proceeding as “Title Report” on July 17, 2009.

<sup>4</sup> The Examiner’s Answer refers to this document as “Kato.” In this opinion, we refer to the document as JP ‘191.

<sup>5</sup> The Examiner’s Answer refers to this document as “Sanbe.” In this opinion, we refer to the document as JP ‘898.

### The Rejections on Appeal<sup>6</sup>

The Examiner rejected claim 1 under 35 U.S.C. § 102(b) as anticipated by Chernow.

The Examiner rejected claim 2 under 35 U.S.C. § 103(a) as unpatentable over Chernow and JP ‘191.

The Examiner rejected claims 4-6 and 14 under 35 U.S.C. § 103(a) as unpatentable over Chernow and Tsumura.

The Examiner rejected claims 7-11 under 35 U.S.C. § 103(a) as unpatentable over Chernow and JP ‘898.

The Examiner rejected claims 12 and 13 under 35 U.S.C. § 103(a) as unpatentable over Chernow, JP ‘898, and Tsumura.

The Examiner rejected claims 11-13 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

### The Invention

The invention relates to an interactive communication system which communicates software of video games or karaoke music from a host facility or distributor to end users. (‘995 Patent Abstract.)

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<sup>6</sup> Claims 1, 2, and 4-14 stand rejected over the prior art. (Ans 5-15.) In the “Grounds of Rejection to be Reviewed on Appeal” appearing on page 7 of the Appeal Brief, ADC lists, in connection with the prior art rejections, only the rejections of claims 1 and 2 as those that are on appeal. However, on page 12 of the Appeal Brief, ADC argues that claims 4-14 are patentable for the same reasons ADC advances in conjunction with claims 1 and 2. Despite ADC’s failure to comply with 37 C.F.R. § 41.37(c)(1)(vi) by providing a concise statement of each ground of rejection presented for review, we take ADC’s argument appearing on page 12 of the Appeal Brief as a statement that the prior art rejections of claims 4-14 are also on appeal.

Independent claim 1 is reproduced below (App. Br. 14 Claims  
App'x.):

1. (ORIGINAL) A communication system having a host facility and communication terminal device capable of communicating with said host facility, said communication terminal device comprising:

an input device for inputting instructions to process data, receiving means for receiving software program as sent out from said host facility,

software program storage means for storing the software program received by said receiving means,

executing means for executing data processing by using the software program stored in said software program storage means, in accordance with instructions from said input device, display means having a screen for displaying the progress of data processing by said executing means,

clock means for keeping a predetermined time period after said receiving means received the software program, and

interference means for interfering with the execution of said executing means by blocking the view on the screen on which the progress of data processing is displayed by display means when said clock means counts said predetermined time period,

said host facility comprising:

software program file storage for storing software program as well as duration data indicative of the predetermined time period to be counted by said clock means, and

sending out means for sending out the software program and the duration data stored in said software program file storage to said communication terminal device.

B. ISSUES

1. Did the Examiner correctly find that Chernow discloses an interference means which operates “by blocking the view” on a screen which displays the progress of data processing by an executing means?

2. Do claims 11-13 fail to comply with the written description requirement of 35 U.S.C. § 112, first paragraph by reciting the term “rental period” in connection with the use of software?

C. PRINCIPLES OF LAW

Anticipation is established only when a single prior art reference discloses all elements of the claimed invention. *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990).

“In order to satisfy the written description requirement, the disclosure as originally filed does not have to provide *in haec verba* support for the claimed subject matter at issue.” *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000).

D. FINDINGS AND ANALYSIS

Claim 1 is an independent claim and claims 2 and 4-14 depend from claim 1. The Examiner rejected claim 1 as anticipated by Chernow and claims 2 and 4-14 as unpatentable over Chernow taken with one or more of JP ‘191, JP ‘898, and Tsumura. The Examiner also rejected claims 11-13 as failing to comply with the written description requirement of 35 U.S.C. § 112, first paragraph.

The Prior Art Rejections

Claim 1 is directed to a communication system including a host facility and a communication terminal device which is capable of communicating with the host facility. The communication system includes a display means with a screen for displaying the progress of data processing by an executing means, and a clock means for keeping a predetermined time period. The system also includes (App. Br. 14 Claims App'x.):

interference means for interfering with the execution of said executing means by blocking the view on the screen on which the progress of data processing is displayed by display means when said clock means counts said predetermined time period[.]

The Examiner found that the above-quoted feature is disclosed in Chernow. Chernow discloses a system incorporating a central station for distributing software to a user by telephone. (Chernow Abstract.) Chernow states that its system operates such that “[a]t the conclusion of the term of use, the software renders itself unusable or erases itself from the user’s disk.” (Chernow 5:16-18.) The Examiner takes the position that that quoted portion of Chernow describes an interference means which operates as required by claim 1 (Ans. 15:13-16:1), *i.e.*, “by blocking the view on the screen of which the progress of data processing is displayed by display means.” ADC challenges the Examiner’s position on the basis that Chernow’s disclosure of simply erasing software or rendering it unusable does not constitute the required “blocking the view on a screen on which the progress of data processing is displayed by the display means.” (App. Br. 9:5-10:11; Reply Br. 3:14-4:15 .) We agree with ADC.

In the context of ADC's '995 Patent, the operation of "blocking the view on the screen" involves visual alteration of the screen through such practices as displaying "patterns of stripes" covering the underlying substantive content of the screen or deleting the images of the screen such as by deleting an image of an opponent in a boxing game. ('995 Patent 10:56-65.)<sup>7</sup> The Examiner states that Chernow's disclosure of erasing software or rendering it unusable represents "a form of blocking the view" of a screen. (Ans. 15:15-16:1.) We disagree, at least not in the context of ADC's disclosed invention.

The disclosed embodiments of blocking the view on the screen do not stop or terminate execution of the data display software. Instead, the image presented to the viewer is altered. That is different from not producing an image at all, which is what occurs when the software programming is erased or rendered unusable. More importantly, the complete recitation at issue in the claim is "blocking the view on the screen on which the progress of data processing is displayed by display means." That further buttresses our view that according to the claim the data processing for displaying an image continues to progress while the view on the screen is being blocked. Chernow's erasing of the software or rendering the software unusable does not meet that claim requirement.

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<sup>7</sup> We observe that remarks were filed May 23<sup>rd</sup>, 1997 during prosecution of the '995 Patent which accompanied the amendment that resulted in the allowance of the claim that is now claim 1. Those remarks make clear that the two noted examples of screen view alteration which are described in the '995 Patent provide the function of the interference means of the claim, *i.e.*, "blocking the view on the screen on which the progress of data processing is displayed by display means."



Anticipation is established only when a single prior art reference discloses all elements of the claimed invention. *In re Spada*, 911 F.2d at 708. We have reviewed the record before us and conclude that ADC has shown that the Examiner was incorrect in finding that Chernow discloses all the limitations of claim 1. We do not sustain the rejection of claim 1 as anticipated by Chernow.

The Examiner's rejections of claim 2 and 4-14 are based on the premise that Chernow discloses the interference means that is required by claim 1. As discussed above, we do not agree with that premise. The Examiner applies the additional references used in rejecting claims 2 and 4-14 only to account for features added by those claims and not to make up for the deficiencies of Chernow in connection with the features of claim 1. Accordingly, we also do not sustain the rejections of claims 2 and 4-14 as unpatentable over the prior art.

#### The Written Description Rejection

The Examiner rejected claims 11-13 as lacking adequate written description in the '995 Patent. Claims 12 and 13 depend on claim 11 which in turn depends on claim 1. Claim 11 adds the limitation (App. Br. 16 Claims App'x):

wherein the software program comprises either a video game, karaoke data, or multimedia audio/video data, and further wherein the predetermined time period comprises a rental period for the software program.

The stated basis of the Examiner's rejection is that in claim 11, "[t]he limitation, 'wherein the predetermined time period comprises a rental period

for the software program’ (claim 11), is not found in the specification as originally filed.” (Ans. 5:5-7.) Compliance with the written description requirement, however, does not mandate that the exact terms which appear in the claim must also appear in the specification. *Purdue Pharma L.P.*, 230 F.3d at 1323.

ADC contends that although the term “rental” in connection with a time period may not appear in the specification of the ‘995 Patent, the specification does include multiple descriptions of using software for a certain amount of time upon payment of a fee. (App. Br. 12:16-20.) ADC submits that in light of those descriptions, the ‘995 would have conveyed to one of ordinary skill in the art that the ‘995 Patent discloses a “rental” period in connection with using the software. (*Id.* at 13:3-6.) We agree with ADC.

The ‘995 Patent makes clear that software may be used for a predetermined time period in exchange for payment. (*See e.g.*, ‘995 Patent 2:37-3:9; 7: 65-8:13; 9:51-57; 11:13-39.) Those portions of the ‘995 Patent are reasonably viewed as describing the practice of renting software. In taking a position to the contrary as to the content of the ‘995 Patent’s disclosure, the Examiner states the following (Ans. 17:5-7):

“Rent” indicates a specific form of exchanging a fee for a service or property. The originally filed disclosure only indicates a generic type of exchanging a fee for a service or property. Therefore, this rejection is not persuasive.

We are unable to discern what distinguishing significance the Examiner attributes to “a specific form” as compared with “a generic type” in connection with the practice of exchanging a fee for a service or property. Whether regarded as “specific” or “generic,” the exchange of payment for

the use of software for a predetermined time period, as is described in the ‘995 Patent, is readily recognized as establishing a “rental period” of the software.

For the foregoing reasons, we do not sustain the Examiner’s rejection of claims 11-13 as failing to comply with the written description requirement of 35 U.S.C. § 112, first paragraph.

E. CONCLUSION

1. The Examiner incorrectly found that Chernow discloses an interference means which operates “by blocking the view” on a screen which displays the progress of data processing by an executing means.

2. Claims 11-13 do not fail to comply with the written description requirement of 35 U.S.C. § 112, first paragraph by reciting the term “rental period” in connection with the use of software.

F. ORDER

The rejection of claim 1 under 35 U.S.C. § 102(b) as anticipated by Chernow is **reversed**.

The rejection of claim 2 under 35 U.S.C. § 103(a) as unpatentable over Chernow and JP ‘191 is **reversed**.

The rejection of claims 4-6 and 14 under 35 U.S.C. § 103(a) as unpatentable over Chernow and Tsumura is **reversed**.

The rejection of claims 7-11 under 35 U.S.C. § 103(a) as unpatentable over Chernow and JP ‘898 is **reversed**.

The rejection of claims 12 and 13 under 35 U.S.C. § 103(a) as unpatentable over Chernow, JP ‘898, and Tsumura is **reversed**.

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Patent 5,775,995

The rejection of claims 11-13 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement is **reversed**.

**REVERSED**

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