

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 47

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte KEIJI KITAGAWA, and IKUO TANI

Appeal No. 2003-0724
Application 08/858,809

HEARD: August 19, 2003

Before KRASS, JERRY SMITH, and RUGGIERO, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 23, 29, 37, 39, 41, 42, 45, 46, 49 and 50.

The invention is directed to graphic displays. In particular, a computer is caused to display an individual explanation of a designated picture corresponding to a specific program that can be activated. Further, in a method of drawing a graphic form in a user drawable area on a computer, a drawing command is used to activate drawing programs, with each drawing program having a function of interactively acquiring a parameter value for drawing a graphic form by causing the computer to present an item name to the user and to receive input by the user, and a function of creating graphic data corresponding to the acquired parameter value.

Representative independent claim 41 is reproduced as follows:

41. A method of displaying explanation of a picture in a computer implementing user interaction by using a pointing device and a display screen, comprising the steps of:

detecting designation of a picture on said screen by said pointing device;
and

causing the computer to display an individual explanation of the designated picture corresponding to a specific program that can be activated, said explanation corresponding to said designated picture and said specific program on a one-to-one basis, wherein said individual explanation is displayed near the designated picture and said individual explanation is surrounded with a predetermined-shaped area which includes the explanation only.

The examiner relies on the following references:

Yoshida	4,747,074	May 24, 1988
Seki et al. (Seki)	5,006,977	Apr. 9, 1991 § 102(e) date Jul. 14, 1989

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Suzuki

5,485,175

Jan. 16, 1996
eff. filing date Dec. 12, 1990

Claims 41, 42, 45 and 46 stand rejected under 35 U.S.C. § 103 as unpatentable over Seki in view of Suzuki.

Claims 23, 29, 37, 39, 49 and 50 stand rejected under 35 U.S.C. § 103 as unpatentable over Yoshida in view of Seki and Suzuki.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

At the outset, we note that this case is related (a parent application) to Application Serial No. 09/407,069, and a decision (Appeal No. 2002-0641) on appeal has been made in the continuation case.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teachings, suggestions or implications in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert.

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denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1040, 228 USPQ 685, 687 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 146-147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 1.192 (a)].

Turning, first, to the rejection of claims 41, 42, 45 and 46, the examiner alleges that Seki discloses the instant claimed subject matter but for the “individual explanation” being displayed “near” the designated picture. In order to supply this allegedly missing element, the examiner turns to Suzuki for a display of a pop-up menu at a location “near” a designated graphic element and concludes that it would have been obvious to combine this teaching of a pop-up menu being “near” a designated graphic element,

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with Seki, for “minimizing cursor movement and also providing a visual cue regarding the relationship between the pop-up definition message and the designated graphic element” (answer-page 5).

Our view is that if the examiner is employing Suzuki merely as a showing of a display “near” a designated picture, Suzuki would be unnecessary to the rejection. We find as such because the term “near” is a relative one. It appears to us that the message shown in Figure 5 of Seki is “near” enough to the designated picture to meet the instant claim language of “said individual explanation is displayed near the designated picture.”

With regard to the display of an “individual explanation” of the designated picture, appellants argue that, in Figure 5 of Seki, the message includes information on circle C1 and straight line S1, in addition to the information on the selected element C2, concluding that the claim language specifying an “individual explanation” is not met by Seki.

We think the examiner has a point when it is argued, at page 6 of the answer, that in those cases, in Seki, where there are no “referential elements” utilized in the definition of the designated graphic element, there would be no other graphic element highlighted other than the selected one, in which case the message would include an explanation of only that selected graphic element.

In any event, we still will not sustain the rejection of claims 41, 42, 45 and 46 under 35 U.S.C. § 103 because there is a key element of the instant claims which is not satisfactorily provided for in the examiner's rejection.

According to instant independent claims 41 and 45, in addition to causing the computer to display an individual explanation of a designated picture, that designated picture is "corresponding to a specific program that can be activated" and the explanation corresponds to the designated picture and the specific program on a one-to-one basis. Clearly, the message displayed in Seki, e.g., bottom of the display in Figure 5, does not, in any way, correspond to any specific program that can be activated. Since Suzuki is of no help in this regard, we will not sustain the rejection of claims 41, 42, , 45 and 46 under 35 U.S.C. § 103.

As to claims 23, 29, 37, 39, 49 and 50, the examiner points to a first storage means, command register CR, for storing a plurality of graphic data programs. The examiner cites column 1, lines 33-43, and column 2, lines 31-36, of Yoshida for the recitation of "drawing command." The examiner further points to column 2, lines 39-41, for a teaching of each drawing command, or program, constituting a drawing command code and a parameter field, to column 2, lines 41-46, for the drawing command code being used for drawing the basic pattern of a graphic element, such as a straight line, rectangle, circle..., and to column 2, lines 54-57, for a teaching of a parameter field for specifying start/stop addresses, radius...

The examiner applies Yoshida's teachings to instant claim 49 at page 8 of the answer and reference is made thereto for the examiner's reliance on Yoshida. The examiner alleges that although Yoshida does not teach the displaying of a menu containing the extracted drawing program, Seki makes up for this deficiency because Seki teaches a CAD system for drawing and editing a drawn graphic element. The examiner concludes that it would have been obvious to combine Seki's teaching of displaying the extracted program with the Yoshida system "for enabling the user to enter parameter to change the scale of the designated graphic element, as set forth by Yoshida with the ease of editing operation as explicitly suggested by Seki (col. 2, line 66-col. 3, line 4)" (answer-pages 9-10). Since this combination still failed to teach displaying the menu of drawing commands near the designated graphic element, the examiner employed Suzuki, as explained supra, to close this gap.

To the extent the examiner relies on Yoshida's disclosure of a "drawing command" as corresponding to the claimed "program," we disagree. While Yoshida describes a "drawing command" in the background section of the patent as "consisting of a program instruction which relates to a specific graphic form to be drawn," there is no indication that the drawing command itself is a graphic data program, or that a plurality of different such programs are employed, although a plurality of drawing commands is stored, column 2, lines 34-35. Moreover, a reading of the Yoshida disclosure makes it clear that a display controller has a function of facilitating extraction of a specific command for a drawing part of a graphic form from among a command

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group for drawing graphic forms and that in order for Yoshida to correct a graphic form, it is necessary to delete the graphic form to correct the displayed picture. Since it becomes necessary to extract and delete a drawing command in order for a correction to occur, if the examiner is implying that Yoshida's extraction operation is tantamount to selection of a program, as claimed, then it would appear that Yoshida would be deleting the drawing program itself. If the drawing program is deleted, then how can Yoshida's system operate? Accordingly, it would appear that Yoshida's disclosure would foreclose the possibility that the "drawing command" disclosed therein can be a graphic data program, as is recited in the instant claims.

We agree with appellants that Yoshida appears to extract and delete data. Yoshida does not disclose any "program" as recited in the instant claims and does not allow for the activation of interactive drawing programs, as brought out in the instant claims. For example, claim 23 calls for, inter alia, "each of said drawing programs having a function of interactively acquiring a parameter value for drawing a graphic form by causing the computer to present an item name to the user and to receive an input by the user, and a function of creating graphic data corresponding to the acquired parameter value" and claim 49 calls for, inter alia, "selecting a program" and a menu "including one or more program identifiers" each "identifying a program for processing an object independent of the designated graphic form..."

We find nothing in Yoshida suggesting these claim limitations and nothing in either Seki or Suzuki that provides for these deficiencies.

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Accordingly, we will not sustain the rejection of claims 23, 29, 37, 39, 49 and 50 under 35 U.S.C. § 103.

The examiner's decision rejecting claims 23, 29, 37, 39, 41, 42, 45, 46, 49 and 50 is reversed.

REVERSED

ERROL A. KRASS)
Administrative Patent Judge)
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